

PRESENTATION:

**THE DOCTRINE OF EQUIVALENTS
AND THE SCOPE
OF PROSECUTION HISTORY ESTOPPEL**

Judge Randall Rader*

I will just take a brief a minute or two because I really cannot improve upon the excellent analogy you have gotten from my senior colleague, Judge Michel. But before I make my comment, I just have to stop and comment on how remarkable this program has been. I go to a lot of these type of events. No matter how many I go to, Judge Michel always appears ahead of me. But to hear one of the leading scholars on the Federal Circuit, Judge Michel, comment is a tremendous opportunity, and then to hear Professor Adelman, who is the leading scholar in the United States in Patent Law—I would have tried to slip by “in the world,” but Joseph Straus is here, so I cannot get away with it. The only problem is I may not be able to say that very much longer, because Professor Thomas is catching up so fast that Martin cannot stay ahead very much longer. And I guess the only thing I can say about John is what one of my colleagues said to me. He said, you know, John Whealan is the finest litigant of his generation to appear before the Federal Circuit. I thought that was a very high compliment coming from one of my colleagues.

Let me just make one clarifying point on the central issue of the *Festo* prosecution history question that we are grappling with here. It is the one that my senior colleague came back to again and again. He said the central question, as you wind back through this labyrinth of undecipherable terminology, is what is the scope to be given to the estoppel. Let me put it in terms that you can visualize.

A hypothetical case: let’s assume that you are claiming a process. Let’s make it a process like the process in *Warner-Jenkinson* and you claim that this process will work between 50 and 100 degrees. That is your claim as you file it with the patent examiner. The patent examiner does an excellent

* United States Court of Appeals for the Federal Circuit, Washington D.C. This document is a verbatim transcript of the remarks presented by Judge Rader on July 21, 2000 at the High Technology Protection Summit at the University of Washington School of Law. Judge Rader’s remarks were given without formal written materials.

job of looking at the prior art and finds someone who has practiced that exact same process at 105 degrees. And the patent examiner comes to you and says, "In light of the prior art your claim range of 50 to 100 will be obvious. 105 is very close to 100. I am going to reject your claim as obvious over the prior art." Your response, of course: you must amend to avoid the prior art. So you reduce the scope of your claim. What do you want to reduce it to? Well, let's be careful, shall we? We will now claim the range is 50 to 75 degrees. And that issues. Now you have your patents and you observe someone out there practicing what looks to be your precise process. And you do all of the careful scientific study, and you find that they practice their process at precisely 75.6 degrees. Well we will round that up to 76 degrees; but clearly, one might say, it is outside the scope of what you were claimed. You literally claimed 50 to 75 degrees. Therefore how are you going to have to sue, again infringement, against this accused process? Outside the scope, you are going to have to use *non-literal infringement*, as Professor Adelman termed it, the doctrine of equivalents.

What is going to be the defense of the accused infringer? Prosecution history estoppel. You had a claim of 50 to 100 degrees; you narrowed the scope of your claim to 75. And now let me be a John Whealan-type excellent arguer before the federal circuit for the accused infringer. He could have chosen any cut off point he wished. He claimed 50 to 75. He did that on purpose. He deserves not to recover what he surrendered. He surrendered the entire 25 degrees between 75 and 100. He cannot recover the slightest inch of that.

Now let me be John Whealan, paid just as much by the other side. How much is it you were paid? Never mind. Not important. Now I will argue for the patentee. "Ah, but look at what I surrendered. Look at the prosecution history itself. I was avoiding prior art at 105. Furthermore, I was avoiding that under the doctrine of non-obviousness, which certainly would not have embraced 30 degrees difference. I did not surrender that entire amount. Then I will wax eloquent and quote language about people committing fraud on the patent, beating it by point-6 degrees, clearly intending to just snuggle up as close as they can to the boundary without crossing it. Isn't it the precise purpose of the doctrine of equivalents to remedy that problem?"

But then John Whealan, now arguing for the huge infringer, in his rebuttal stands back up and says, "There is no standard for us to tell how much he surrendered except his own words. He dropped his claim from 100 to 75. Let's hold him to it. Let's estop him from reclaiming what he explicitly surrendered."

This is a difficult debate. This is what we are in the midst of in *Festo*. Again, I cannot expound upon it except to help you recall what Judge Michel said: "Since 1983 we have regularly focused on surrender, and we have said we are going to look at the prior art and discern what scope you surrendered. We are not going to write off all equivalents of any amendment." In other words, one view that the accused infringer is arguing for is

that there will never be an equivalent of an amendment. If you amend down to 75 degrees, you are stuck with it, because you are estopped to reclaim anything that you have surrendered; and that we are going to define surrender in the broad term to mean everything that you have said.

The court has not in the past taken that approach. Judge Michel, I think, focused precisely on the point: *it's the logic versus the language*. And I heard him saying to us, the language of the Supreme Court case may indeed support the position that there can never be an equivalent or an amendment for an amendment in prosecution. That is what the language of the Supreme Court may say. But Judge Michel says that the logic compels a different result. If you look at the logic—and it tends to reinforce what the Federal Circuit has said for more than 17 years—that the prior art gives us the context to determine how much was surrendered. At least you can see perhaps a little better the parameters of what we are debating.

Underneath the debate is simmering the ultimate question, raised by Professor Thomas: What notice do we really get out of the prosecution history anyway? I mean, theoretically, you can get absolutely no notice in advance, because someone can file an infringement suit the day the patent issues. In which case, there is no chance to request a prosecution history, and thereby avoid the scope of the patent in advance. John responds, ably, that any kind of notice at any point is going to help us; and indeed it is all retrospective anyway. And Professor Thomas says that there must be limits to how many rings within Dante's hell we'll go down through to get to the real meaning of evil. You'd like to cut it off a little ahead—it is burning a little....

Anyway, those are the parameters of what we've been talking about. Thank you.