

# LITIGATORS CORNER:

## Does Festo Change Patent Prosecution?



BY JOSEPH N. HOSTENY,  
OF NIRO, SCAVONE,  
HALLER & NIRO

*Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago*

*law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Listed in Who's Who, Mr. Hosteny was recently named to the Board of Editors of Patent Strategy & Management (a monthly publication of American Lawyer Media), for which he will also be writing periodic guest columns. In addition, an article quoting him appeared in the November, 1999 issue of Entrepreneur Magazine. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at [jhosteny@hosteny.com](mailto:jhosteny@hosteny.com), or by visiting his web site at <http://www.hosteny.com>.*

**W**hat does Festo mean to patent litigators? In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) (en banc), the court decided that the doctrine of equivalents did not apply to any claim that was amended for any reason. So, right now, thanks to Festo, the doctrine of equivalents is dead, dead, dead — perhaps the ultimate culmination of a narrowing that has occurred in the last decade or so. We patent litigators hope the Supreme Court will take the case and restore the doctrine to life.

The *Festo* decision is troubling to litigation attorneys for several reasons. In addition to being hostile to the doctrine of equivalents, the court is skeptical of juries, and doesn't think too much of their ability to understand and decide. For instance, one concurring opinion refers to the "game," to "convince the trier of fact,

typically a jury, that even an accused product does not infringe the claims as written, the claimed invention and the accused product have only 'insubstantial differences,' a wonderfully indeterminate phrase, lending itself to making every decision under the doctrine an individualist choice, if not simply a flip of the coin." This statement disregards the effort that district courts put into drafting good jury instructions. It is hard to imagine less respect for a jury.

The *Festo* decision is also critical of attorneys for stretching the doctrine beyond its limits. Another concurring opinion refers to "clever attorneys," and clearly believes that their abuse of the doctrine of equivalents is a reason to support its elimination. It is too bad that the innocent among us have to be executed along with the guilty.

I say that the doctrine of equivalents is dead if an amendment is made for "any reason," because that is what the opinion really means, even though it **purports** to limit its rule only to narrowing amendments made for reasons of patentability." While *Festo* says that the only amendments that preclude use of the doctrine of equivalents are purportedly those that are made for purposes of "patentability," the decision court did not say anything that in any way limited "patentability." It is an open-ended term that has very broad meaning.

The opinion answered the first *en banc* question affirmatively: Any reason "affecting the issuance of a patent" is related to patentability. The opinion says that if the amendment has anything to do with the "statutory requirements for a patent," it relates to patentability. As examples, but not limitations, the court referred to §§101, 102, 103 and 112. It gave no example of any amendment that might be made for a reason not related to patentability. The absence of examples of non-patentability amendments, combined with the broad language about "statutory requirements," signify that any amendment is made for patentability. All amendments, therefore, are going to result in loss of the doctrine of equiva-

lents. It goes without saying that we now have a new issue to fight about in lawsuits, as if we didn't have enough to fight about already.

As we all know, it is common for an examiner to reject an independent claim under §102 or §103. In many such rejections, however, an examiner may often comment that a dependent claim would be allowable if rewritten in independent form. A dependent claim includes all the limitations of the independent and any intervening claims. In other words, if the independent claim has limitations A, B, C, and D, and the dependent claim recites E, then the limitations of the dependent claim are A, B, C, D, and E. Everyone knows that.

Rewriting a dependent claim like this into independent form therefore does not add or remove any limitations. As a result of rewriting the dependent claim, however, it is unquestionably amended. There is no doubt that the rewriting and amending was done for reasons related to patentability: if rewritten, the claim is allowable. *Festo's* rule means, however, that the resulting issued independent claim cannot be infringed under the doctrine of equivalents, unless you can prove that it was not a "narrowing" amendment. That isn't much comfort; change one word, and you will give rise to an argument that you "narrowed" the claim. In *Festo*, claims were amended because they were in improper multiple dependent form. That amendment was enough to deny the doctrine of equivalents.

### WAYS AROUND FESTO

There may be ways around this, but there is no clear-cut solution. **The first possibility is to change the claiming strategy.** Many prosecuting attorneys will file an application with a few independent claims, and with many dependent claims. One reason for doing so is to get a range of claims from broad to narrow. Another reason is to avoid the filing costs associated with independent claims. But, perhaps *Festo* is a reason to change. A new claiming strategy might be to file an application with numerous independent claims, ranging from broad to narrow. An examiner might then be able to allow one or more narrow independent claims without amendment. The independent claim is without the baggage of an amendment, and therefore has at least the possibility of being applied under the doctrine of equivalents.

A disadvantage of this technique is that it increases the expense of prosecuting a patent application, and most patent applicants are pretty budget-minded when it comes to patent applications. That is a mistake, because decisions made in prosecution to save a few dollars can greatly magnify litigation costs later on.

There may be another way to avoid an “amendment” when an examiner has rejected a dependent claim, while indicating that it would be allowable if rewritten in independent form. The solution may be to avoid amending the dependent claim, or the independent claim. Instead of amending either the dependent or the independent claim to incorporate the limitations of the other, cancel the dependent claim and replace it with a new independent claim. I have seen patent applications using both techniques in the past, and *Festo* is a reason to employ cancellation with submission of a new claim rather than amendment. In other words, make underlining and brackets a thing of the past. But *Festo* suggests that this tactic is not risk-free.

Perhaps I am putting form ahead of substance. So be it. One of the opinions in *Festo* agrees that there is “fine tuning” of claim language during prosecution, and that these changes evidence no intent to alter the scope of the invention. Another of the opinions gives another example, correcting an antecedent basis. Nevertheless, the rule established by the majority in *Festo* ignores these concerns, puts no limit on what is related to patentability, and means that even these cosmetic changes can have very bad consequences. Yet another opinion – there were a lot of opinions – stated that the claims at issue in *Festo* had been rejected because they were in improper multiple independent form, and that correction of this minor problem resulted in loss of the doctrine of equivalents.

**Second, get the allowed claim or claims out of the case as quickly as possible.** It may be appropriate to file a continuation with the unallowed claims so that the allowed claims suffer the least from further arguments and discussion during the prosecution of the remaining claims. Again, this increases expense. If there are two patents, there are two sets of maintenance fees, etc.

**Third, means plus function clauses may have recovered from their death bed.** The means clause covers the structure disclosed in the specification for per-

forming the function, and equivalents of that structure. Had you written this clause in other than means plus function form, and then amended it, you would have no equivalents at all. The decision in *Festo* contemplates that means-plus-function language can be broader: “Thus, a claim amendment that replaces means-plus-function language with language reciting the corresponding structure narrows the literal scope of the claim.”

**Fourth, don’t file a patent.** Use trade secret protection, if possible, as I pointed out in my column of August, 2000 (“Patent or Trade Secret: Which One is Best?”). Some of the comments in *Festo* recognize that one unfortunate effect of the majority decision will be to encourage inventors to keep their inventions secret, if possible. One comment in *Festo* is that the unavailability of the doctrine of equivalents “creates a perverse incentive for patent applicants” to abandon patent applications and employ trade secret protection. Trade secrets don’t have as one of their goals the increase of public knowledge, but that isn’t your job. Protecting your client’s interests is.

*Festo* results from a perception that, because the doctrine of equivalents has

been abused by a few who are excessively clever, the doctrine must therefore be made unavailable to all. Not much equity in that. Judge Newman says it best on nearly the last page of this very long opinion:

Equivalency is a judge-made response to the pernicious literalism of the system of claiming, not an enlargement of the scope of the invention.

She is right, but Judge Newman was not in the majority, so we must live with *Festo*. My vantage point is litigation, not prosecution, and I want to litigate clean and enforceable patents.

So my message to patent prosecution attorneys – in light of *Festo* – is: Think about changing your claiming strategy. Carefully read your claims to avoid simple errors like multiple dependencies or improper antecedents. Get allowed claims out of prosecution, and issued, as quickly as possible. Consider renewed use of means plus function claims. Finally, think harder about whether your client is better protected by trade secrets rather than a patent. **IPT**

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P.U. FROM OCTOBER 00, PG. 45

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