

Drafting Patent Applications after *Festo* and *Johnson & Johnston*

By

Bruce D. Sunstein
Bromberg & Sunstein LLP¹
Boston

- I. The Patent Landscape After *Festo* and *Johnson & Johnston*
 - A. *Festo* has narrowed conditions under which a claim will be found to cover structures urged as equivalent by barring equivalents where an element has been amended

Following the decisions in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000)(*en banc*), *cert. granted*, 533 U.S. 915 (2001), and *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.*, 285 F.3d 1046 (Fed. Cir. March 28, 2002)(*en banc*), the doctrine of equivalents has been forever altered. The doctrine of equivalents, developed over a period of centuries, in cases like *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), is an equitable doctrine that is invoked to prevent copying of a patented invention while avoiding the literal scope of the patent claims:

“[C]ourts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though

¹ Copyright © 2002 Bromberg & Sunstein LLP. The author’s e-mail address is bsunstein@bromsun.com.

adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.”

Graver Tank, 339 U.S. at 607.

When a claim has been amended to overcome prior art in the course of prosecution, the scope of equivalents accorded to the claim is typically narrowed by the doctrine of file wrapper estoppel. Historically, file wrapper estoppel has been applied in a flexible manner, and the extent by which the scope of equivalents is deemed narrowed by a claim amendment will depend on the circumstances. *Hughes Aircraft Co. v. United States*, 717 F.2d 1351 (Fed.Cir.1983)(*Hughes I*); *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449 (Fed.Cir.1998) (file wrapper estoppel only bars recapture of that subject matter actually surrendered).

By the time of the *Festo* decision, the doctrine of equivalents had already modified by the Supreme Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). Under *Warner-Jenkinson*, first of all, the doctrine of equivalents was contracted: it was not to be applied to the invention as a whole, but rather on an element-by-element basis: “thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.” 520 U.S. at 29.

Also under *Warner-Jenkinson*, file wrapper estoppel was expanded by creation of a new rebuttable presumption. “Where no explanation is established [for a claim amendment], however, the court should presume that the patent applicant had a substantial reason related to patentability for including the limiting element added by amendment. In those circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents as to that element. The presumption we have described, one subject to rebuttal if an appropriate reason for a required amendment is established, gives proper deference to the role of claims in defining

an invention and providing public notice, and to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application. In accordance with this presumption, when the prosecution record is silent as to the reason for a change to the claims, the presumption arises that the change was made for "a substantial reason related to patentability." *Warner-Jenkinson*, 520 U.S. at 33-34.

The Federal Circuit in *Festo* has essentially made irrebuttable the presumption established by the Supreme Court that a claim amendment is for patentability reasons, with the effect that any amendment of a limitation in a claim, even if voluntary, and even if not to overcome prior art, will bar the application of the doctrine of equivalents to the claim element in question. *Festo*, 234 F.3d at 566 (any amendment for "any reason which relates to the statutory requirements for a patent" [original emphasis]), 568 (even if a voluntary amendment), 569 (complete bar applied), 578 (bar also applied in absence of explanation for amendment).

B. *Johnson & Johnston* has barred use of equivalents to cover subject matter disclosed but not claimed in a patent.

What the Federal Circuit did in *Festo*, it did more of in *Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.* *Johnson & Johnston* involved a patent having claims to a printed circuit board with an aluminum substrate. The patent disclosed the use of aluminum and other materials for a substrate, including stainless steel, but claimed only aluminum. The accused infringer used stainless steel, and at trial was found liable for infringement under the doctrine of equivalents. The Federal Circuit held that "when a patent drafter discloses but declines to claim subject matter, as in this case, this action dedicates that unclaimed subject matter to the public" and therefore the doctrine of equivalents is not available to the patent holder for such subject matter. 285 F.3d at 1054. *Johnson & Johnston* thus places further limits on the doctrine of equivalents.

Collectively, the effect of the Federal Circuit decisions in *Festo* and *Johnson & Johnston* has been to dramatically curtail the scope of the doctrine of equivalents. While the Supreme Court might well reverse *Festo*², one does not hear much urging to reverse *Warner-Jenkinson*. So if *Festo* is reversed, we are still likely to have equivalents applied only on an element-by-element basis and a rebuttable presumption against equivalents when a claim element has been amended.

II. Patent drafting strategies for dealing with narrowed equivalents

An environment that is hostile to the doctrine of equivalents requires the conscious use of patent drafting and prosecution strategies to obtain coverage comparable to what might have existed in the good old days before *Warner-Jenkinson*, *Festo*, and *Johnson & Johnston*. We list below some claim strategies that have been suggested in various contexts for achieving broader coverage.

- A. Avoid file wrapper estoppel with respect to claims. If file wrapper estoppel is avoided, then the doctrine of equivalents can be applied.
 - 1. Provide some claims that might well be allowed without rejection: include some independent claims that are narrow. This increases the odds that estoppel will be avoided, because the narrower claims are

² The *amicus* brief of the Institute of Electrical and Electronics Engineers, attached as Appendix 1, suggests a test for applying file wrapper estoppel to a claim amendment only if “the limiting effect of the amended language with respect to an accused device would have been foreseeable at the time of the amendment.” IEEE brief at 18. The Court expressed some interest in this standard at oral argument of the *Festo* appeal. Perhaps not coincidentally, Judge Rader offered a justification for the Federal Circuit’s reasoning in *Johnson & Johnston* a “reconciling principle” that “the doctrine of equivalents does not capture subject matter that the patent drafter reasonably could have foreseen during the application process and included in the claims.” 285 F.3d at 1056.

more likely to be allowed without amendment.

2. Seek allowance without amendment of claims. Even if more responses to more office actions are required to obtain an allowance of claims without amendment, the reward of no file wrapper estoppel may justify the extra effort.
 3. Know the prior art before you file; this will help you to craft claims that are more likely to survive without amendment.
 4. Consider a multiple filing strategy. A first application might have a narrow set of claims designed for garnering allowance without amendment, and a second application could go for greater breadth, albeit with a greater risk of requiring an amendment.
 5. If possible, attempt to characterize your amendments as not narrowing and not for purposes of patentability. (Remember, if unexplained, it is presumed for purposes of patentability.)
- B. Use means-plus-function claims to avoid file wrapper estoppel. Means-plus-function claims under 35 U.S.C § 112, paragraph 6, are by statute directed to structures disclosed for performing the claimed function and their equivalents. On the scope of means-plus-function claims, see *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303 (Fed. Cir. 1998).
1. Because only known structural equivalents are covered, state the structural alternatives

broadly in the application. But watch out for unclaimed subject matter under *Johnson & Johnston!*

- a. Explain the function.
 - b. Explain the range of ways of carrying out the function.
 - c. Use figures to show the basic configuration claimed, as well as more detailed embodiments. (This is in general a good tip, frequently ignored. If the most basic configuration is illustrated, the patent is more easily asserted against a wider variety of structures.)
2. Make the record clear that you intend the means-plus-function claims to be such! *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed.Cir.1997).
 3. Note the distinctions between means-plus-function claims and coverage under the doctrine of equivalents. See *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, above, and *Odetics, Inc. v. Storage Technology Corp.*, 185 F.3d 1259 (Fed. Cir. 1999); *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999).

- a. Only structural equivalents existing at the time of patent issuance are covered by a means-plus-function claim.
- b. Function of the structure offered as equivalent must be identical to what is disclosed in a means-plus-function claim.
- c. Overall structural equivalence is sufficient with a means-plus-function claim, and structure need not be analyzed by components.

C. Method claims have an important purpose in this context.

- 1. Processes carried on can often differentiate systems that are otherwise relatively similar.
- 2. Method claims can also potentially eliminate structures that would have to be in device or system claims.

In conclusion, successful patent prosecution strategies in the wake of cases narrowing the doctrine of equivalents involve many facets: mixing of plain language, means-plus-function, and method claims, providing a figure that shows broadly what the invention is, as well as more specific embodiments, disclosing equivalent structures, and seeking to ensure that all equivalent structures are claimed.

Appendix 1