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LOWER COURTS' FESTO INTERPRETATIONS ARE INCREASING UNCERTAINTY, ATTORNEYS TOLD

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Federal district courts are interpreting the Federal Circuit's landmark **Festo** ruling in some unexpected ways, which has compounded the uncertainty the decision has created for patent attorneys, attendees were told at a recent Association of Patent Law Firms roundtable session.

"This is pretty frightening stuff," said Steven I. Weisburd of Ostrolenk, Faber, Gerb & Soffen in New York, who gave the one-hour presentation via conference call to attorneys from APLF's 21 member firms, as well as general counsel who were invited to participate.

The presentation included analysis of the Federal Circuit's decision in **Festo** Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd. et al., discussion of subsequent district court and Federal Circuit opinions interpreting **Festo,** and advice for attorneys who are litigating patent cases or prosecuting patent applications in the wake of **Festo.**

(Editor's Note: **Festo** Corp. filed a petition for a writ of certiorari with the U.S. Supreme Court April 9. See story on P. 10. of this issue.)

In **Festo, 234 F.3d 558, 586, 56 USPQ 2d 1865, 1886** (Fed. Cir., 2000), the en banc Federal Circuit said that when a patent applicant amends a claim element such that "prosecution history estoppel" is created, the applicant cannot later claim that element was infringed under the doctrine of equivalents. The decision also clarified that prosecution history estoppel-- also known as "file wrapper estoppel"--is created whenever a claim element is amended for any statutory reason related to the patentability of an invention, not just for the purpose of avoiding prior art.

The decision has turned the once-routine give-and-take process between the applicant and the patent examiner into a nerve-wracking experience for patent prosecutors.

"You used to freely amend claims to make things more clear. Now, that's dangerous," Weisburd said. Even seemingly minor and inconsequential amendments, if they are not adequately explained in the prosecution record, can trigger **Festo**'s bar on the doctrine of equivalents, he said.

In Pioneer Magnetics Inc. v. Micro Linear Corp., No. 00-1012 (Fed. Cir., Jan. 20, 2001), the Federal Circuit said that in the absence of a clear explanation for why a claim element was amended, the presumption will be that the amendment was made for statutory purposes, and the **Festo** bar on the doctrine of equivalents will be triggered, Weisburd said.

That ruling should serve as a clear warning to anyone prosecuting a patent application that any ambiguity in the "file wrapper" will be held against him or her, he said.

During prosecution, he said, "never make a change to a claim element that's unexplained, unless you already know the change is going to create **Festo** estoppel."

Lower Court Applications of **Festo**

In Molton Metal Equipment Innovations Inc. v. Metaullics Systems Co., No. 1:97cv02244 (N.D. Ohio, Apr. 20, 2001), the U.S. District Court for the Northern District of Ohio held that **Festo** applied in a case where the claims at issue in the litigation (the "asserted claims") included certain limiting language from the outset, but identical limiting language had been added to one of the non-asserted claims. In other words, certain language limiting the asserted claims to a "non-volute pump chamber" was present in the original application and had never been amended during prosecution. However, the "non- volute pump chamber" limitation had been added to another claim, which was not at issue in the litigation, to overcome the examiner's prior art rejection.

"Under the doctrine of equivalents, [there is] no reason to assign different ranges of equivalents for the identical term used in different claims in the same patent, absent an unmistakable indication to the contrary," the Molton Metal court wrote. "Thus, if **Festo** applies to claim 19, and if 'non-volute' as it appears in that claim is entitled to no range of equivalents, then 'non- volute' as it appears in any claim is entitled to no range of equivalents."

"I never thought I'd see that," Weisburd commented.

If a patent applicant cancels dependent claims that were rejected by the examiner, and rewrites them in independent form, will **Festo** apply? The U.S. District Court for the District of Delaware said "yes" in Honeywell International Inc. v. Hamilton Sundstrand Corp., No. 1:99cv00309 (D. Del., Apr. 20, 2001). However, the court's conclusion that the broader claims were not surrendered might conflict with two **pre-Festo** Federal Circuit decisions, so the issue remains clouded, Weisburd said.

The third case Weisburd mentioned in his presentation was Aclara Biosciences Inc. v. Caliper Technologies Corp., 125 F. Supp. 2d 391 (N.D. Cal., 2000), in which the U.S. District Court for the Northern District of California held that

Festo estoppel must be applied individually to each of the limitations in a particular claim, rather than to the claim as a whole.

Using a hypothetical scenario, Weisburd said, under the Aclara interpretation, **Festo** would not apply when a patent applicant claims a chair with "straight legs made of wood," amends the claim to cover "straight legs made of oak" and then relies on equivalents to claim infringement by a chair with "slightly curved legs made of oak."

Festo and Patent Prosecution

Weisburd concluded the presentation with suggestions for patent prosecutors:

. Thoroughly research the prior art before filing your application;

. Include some independent claims that clearly distinguish the invention from prior art, even if these claims are narrower than you would like;

. Make greater use of multiple independent claims;

. Whenever possible, state that an amendment broadens a claim element (or at least does not narrow that element);

. Whenever possible, clearly state that an amendment was made for purposes unrelated to statutory concerns;

. When appropriate, try to convince the patent examiner to issue an examiner's amendment in which he or she states that the amended language does not change or narrow the scope of the claim;

. Never make narrowing amendments that are not required by the examiner; and

. Never make a change to a claim element that is left unexplained in the patent prosecution record.

APLF is planning to file an amicus brief in support of **Festo** Corp.'s petition for a writ of certiorari from the U.S. Supreme Court. The brief is due by May 9.

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