

*PRESENTATION:*

**THE DOCTRINE OF EQUIVALENTS  
AND PROSECUTION HISTORY ESTOPPEL:  
A USPTO PERSPECTIVE**

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A lot has been covered by the four previous speakers about the general topic of prosecution history estoppel. I want to touch on a few things and try not to be repetitive.

I will start first with Jay, who thinks we should burn, or in the future delete, the file-wrapper or materials that go into making up the patent. I disagree not only because I work in the Patent Office—although I think this might save a lot of space and make some people very happy. I disagree because, from a practical perspective, I get a new case every month.

When I was a law clerk for Judge Rader, I would pick up a new case and read the patent, but I'll tell you, even when I read the claim of the final product of the application, I usually still didn't know what it meant. It would probably be in an area of technology I did not study. If it was an area of technology that I studied, I studied it 10 or 15 years ago and I probably don't remember it. It is a learning process of trying to understand really what is going on at the time.

In the end, I think the patent itself is insufficient to tell you what the technology is, what happened, how it was developed, and how did it change. The prosecution history is the story before you get to the conclusion. And I am not saying it should be used for bright-line estoppel necessarily, but I can tell you personally that, without that back and forth you get in readings and discussions, I am unable to understand really what the patents are.

Patent law is really all about looking back in time. Think about it. For prosecution history estoppel, you are looking sometimes 10 years down the line in the future when there is an infringement litigation, and you are trying to figure out what did the examiner and the applicant discuss about what was there, back and forth, before they got the patent. And, when somebody is trying to get a patent they also look back in time. They try to say, "Would this have been obvious to somebody 5 to 10 years ago at the time the patent was filed?" So you combine these things. The only way to do that is to have some sort of document to look at. Because, I guarantee you, if you are in a

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litigation you are going to have one expert on one side saying what they say and an expert on the other side saying exactly what the other side wants to say. As someone who works for the Government, you are not going to believe either of those two parties too quickly. You want to look at the evidence, the best evidence, the contemporaneous evidence—and the only contemporaneous evidence is what was written at the time.

Now, I think Jay missed the point about who is relying on all this. It is the examiners whose opinion I care about. He is the one you are talking with, he is the one to whom you say, “Well this only covers this, therefore, give me the patent.” He says okay, and he gives it to you. That to me is a very important point. Since in our system you don’t call the examiner to the stand and you don’t have the discussion, you try to figure out what the examiner’s state of mind was when he granted you this right. And the best place to start looking, before you start thinking of all these new theories during the course of litigation, is at what they said at the time. That is the first place I would look.

Regarding reasons for allowance, Jay is right. They are not elaborate enough. That is something that could be changed. In high-profile cases, an examiner should discuss—and I have encouraged them to discuss—why he is allowing the patent. That gives the public an opportunity to know what we were thinking, and it also gives potential infringers an opportunity to go find the art we could not find, and present it to us in a re-examination.

I like to think of my job as creating more prosecution history estoppel. I think the cases argued most recently in the Federal Circuit are close. And typically the board has decided that the claims may be written too broadly and therefore the prior art reads on it. Well the applicant on the other side is arguing, “No, no, my claims are much narrower.” And given the way we review them, on what is called the broadest reasonable interpretation, we take a broader look at the claims than Judge Coleman would in district court litigation.

I like to think we make reasonable interpretations, but every once in a while Judge Rader or one of his colleagues will tell us that we don’t. He says the claim means ‘X’ and not ‘Y’. That is prosecution history estoppel. That is, additional statements by the other side about what something means, statements that people in the public will be able to rely on in the future in potential licensing or a potential infringement. Their briefs, and the other side’s briefs, are statements of what they think it means and how they think it is limited. And so our office tries to make the record clear as to what everybody thinks their patents are entitled to, and then to let people look at them.

Let me just comment about a few other things that have been discussed. I notice a pattern in these high profile cases, like *Festo*,<sup>1</sup> at the Federal Circuit. It's kind of a trilogy. What first happens is there is some debate amongst the panel judges about a doctrine that eventually generates a lot of discussion. The solution is to take the case *en banc*. So in *Warner-Jenkison*<sup>2</sup> the debate was about whether or not judges or jurors were going to decide doctrine of equivalents. To frame it up, it is a good thing that the Federal Circuit decided *en banc*, so therefore we will all be more likely to understand it. Well, what happened, as with all others *en banc* cases, there were a lot of splintering decisions so it is hard to understand what it means.

So then what happens is the Supreme Court takes the case. Then the Supreme Court case comes back and the Federal Circuit panels try to figure out what the Supreme Court meant. Now, give the Supreme Court credit. In the *Pfaff*<sup>3</sup> case, they laid out what is a pretty clear test and it seems to be followed pretty consistently. But now, there is a lot of discussion in the *Litton* case<sup>4</sup> and in *Hughes*,<sup>5</sup> *Sextant*<sup>6</sup> and *Festo*<sup>7</sup> about what the Supreme Court really meant. And the Federal Circuit had to go *en banc* again, to tell us what the Supreme Court really meant.

If you think about it, this same trilogy happened in *Markman*.<sup>8</sup> First, claim construction was debated amongst the panels. Then it went up to the Supreme Court, which finally told us what the law was. But then there was still a lot of debate after the Supreme Court's decision and the case had to go *en banc* in *Cybor*<sup>9</sup> to tell us what the Supreme Court really meant in *Markman*. So, this pattern is not that uncommon.

The Supreme Court is not really there to dot the I's and cross the T's of the doctrine. I think they are there to kind of say, "Look, we like the doctrine of equivalents, we don't like it to be too broad, good luck, come up with a good test." As Judge Michel pointed out several times, maybe we should be a little bit more clear. I think that although the court has to acknowledge what the Supreme Court says, I think they should not, for instance, read too much into the words the Supreme Court used regarding "bar." I think they should focus more on what Judge Michel was talking

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<sup>1</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 172 F.3d 1361 (Fed.Cir. 1999).

<sup>2</sup> *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

<sup>3</sup> *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998).

<sup>4</sup> *Litton Systems v. Honeywell, Inc.*, 140 F.3d 1449 (Fed.Cir. 1998).

<sup>5</sup> *Hughes Aircraft Co. v. United States*, 140 F.3d 1470 (Fed.Cir. 1998).

<sup>6</sup> *Sextant Avionique, SA v. Analog Devices, Inc.*, 172 F.3d 817 (Fed.Cir. 1999).

<sup>7</sup> *Supra*, note 1.

<sup>8</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir. 1995).

<sup>9</sup> *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed.Cir. 1998).

about: creating a doctrine that makes sense, creating a doctrine that has a clear test that competitors can apply well before any lawsuit.

I was going to talk a little bit about the *Festo* questions, but I think there has been enough said about that case right now. I expect there will be some sort of clarification that the doctrine has teeth but is not necessarily a complete bar, as some judges believed the Supreme Court meant. Personally, I don't think the Supreme Court really meant to put all the emphasis on a few words at the end of that decision. I don't think they understood the ramifications, I don't think most commentators thought this debate was even going to occur. Initially, I remember being in a conference with Jay Thomas two months after the case came down, and the debate then was about what was meant by the phrase "related to patentability." We never discussed this present issue. This first arose in the *Litton* case.

To wrap this up, what does "related to patentability" mean? That is the \$64,000 question. In my opinion, where the court was going before *Festo* seems to make a lot of sense; I don't think it is just related to Sections 102 or 103. I think it relates to basically any statements. I think Judge Michel was right: any sort of surrender, any sort of point where you told the examiner something that he believed such that he then issued you a patent. It does not make a difference to me whether it was a Section 112 amendment, or just a statement. The point of the system is not to let people be hypocritical. Don't let them say one thing to get the patent and then let them now—several years later, when they realize they should not have said it—say something else.

I think one of the big issues is what Professor Adelman talked about: pre-existing vs. post-existing technology. It does seem to make a little more sense when you start separating them. I think a good example of how this type of pre/post technology was used is in the *Chiuminatta*<sup>10</sup> case. There, Judge Michel tried to untangle the confusion between Section 112(6) equivalents and *doctrine of equivalents*-equivalents. And he said, just to summarize, "Well, if it is pre-existing technology, you get a means plus function claim in Section 112; if it is post-existing, it is doctrine of equivalents."

Maybe what the court will say in *Festo* is that if it is pre-existing technology and you did not claim, you are barred. Well, if it is post, or prospective technology that nobody knew about then, as Professor Adelman suggested, the doctrine was probably intended to protect.

Tying together these things that Judge Michel and Professor Adelman said—Judge Michel kept talking about the word "surrender" and Professor Adelman talked about how you have the opportunity to file for reissue. The doctrine of recapture, or to prevent recapture, laid out by the federal circuit is consistent with both of their points. You should not be able to obtain in a

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<sup>10</sup> *Chiuminatta Concrete Concepts v. Cardinal Industries, Inc.*, 145 F.3d 1303 (Fed.Cir. 1998).

doctrine of equivalents something that you could not get by way of reissue. If you gave it up and you made statements to limit it, you are not going to be able to get it back; and if you could not get it back on a reissue under the doctrine of recapture, why should you get it back in the doctrine of equivalents?

The final point is it really does go to the point that Professor Adelman talked about—I think Judge Michel mentioned it too—in Judge Rader’s opinion in the *Sage Products* case.<sup>11</sup> *Who bears the responsibility?* I read a lot about companies that are very proud that they get “the most patents of any company in the world.” Why is that such a great feat? I’d rather be a small company that has 5 or 10 patents in one particular area of technology that are on the cutting edge in the area where they prosecuted the cases, and to do a good job locking up the technology.

We get roughly a quarter-million applications a year, we issue about two-thirds of those, and we have about 3,000 examiners. So do the math. I mean, these examiners only have so much time to work on a case. Even if it is a half a week or a week, there is only so much time. Attorneys, even if you are not working at the \$300 or \$400-an-hour rate, if the numbers are more you’d get \$5,000 or \$6,000 per patent. There is only so much work you are going to put into it. So if these corporations want to just churn out patents and not be specific enough to claim the right range, then you will question whether or not the doctrine of equivalents will apply. You’ll have all the uncertainty that goes with it, all the unpredictability, all the lawsuits—if you can’t know whether or not the doctrine should be used broadly to fix mistakes that were clearly curable mistakes. And I tend to think it should not be used that way.

I tend to think that a lot of what has been going on in prosecution is a trade off—if people want to get out an application quickly or want to compromise not to take an appeal. And if those choices are made, then they should not be able to undo everything they did—when they realize it is one of the important cases—and escape the prosecution history estoppel and create a whole new uncertainty.

Thank you.

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<sup>11</sup> *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed.Cir. 1997).