--- F.3d ---

Only the Westlaw citation is currently available.

United States Court of Appeals, Federal Circuit.
MYCOGEN PLANT SCIENCE, INC., and Agrigenetics, Inc., Plaintiffs-Appellants,
v.
MONSANTO COMPANY, Defendant-Appellees.
No. 00-1127.
May 30, 2001.

Suit was brought alleging infringement of patent entitled "Synthetic Insecticidal Crystal Protein Gene." The United States District Court for the Southern District of California, Napoleon A. Jones, Jr., J., granted summary judgment to alleged infringer, and patent owner and licensee appealed. The Court of Appeals for the Federal Circuit, Bryson, Circuit Judge, held that: (1) collateral estoppel applied to claim construction and to finding of alleged infringer's reduction to practice prior to patent owner, based on prior suit involving child patents of the patent at issue; (2) collateral estoppel did not apply to issues of patent owner's prior conception and diligent reduction to practice, or to claim of invalidity of patent as not enabled; (3) there were issues of fact precluding summary judgment on alleged infringer's claim of prior invention; (4) defendant could not be liable as an infringer for selling products containing genes made before the patent issued, even though the products were sold after the patent issued; and (5) prosecution history estopped patent owner from relying on the doctrine of equivalents to show infringement of certain claims.
Affirmed in part, reversed in part, and remanded.
See also, 243 F.3d 1316.

This court recently held in ***Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558, 563, 56 USPQ2d 1865, 1868 (Fed.Cir.2000)***, that "an amendment that narrows the scope of a claim for any reason related to the statutory requirements of a patent will give rise to prosecution history estoppel with respect to the amended claim element." In this case, the product claims were not amended. Instead, the initial claims defining the synthetic gene by a broadly specified DNA sequence were cancelled and replaced with claims containing a more narrowly specified DNA sequence. The more narrowly specified claims then issued with the '831 patent. We do not discern any legally significant difference between canceling a claim having a broad limitation and replacing it with a claim having a narrower limitation, and amending a claim to narrow a limitation. To do so would place form over substance and would undermine the rules governing prosecution history estoppel laid out in ***Festo*** by allowing patent applicants simply to cancel and replace claims for reasons of patentability rather than to amend them. This notion is not new, as this court has previously treated canceling and replacing claims as analogous to amending them. *See* *Haynes Int'l, Inc. v. Jessop Steel Co., 8 F.3d 1573, 1578-79, 28 USPQ2d 1652, 1656-57 (Fed.Cir.1993)*. In fact, some of the "amendments" at issue in ***Festo involved cancellations. 234 F.3d at 588, 56 USPQ2d at 1887***.
***13** [17] On appeal, Mycogen does not argue that the district court erred in concluding that the cancellation of the product claims with the broad DNA sequence in favor of claims with a more narrowly defined DNA sequence gave rise

to prosecution history estoppel. Instead, Mycogen argues that despite the estoppel the district court erred when it did not hold that claims 13 and 14 were entitled to some range of equivalents. That argument, however, is at odds with our decision in ***Festo.*** When a claim amendment (or in this case the cancellation of a claim with a broad limitation in favor of one with a narrower limitation) creates prosecution history estoppel, *no* range of equivalents is available for the amended claim limitation. ***Festo, 234 F.3d at 564, 56 USPQ2d at 1868***. Accordingly, we affirm the district court's ruling that Mycogen is estopped from asserting the doctrine of equivalents with respect to claims 13 and 14.

Each side shall bear its own costs for this appeal.

AFFIRMED IN PART, REVERSED IN PART, AND REMANDED.

C.A.Fed. (Cal.),2001.