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## Supreme Court Takes Another Look At Doctrine of Equivalents

In *Festo v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, \_\_U.S.\_\_(2002), the U.S. Supreme Court recently waded into one of the murkiest areas of patent law, the Doctrine of Equivalents (“DOE”). Stated simply, the DOE allows a patent to cover an accused device which does not come within the literal scope of the patent claims, provided the accused device is an “equivalent” of the claimed invention. The archetype is an accused device using a screw to perform a certain function which likely would be considered the equivalent of a patent claiming a bolt to perform that function. A traditional limitation on the DOE is that if the patentee amends the claims during the prosecution of the patent, then the application of the DOE may be limited for the claim element(s) so amended. This limitation on the DOE is known as “prosecution history estoppel” or “file history estoppel.”

In *Festo*, the Federal Circuit held that any time a patentee amended the claims during prosecution for reasons related to patentability, then there would be an absolute bar to the application of the DOE and the claim element(s) so amended would not be entitled to any range of equivalents. This “absolute bar” approach caused considerable concern among patent holders and patent attorneys and was a marked change in the law. Thus it comes as no surprise that the Supreme Court chose to review this opinion. The Supreme Court found that the Federal Circuit had gone too far. Rather than imposing an absolute bar to the DOE for claim elements which are amended, the Supreme Court spelled out a “flexible bar” approach. The Court held that prosecution history estoppel would apply to limit the DOE for amended claims unless the patentee could:

“show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.”

Although the Supreme Court may have spared patentees the full brunt of the “absolute bar” standard, the Supreme Court’s standard appears to be rather onerous itself. First, the Supreme Court’s holding is far from clear and may require many opinions from lower courts to flesh out the new standard. Second, other than technology developed after the patent was filed, it may be rare to find technology which one skilled in the art could not reasonably be expected to identify and cover in the patent claims during the prosecution process.

The bottom line is that in the prosecution of patent applications, *Festo* will require greater efforts and foresight of inventors and patent attorneys if inventors are to maximize their patent protection. In litigation, *Festo* is likely to make the outcome of patent infringement lawsuits less predictable than they already are. While many people consider *Festo* a fair outcome, the decision certainly did nothing to simplify a highly complex and unpredictable area of the law.

*Remember that these legal principles may change and vary widely in their application to specific factual circumstances. You should consult with counsel about your individual circumstances. For further information regarding these issues, contact:*

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