

*PRESENTATION:*

**THE DOCTRINE OF EQUIVALENTS,  
PROSECUTION HISTORY ESTOPPEL,  
AND COMMENTS ON NAPSTER**

**Darryl Woo\***

Being on this panel is a welcome break from what I have been doing for the last couple of months with my groups in patent litigation. I am one of the many lawyers working for Napster in the case brought by the recording industry. It has been a very interesting exercise, particularly for me, since ideally it deals with entertainment law.

Let me tell you what I mean by that. A couple of days ago we received a brief, a declaration actually, by an attorney who is interviewing artists. Let me just read a couple of paragraphs:

I have been contacted by this one party who wishes me to represent his label in the present proceedings which has been harmed by the Napster Music website concerning the copyrights of labels without consent. I went to the company's website, www.whatever, and really enjoyed the creativity he has brought to the site. Mr. X is a 23 year old colored male who is from Virginia. His label represents artists who do hip hop music. I enjoy some hip-hop music because it makes me feel cool. It made me really happy that I can represent this client. I do not drink, I do not smoke, and I find that disaster usually starts if I do not do my yoga every morning for an hour. So, I guess that is why they sometimes call copyright law "entertainment law."

Anyway, it is too bad this case has not been decided. It is coming up for oral arguments for plaintiff's motion for preliminary injunction this Wednesday. It is too bad because the case is a great example of how the Internet is likely to change our notions of traditional law.

This morning we talked about how the Internet can be compared to the telegraph. And I suppose another aspect of the Internet is that it is really a combination of the radio and the telegraph, because at the end of the day, if you think about the policy of the Internet, you have to think about the scalability that it involves. I can buy a CD, make a copy, copy it for my car, copy it for use in my office, give a copy of it to my wife so that she can listen to it in her car, make a copy for my kids, and if cousin George wants

---

\* Fenwick & West, LLP, Palo Alto.

one, he can get one from me as well, or I can email it to him, or I can leave it on my website and he can come download it if he wants. Think about what happens because of the Internet: anybody can download anything they want; and, instead of having to choose specifically who you want to send a CD to or a certain type of file, you can electronically upload it to everywhere in the world. Tremendous power forms in the combination of the radio and the telegraph. It creates a problem for a lot of traditional methods of obtaining copyrighted material.

Before I turn back to the real topic that I am suppose to talk about, prosecution history estoppel, I would like to talk about what has been discussed by Judge Michel, Judge Rader, Professor Adelman and Mr. Whealan. First of all, I want to confess that I am at nowhere near the scholarly level of the others. I am just a simple litigator, and as a civil litigator I take things as I find them.

We've talked a lot about predictability and I would like to put my own twist to it. Predictability in part arises from rules that do not change. Every time you change the rules you introduce more unpredictability into the process. For example, if you take a look at the game in *Festo*, the rules do not change for at least 100 years, if not longer. As a result, the predictability is very high. Everybody knows exactly what is going to happen. If you are the defendant you need to find the "black pieces" in those games.

Unfortunately, we do not have that in patent law. We have a constantly shifting set of rules. Again, as a litigator, I take things as I find them. On the defense side, I am facing all the same issues in patents. Why should I play the archeologist and dig up the pieces of prior art? Or, why should I be a historian and research the prosecution history, and try to figure out where my opponent made a critical mistake?

Even in the European, post-*Markman* and post-*Vitronics* era, we as litigators find ourselves taking the depositions of the inventors. Why? Because we want to get more admissions. They are going to say something about what they think the patent is about or what the terms mean. I want to try and take that deposition and get more admissions—the more the better—so that I can use it against the patentee.

So, contrary to Professor Thomas, I find myself in favor of keeping the rules as they are. Let's look at the prosecution history. Let's keep that going. On the other hand, on the side of the patent holder, I also have to take my record as I find it. By the time it is necessary to enforce a patent, all the battles with the patent office have been won. If they have not been won, the patent would not have been issued. The specifications, the file history—it is all pretty much set in stone. There is nothing more I can do about it, unless you have continuations going, as Professor Adelman mentioned earlier. Finally, you knew at the time of the prosecution what the competition had done. So as a litigator, I don't have the competitor's product in acceptance in the context of trying to sue them.

Patent prosecutors have a chance to alter the file history as it develops. So, for a moment I want to focus on the litigator's perspective. I think there is a lot to learn from what happens in litigation. To avoid prosecution history estoppel, prosecutors should learn from all the cases we talked about today: the whole thing is based on what is said in the patent. If you claim a square tile instead of a whole tile, then you are going to be estopped with a square tile. If you did that because you were in a hurry, well then shame on you, because you have the control at the time of the application to change that. While we don't have time machines, you can look at existing law and that helps you at least part of the time.

Let's go back to the *Warner-Jenkinson* case for a minute. As a litigator, I always thought that prosecution history estoppel was very straightforward. If to obtain allowance on a patent with respect to a device—say, in claiming switches, if I give up mechanical switches in favor of a touch screen—I cannot later argue that the accused device using mechanical switches infringes under the doctrine of equivalents. That should be very clear.

But *Warner-Jenkinson* introduces all kinds of uncertainties over that. Look at some of the language in that decision: “where the reasons for the change was not related to avoiding the prior art, the change they introduce is a new element, but it does not necessarily preclude infringement by equivalents of their own.” What are they talking about? Does that mean that if I introduce a new element and it is not to avoid the prior art, there is no estoppel? Does it mean that that only amendments that were made in response to section 102 and 103 rejections will create an estoppel? Or can estoppel be created by a response to a 112 objection? What if the amendment was voluntary? But then when is it ever voluntary? John Whealan, in a discussion in the hallway, suggested that it is now practice to make voluntary statements to the Patent Office. I do not like all of that. It seems to me that there is some room for making an amendment if you know the piece of prior art.

I want mention briefly some other cases, then I will sit down. First, the *Sextant Avionique*<sup>1</sup> case where the court discussed both sides of the section 112 device and said, “Well, wait a second. On the one hand, section 112 has to be met in order to get a patent, and the failure to meet that is denial of the patent, and therefore that is a sort of form of patentability.” So when *Warner-Jenkinson* talks about patentability, it is talking about section 112 as well as 102 and 103 rejections.

On the other hand, sections 102 and 103 are entitled to the conditions for patentability. Section 112 only deals with the more mechanical requirements of what has to be in the specifications. So if you are really talking about patentability, *Sextant* did not really talk about 102 and 103 rejections;

---

<sup>1</sup> *Sextant Avionique, SA v. Analog Devices, Inc.*, 172 F.3d 817 (Fed.Cir 1999).

even though it discusses both issues it did not resolve anything. That is why we get to the *Festo* case.

In another case, called *Loral*,<sup>2</sup> there are some suggestions that patentability only refers to 102 and 103 rejections, but the court also found something very interesting: that the patentee could not avoid the effective part of prosecution history estoppel by trying to avoid 102 and 103 by having the 112 responses. You cannot hide behind section 112 in order to try to avoid prosecution history estoppel. The court says you cannot do that. So *Loral* seems to suggest that the back-handed way in response to the 112 rejections would not be an estoppel.

Then again, earlier this year in *Bayer AG*<sup>3</sup> there was an amendment that was made in response to the section 112 rejection, in which the court held that, because it was a clear, unmistakable surrender of subject matter, there would be an estoppel, even though it was given in response to the 112 rejection. So, it seems to be that there is a conflict between the *Loral* court's suggestion that a 112 amendment cannot be an estoppel, and *Bayer*, which found that there is an estoppel with respect to the 112 amendments. So, I guess we just have to wait and see the outcome of the *Festo* decision and how they resolve it.

Let me just sort of lead you with some conclusion from all these different cases. If you want to try to avoid a prosecution history estoppel, you might try some of the following ways:

1. If an examiner gives you a rejection and does not state clearly that is under section 102 or 103, you might try to raise it in response to a 112 premise, rather than 102 or 103.
2. I think you want to avoid making silent amendments in response to an examiner's suggestion. You should at least consider what Judge Michel, that if you say nothing then you will get an absolute bar as to everything. So, let me help you end the case. I think you want to avoid making silent amendments.
3. This one is really going to cause some controversy. If you proceed with trouble, such as when you come across a piece of prior art in the course of prosecution, consider making a voluntary amendment to the examiner's actions.
4. Finally—and this one is a no-brainer—choose your language carefully, because what you say today will effect what you will have to try to enforce later on.

Thanks very much.

---

<sup>2</sup> *Loral Fairchild, Corp. v. Sony Corp.*, 181 F.3d 1313 (Fed.Cir. 1999).

<sup>3</sup> *Bayer AG v. Elan Pharmaceutical Research Corp.*, 212 F.3d 1241 (Fed. Cir. 2000).