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Feature
Patent

***13** ENSURING BROAD CLAIM COVERAGE AFTER **FESTO**

William James [FNa1]

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The only thing certain to flow from the recent decision of the US Court of Appeals for the Federal Circuit in **Festo** Corp. v. Shoketsu Kinzoku Kogyo Kahshiki Co. [FN1] is ink. Many articles have been and will be written by practicing attorneys, academics, and other commentators to laud, lament, explain, and analyze the lengthy opinion of the court and the various concurring and dissenting opinions. The most ambitious will attempt to predict what, if anything, the US Supreme Court may do with the case and/or prognosticate on whether and when further changes, and perhaps even the demise, of the Doctrine of Equivalents (DOE) will come. This article has the modest goal of providing guidance for patent attorneys who must prosecute patent applications in the face of the uncertain future of the DOE after **Festo**.

In **Festo**, the Federal Circuit effected sweeping changes in the application of the DOE to claim limitations that were amended during prosecution. Under the DOE, infringement may be found even though one or more claim limitations do not read literally on an accused device if the differences between the claim and the accused device are insubstantial. [FN2] The related doctrine of prosecution history estoppel holds that where a claim has been amended for reasons substantially related to patentability, the DOE may not be used to recoup subject matter the applicant surrendered by making the amendment. [FN3]

The **Festo** court changed the scope and application of these doctrines radically by providing the following answers to four of the five questions certified by the court for rehearing en banc:

1. An amendment is made for a "substantial reason related to patentability" if it is made to satisfy any of the statutory requirements for obtaining a patent, including those set forth in 35 U.S.C. Section 101 and Section 112. Therefore, prosecution history estoppel may arise for amendments made for reasons other than to distinguish prior art under 35 U.S.C. Section 102 and Section 103. [FN4]
2. A so-called "voluntary" amendment (i.e., one made for a reason other than in response to a rejection by the examiner for a stated reason) is to be treated the same as any other amendment for purposes of prosecution history estoppel. That is, if a claim is narrowed by a voluntary amendment for a reason substantially related to a statutory requirement for patentability, prosecution history estoppel applies to the claim so amended. [FN5]
3. If an amendment gives rise to prosecution history estoppel, no range of equivalents is available under the DOE as to the amended limitation. [FN6]
4. Where the patentee cannot establish, based solely on the prosecution history and without resort to extrinsic evidence, that a narrowing amendment was made for a reason other than a substantial reason related to patentability, prosecution history estoppel applies and no range of equivalents is available as to the amended limitation(s). [FN7]

Patent Prosecution before **Festo**

Festo's impact on patent prosecution requires careful consideration. Before **Festo**, a widely used strategy for obtaining broad patent protection was to file an application with the broadest claims supported by the specification that did not read on the prior art as known to the applicant and its counsel. This approach enabled the patent applicant to avoid selling himself short by including limitations that were not, in fact, necessary to distinguish the prior art. The strategy complemented Patent Office practice well, as examiners frequently issue first office action rejections in at least a significant number of cases, most commonly based on cited prior art.

Prior to **Festo**, the typical response to such a rejection was either a communication arguing why the prior art rejection was wrong or an amendment narrowing the claim only to the extent necessary to clearly (or more ***14** clearly) distinguish the cited prior art. In some marginal cases, an amendment would be made even if the patent attorney believed the rejection to be unfounded, if the patent attorney felt an amendment could be made that would more clearly distinguish the prior art without limiting the claim unduly. In such cases, an amendment would often be made to get the case allowed more quickly than could be accomplished through an appeal or continuation practice.

Patent attorneys recognized that under the law (as it then existed) any such amendment might give rise to prosecution history estoppel. It was believed by many, however, that the scope of the estoppel would extend only to the specific prior art cited by the examiner and some reasonable scope beyond the specific prior art cited. For example, many believed that such an estoppel would be limited to technology that bore more resemblance to the prior art than the invention literally described by the claims. Most expected there would be at least some limited range of coverage under the DOE for amended claim limitations. [FN8]

Post-Festo Patent Prosecution

In response to the guidance provided by the Federal Circuit in **Festo**, patent attorneys should consider doing the following, for the reasons explained more fully later in this article:

. Present more independent claims, covering, to the extent practical, the entire spectrum of possible claims from the most broad to the most narrow imaginable.

. Include means-plus-function claims which have a statutorily mandated range of equivalents under 35 U.S.C. Section 112, paragraph six.

. Resist the temptation to make a seemingly minor amendment to more clearly distinguish prior art cited by the examiner where it is possible to overcome the rejection without amendment.

. Resist the temptation to amend claims to make them more elegant or more technically or grammatically correct.

. Explain the reason for making the amendment fully--in remarks included with the amendment--if they must amend for reasons other than a substantial reason related to patentability. . Focus on carving out the prior art and not on further describing the "invention," if they must amend to distinguish prior art.

. Use a claim structure that divides the claim into discrete elements and, if they must amend, make the amendment by adding a separate element, if possible.

. Interview the examiner before making any amendment that might be construed as having been made for a substantial reason related to patentability.

Present More Independent Claims. In light of **Festo**, patent prosecutors must assume that in most cases an amended claim will be given no range of equivalents under the DOE while original claims will continue to enjoy the full range of equivalents supported by the law and evidence. As such, it is important to include among the original claims in any application an array of independent claims covering the full range of claim breadth, from the most broad to the most narrow. Using this approach, the more broad claims may be dropped, if necessary, rather than amended, leaving one or more original independent claims, which have not been amended and which contain the limitations necessary to distinguish, or more clearly distinguish, the prior art. Any claims not pursued should be canceled "without prejudice" and without further comment, to be pursued later in a continuation application, if appropriate, as original claims.

The common **pre-Festo** practice of including only broad independent claims and an array of more narrow dependent claims may not be sufficient to avoid the estoppel found in **Festo**. In **Festo**, Claim 1 of the Stoll patent was amended to add a limitation that appeared in Claim 8, which depended from Claim 1, and Claim 8 was canceled. Claim 1, as amended, was in substance the same as original dependent Claim 8. That is, the applicant could have reached the same result by canceling Claim 1 and amending Claim 8 to recite explicitly the limitations of Claim 1, which by law were already part of Claim 8. Query whether the **Festo** court would have reached a different result with respect to this limitation if the patent attorney had arrived at the same claim by merely rewriting Claim 8 in independent form instead of amending Claim 1 to include the limitations of Claim 8? As a result of the uncertainty of the answer to this question, the only prudent approach is to include a range of independent claims in each application, as it is clear that the holding and rationale of **Festo** do not apply to claims that have not been amended.

***15** Include Means-Plus-Function Claims. So-called means-plus- function claims have fallen out of favor in recent years, as a series of judicial decisions have defined such claims more narrowly than both the literal language of such claims and the facially expansive language of the statute authorizing them had led many patent attorneys and owners to expect. In light of **Festo**, however, it may be advisable to include such claims in any patent application. The reason is that it may be possible to avoid or overcome a prior art rejection to such a claim without having to amend it in circumstances where an amendment would have been necessary for a corresponding non-means-plus- function claim.

For example, one could argue (if the facts support it) that the structure described in the prior art for performing a recited function is not equivalent to the corresponding structure disclosed in the patent application. [FN9] Such argument may itself create an estoppel to the extent it evidences a "clear and unmistakable surrender" of subject matter. [FN10] The estoppel, however, would not be absolute and instead would be limited to the subject matter clearly and unmistakably surrendered by virtue of the arguments, as determined by the court, which resembles the "flexible bar" approach rejected (for purposes of the DOE) in **Festo**. [FN11]

To illustrate the point, suppose an original application claim recites "means for fastening" and the written description discloses only adhesive fasteners, such as tape. Suppose further that the examiner rejects the claim based on prior art in which the function of fastening is performed by tying. One way around the rejection would be to amend the claim to recite a "means for adhesively fastening." That, however, would limit the claim to those devices in which the exact same function of "adhesively fastening" is performed, using structures equivalent to those disclosed in the patent. [FN12]

What would happen if the applicant instead were to overcome the rejection by arguing that the structure used to perform the function of fastening in the prior art is not equivalent to the corresponding structure described in the application? In that case, the resulting estoppel may be limited to exclude from coverage devices in which the fastening is done by tying and, perhaps, other methods closer to tying than to the adhesive fasteners described in the patent. Under the former approach, a device in which magnets are used to fasten may be excluded from coverage on the grounds that it does not perform the function of "adhesively fastening." By contrast, under the latter approach such a method of fastening may be found to be structurally equivalent to the adhesive fasteners described in the patent and not excluded by the estoppel resulting from the argument that fastening by tying is not equivalent.

The greatest potential advantage of including such claims may be the possibility that the examiner would conduct the means-plus-function analysis and never reject the claim in the first place. In that case, there would be no estoppel.

Of course, to obtain broad, effective protection using such claims, one must be sure to draft applications and claims with the lessons of the means-plus- function case law of the past 10 years in mind. For example, the specification must include language clearly linking disclosed structures to the claim limitation(s) to which they correspond. [FN13] In addition, as the range of equivalents may be construed narrowly, it would be advantageous to include in the specification a non-exhaustive but wide-ranging description of known equivalent structures and even multiple embodiments, each of which may be given a different range of equivalents. This approach insures against a construction of the patent claims which would effectively narrow the scope of the claim either by identifying too many specific structures as corresponding to a particular means (since the same specific structures are not likely to be found in alternative embodiments) or by defining the scope of structural equivalents too narrowly.

Resist the Temptation to Amend to More Clearly Distinguish Prior Art Where It May Not Be Necessary. If you believe the examiner has rejected a claim in error, traverse the rejection without amending. In the past, it may have been a reasonable approach to make a minor amendment that more clearly distinguished cited prior art, thereby increasing the chances of obtaining prompt issuance of the claim. Under **Festo**, such a course of action likely would lead to the amended limitations being afforded no range of equivalents under the DOE. Instead, make your arguments to the examiner without amending and, if the examiner maintains the rejection, appeal if necessary. This course of action is likely to delay the allowance of the patent and may increase the cost to the applicant, but it is necessary under **Festo** to ensure broad patent coverage.

***16** Resist the Temptation to Amend to Make Perfect. Do your best to write clear, well-structured claims for the original application and then stick with them. Many patent attorneys, as the product of both technical and legal training, delight in reading and writing an elegant patent claim, that is, one that is simple, clear, uses an economy of well selected words, and is technically accurate and complete without being cluttered with unnecessary verbiage and jargon. Strive for this ideal in the first instance. If at the time you review a subsequent office action you realize that you missed the mark in some way, resolve to do better next time and leave the claim alone. Doing otherwise invites a finding later that your amendment was made for a substantial reason related to patentability over your muted protest that you were just trying to be perfect.

Carefully Document Non-Patentability Reasons for Amending. Particularly after **Festo**, this author cannot think of a good reason for amending a claim that is not a substantial reason related to patentability, other than to correct obvious typographical or spelling errors. Apart from such obviously safe reasons for amending, a claim should simply not be amended after **Festo**, except where necessary to gain allowance and with full knowledge that any claims issued after being amended will have no range of equivalents under the DOE for amended limitations. If you do amend for a reason other than a substantial reason related to patentability, be sure to set forth the reason for the amendment without so much as hinting at a patentability-related reason for the amendment. Take special care where the amendment must be made in response to an office action in which the claims have been rejected for reasons related to patentability, which under **Festo** would appear to include any permissible basis for rejection.

If You Must Amend to Distinguish Prior Art, Focus on Carving Out the Prior Art. If you must amend to overcome a rejection based on cited prior art, try to fashion a limitation that excises the prior art from the scope of the claim. The contrary and more elegant approach of adding as a limitation an additional feature of the embodiment(s) you had in mind at the time you drafted the claim would have the effect of limiting the claim strictly to devices or processes that literally meet the added limitation.

To illustrate, assume your client developed a pen in which the tip could be retracted by rotating one portion of the pen body in relation to another. You and your client believed reasonably and in good faith that the client had invented the first pen with a retractable tip. Assume further that you drafted an original claim which recited a pen in which the point may be retracted into the pen body when the pen is not in use and extended out of the pen body for use. Finally, imagine the examiner rejected the claim, citing a prior art pen in which the tip was retracted or extended by operating a button at the end of the pen opposite the tip. An amendment adding a limitation reciting that the tip is retracted by rotating a first portion of the body relative to a second portion would, under **Festo**, strictly limit the claim to that particular mechanism, to the exclusion of even the most closely equivalent mechanism.

A better approach would be to add a limitation reciting that the element is retracted by a mechanism other than a push button at the opposite end of tip. The latter claim would cover a pen that retracted the tip, for example, using the identical internal mechanism as used in your client's pen but actuated by sliding a first portion of the pen body (such as a sleeve) relative to a second portion of the body (or by rotating a sleeve relative to a unitary body). By contrast the amendment first discussed would not cover such a pen literally and under **Festo** could not be found to cover the pen under the DOE, even if it were possible to prove that the differences are insubstantial.

Draft Claims with Discrete Elements/Limitations and Amend, if Necessary, by Adding New and Separate Elements/Limitations. All claims are single, run-on sentences. [FN14] In light of **Festo**, however, it may be advisable to present claims in the form of a series of discrete "elements" and "limitations," with each "element" and "limitation" set out in a separate subparagraph, to the extent practical, as opposed to presenting the entire claim as one large paragraph. Attorneys and courts tend to think of each subparagraph as a separate "element" or "limitation." Under **Festo**, no range of equivalents under the DOE is available for a "limitation" that was amended during prosecution.

[FN15] Therefore, one should strive to break each claim out into as many separate "elements" and/or "limitations" as possible. [FN16]

This practice is consistent with the applicable patent rules for the format of claims, which provide that each element or step should be separated by a line indentation and that subparts of elements or steps may be set off by further line indentations. [FN17] As a general rule, you should hit the ***17** "enter" or "return" key at a minimum after every punctuation mark in your claim. This will provide an indication to those reviewing the prosecution history in the future that you considered each subparagraph to stand on its own. This may insulate the "elements" or "limitations" contained in subparagraphs that are not amended from being affected by an amendment to a limitation in an adjacent subparagraph.

In amending, if possible add new "elements" (or "limitations") as clearly separate clauses set off from the rest of the claim by punctuation and carriage returns. This may result in only the added portion being found subject to the complete estoppel found in **Festo**.

If You Must Amend and an Office Action Is Outstanding, Interview First. Before making any amendment for a reason related to patentability, you should call the examiner first to identify the absolute minimum response required to get the claim allowed. If possible, have the examiner review and tentatively approve any amendment prior to filing. Since any amendment you make will likely give rise to an absolute estoppel with respect to the limitations added or modified, it is important that you amend the claim only to the extent necessary to ensure allowance. You certainly would not want to make an amendment that the examiner considers not sufficient to get the claim allowed, as that would probably still give rise to an absolute estoppel with respect to the amended limitations if the claim is later allowed, without having gained anything.

Conclusion

Whatever its merits, the **Festo** case requires that careful thought be given to its impact on patent prosecution practice. The author believes the strategies discussed here will ensure the broadest patent protection possible in the face of the uncertainty engendered by the **Festo** decision, both in terms of whether the decision itself will stand and what it may foretell regarding the future vitality of the DOE.

[FNa1]. William James is an associate at Van Pelt & Yi LLP in Los Altos, CA. He is currently on sabbatical in Mexico under a Fulbright Binational Business Grant.

[FN1]. 234 F.3d 558 (Fed. Cir. 2000) (en banc).

[FN2]. See **Festo, 234 F.3d at 564**.

[FN3]. Id.

[FN4]. **Festo, 234 F.3d at 566-568**.

[FN5]. Id. at 568-569.

[FN6]. Id. at 569-578.

[FN7]. Id. at 578. The court held it did not need to reach the fifth question certified for rehearing, which was whether the DOE had been used to essentially eliminate an element from the claims at issue, contrary to the so- called "all elements" rule. 234 F.3d at 578.

[FN8]. See, e.g., Hughes Aircraft Co. v. United States, 717 F.2d 1351 (Fed. Cir. 1983) (adopting so-called "flexible bar" approach to determining range of equivalents available there prosecution history estoppel applied), overruled by **Festo, 234 F.3d at 574**.

[FN9]. In re Donaldson, 16 F.3d 1189, 1194-1195 (Fed. Cir. 1994) (en banc) (holding PTO must limit its interpretation of means-plus-function claims to structural equivalents); accord Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, 6, 65 Fed. Reg. 38510-38516 (June 21, 2000).

[FN10]. KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1359-1360.

[FN11]. Note that if the recited function were amended, that action probably would give rise under **Festo** to an absolute estoppel with respect to the coverage that may otherwise have been available under the DOE for equivalent functions. See, e.g., Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1364 (Fed. Cir. 2000) (accused device may infringe means plus function claim under DOE if substantially the same function performed).

[FN12]. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc).

[FN13]. B. Braun Medical, Inc. v. Abbott Lab., Inc., 124 F.3d 1419, 1424 (Fed. Cir. 1997).

[FN14]. Manual of Patent Examining Procedure (MPEP) 608.01(m).

[FN15]. 234 F.3d at 569-578.

[FN16]. As the **Festo** court noted, there is much confusion among attorneys and judges regarding the terms "element" and "limitation." 234 F.3d at 564 n.1. Unfortunately, the court's resolution, positing that "element" should be used only to refer to an aspect of an accused device and "limitation" used exclusively to refer to "words in a claim" does not really clarify the matter. Id. The court acknowledges it did not follow this convention in framing its questions for rehearing en banc in this very case. Id. In addition, courts have used the term "element" to refer to words in a claim for years. The patent rules and the Manual for Patent Examining Procedure also use the term "element" to refer to parts of a claim. See, e.g., 37 C.F.R. 1.75(i); MPEP 608.01(m). This nomenclature may become more important after **Festo**, as the **Festo** court speaks of an absolute estoppel with respect to an amended "limitation." 234 F.3d at 569-578. It will remain for future courts to establish more precisely how one defines the boundaries of a "limitation" for these purposes. The author herein uses "element" to refer to a major subdivision of the claimed invention, typically set off from other parts of the claim by punctuation and/or indentation. See 37 C.F.R. 1.75(i); MPEP 608.01(m). Under the author's convention, a "limitation" is one or more words contained within an element by which the element is limited. Under this convention, an entire element is a limitation but the term limitation may also be used to refer to only part of an element.

[FN17]. 37 C.F.R. 1.75(i); MPEP 608.01(m).
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