

The Doctrine of Equivalents after *Festo* and *Johnson & Johnston*

Impact on Patent Prosecution

Lawrence J. Bassuk
Texas Instruments Incorporated
12500 TI Boulevard
Dallas Texas, 75243-4136
972-917-5458
fax 972-917-4418
L-bassuk@ti.com

Patent prosecution before *Festo*¹ and *Johnson & Johnston*²

1. File a new patent application with written, enabling, and best mode descriptions and several independent and dependent claims of varying scope.

2. Receive a typical Examiner's Action with the following rejections:

3. Specification indefinite;

4. Claims indefinite;

5. Claims anticipated; and

6. Claims obvious.

7. Prepare and file a response:

8. Amend specification to correct spellings and conform to drawings;

9. Cancel original claims and insert new claims, or amend the form of the claims to provide proper antecedent support and connect together all the parts; and

10. Keep original claims, cancel original claims and insert new claims, or amend the original claims to emphasize a limitation or insert a limitation that distinguishes over the cited art.

11. Prepare remarks that:

12. Explain the amendments to the specification and that they do not insert new matter;

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831; 152 L. Ed. 2d 944; 62 U.S.P.Q.2d 1705 (2002)

13. Explain that the new or amended claims, as to form, do not change the substance of the claimed invention; and
 14. Explain that the distinguishing limitation(s) in the new or amended claims is(are) not disclosed or suggested in the cited art and is(are) supported by the specification.
15. Examiner allows application after reading applicant's response and the patent issues.
16. Patentee sues competitor for infringement.
17. Competitor (alleged infringer) responds:
18. no direct infringement; and
 19. scope of the claims limited by any narrowing amendment of the specification and claims and remarks presented to examiner in getting patent (estoppel).
20. Court looks at:
21. patent claims;
 22. specification; and
 23. file history of actions by patentee to get patent, including art avoided to get the patent, and examination of subject matter surrendered by any narrowing amendment (patentee estopped from extending scope of claims beyond their literal words based on actions of patentee in amending the application and the amendment narrows the application scope).
24. Court decides direct infringement and infringement by equivalents.

² *Johnson & Johnston Assoc. v. R. E. Service Co.*, 285 F.3d 1046; 62 U.S.P.Q.2d 1225 (Fed.Cir. 2002)

US Supreme Court *Festo* Decision

25. Doctrine of Equivalents necessary to overcome problems in describing and claiming inventions.

26. Narrowing amendment of the application made to satisfy any requirement for patentability may give rise to an estoppel. The prosecuting attorney knew the words for the broader and narrower claim and affirmatively chose the narrower claim words. Requires an examination of the subject matter surrendered by the narrowing amendment.

27. Narrowing amendments do not relinquish unforeseeable equivalents and do not relinquish equivalents for aspects of the claims that have only a peripheral relation to the reason for the claim amendments. Also, there may be some other reason that the patentee could not have reasonably be expected to have described the insubstantial substitute in question. Patentee carries the burden of showing that any one of these exceptions overcomes the presumption that prosecution history estoppel bars a finding of equivalence.

28. Patentee is presumed to have surrendered the matter outside the literal scope of the claims.

29. Patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent. (Is this paragraph 27 or paragraph 29, or paragraph 27 and paragraph 29?)

Federal Circuit *Johnson & Johnston* Decision

30. The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed.

31. Patentee may file for a reissue patent, or may file a continuing or divisional application before the patent issues to claim the disclosed but not previously disclosed matter.

32. But if the statement in paragraph 31 is true, then how does a dedication described in paragraph 30 truly occur? (Does the principle in paragraph 30 foreclose any infringement by equivalents of the issued patent because a pending application still subsists?)

Patent prosecution after *Festo* and *Johnson & Johnston*

33. Know all competing (infringing) devices and processes before the patent issues and draft claims to encompass them. (Not very likely!)

34. In patent applications that appear to protect a leading product or technology, keep a continuation or divisional application pending throughout the 20-year term of the patent. Then draft claims to the competing (infringing) device or process when it arises. The *Johnson & Johnston* decision encourages and explicitly condones this conduct. (Being done today!)

35. Perform an extensive prior art search before preparing the application and draft claims safely from the edge of the art to obtain allowance without action. This eliminates any amendments of the application and explanatory remarks in the prosecution history. But does estoppel prevent infringement by equivalents because the claims were intentionally drafted to avoid the art?

36. Work with the inventor when preparing the application and when responding to any rejection of the application to encompass competing developments in the art that come close to the disclosed invention. (Likely to be done more in the future.)

37. Consider who would be a person skilled in this art. What claim would they be reasonably expected to draft to encompass known or foreseeable equivalents? What evidence would be necessary to prove who that person was and what knowledge they have? What evidence would be necessary to prove what was foreseeable? Patents? Technical papers? Then use that evidence to draft such a claim with supporting remarks. (Unlikely to be done.)

Conclusion

38. Competitors will continue to develop and sell competing products that provide the same or substantially the same benefits or features as the product of your client. They must do so to stay in business.

39. Regardless of the decisions in *Festo* and *Johnson & Johnston*, the patentee will never be able to sue a competitor for infringement without a patent. The prosecuting attorney therefore must do everything necessary to get the patent. The standard prosecution practices of presenting claims of varying scope, making few amendments to the specification and claims and making few remarks continue to stand foremost. Maybe more thought will be given to equivalents. In prosecution, claims can only be expanded to the extent of the disclosure and to the edge of the known art. The rest is up to the competition and an astute trial attorney.