

No. 07-1066

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In the Supreme Court of the United States

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FESTO CORPORATION,

*Petitioner,*

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO.,  
LTD., A/K/A SMC CORPORATION AND SMC  
PNEUMATICS, INC.,

*Respondents.*

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On Petition For Writ Of Certiorari to the  
United States Court of Appeals for the Federal  
Circuit

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**BRIEF OF FÉDÉRATION INTERNATIONALE  
DES CONSEILS EN PROPRIÉTÉ  
INDUSTRIELLE AS AMICUS CURIAE IN  
SUPPORT OF PETITIONER**

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## INTEREST OF AMICUS CURIAE

Pursuant to Supreme Court Rule 37, Fédération Internationale Des Conseils En Propriété Industrielle (“FICPI”) submits this brief as amicus curiae in support of Petitioner Festo Corporation.<sup>1</sup> All parties were notified of FICPI’s intent to file this brief at least ten days prior to its due date and their consents to this filing are separately attached.

Established in 1906, FICPI is a Switzerland-based international and non-political association of approximately 4,000 intellectual property attorneys from over eighty countries, including the United States. FICPI’s members represent individual inventors as well as large, medium and small companies. One of the members’ major roles is to advise inventors in intellectual property matters and secure protection for industrial innovation. FICPI supports predictable, balanced global protection of patents, the global harmonization of substantive patent law, and the interests of inventors and the U.S. Patent and Trademark Office (“the PTO”) for recognizing a fair scope of patent protection consistent with the claimed invention.

FICPI is concerned with the pernicious erosion of the doctrine of equivalents via prosecution history estoppel in recent years. In 2001, FICPI filed an amicus brief supporting the Petitioner and opposing

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<sup>1</sup> Pursuant to Supreme Court Rule 37.6, counsel for Amicus Curiae certifies that this brief was not written in whole or in part by counsel for any party, and that no person or entity other than Amicus Curiae or its counsel has made a monetary contribution to the preparation or submission of this brief.

the Federal Circuit's imposition of a "Complete Bar Rule." *Brief of Amicus Curiae Fédération Internationale Des Conseils En Propriété Industrielle in Support of Petitioner, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo VIII)*, 535 U.S. 722 (2002) (Brief filed: Aug. 30, 2001). Now, some seven years after this Court struck down that rule in favor of a more measured approach, numerous decisions of the Federal Circuit have shown that its retreat from the Complete Bar Rule is in name only. Each of the three exceptions that this Court carved out have steadily been whittled away to be virtually meaningless.

FICPI's members rely on the doctrine of equivalents in drafting patent language, and in advising clients involved in patent infringement lawsuits and licensing transactions. Because many of its members are foreign practitioners, FICPI has a unique perspective on the global impact of the diminishing viability of the doctrine of equivalents in the United States. In this vein, FICPI desires to ensure that its members' clients are afforded a fair scope of protection for their inventions, and therefore respectfully submits this brief in support of the petition for certiorari.

## INTRODUCTION AND SUMMARY OF ARGUMENT

The Doctrine of Equivalents, though necessarily limited, is “important for the proper protection of patentable inventions.” *Int’l Visual Corp. v. Crown Metal Mfg. Co., Inc.*, 991 F.2d 768, 774 (Fed. Cir. 1993). Without the ability to prevent competitors from copying, inventors would have little incentive to file for a patent, which serves the purpose of granting an inventor a limited monopoly in exchange for full disclosure to the public. To be meaningful, a patent claim’s monopoly extends beyond the literal terms of a claim to encompass all equivalents that perform the same function in substantially the same way to achieve the same result as the claimed invention.

On the other end of the scale, however, the doctrine of equivalents must be limited in a way that permits useful secondary innovation and does not expand the inventor’s rights beyond what is equitable. One of the most controversial of these limitations is prosecution history estoppel.

A patent serves an important public notice function, allowing the public to examine the language of a claim and its file history in order to design a competing product that does not infringe. A number of rules exist to prevent inventors from utilizing the doctrine of equivalents to unfairly expand their monopoly power. Among them, the doctrine of prosecution history estoppel provides that any amendments to the claims during the prosecution of the patent made in response to a patentability-related rejection are presumed to cede from the claimed invention all territory between the

original claim and the amended claim. Recognizing the potential harm that would be effected upon patentees and the patent system by a complete bar on the doctrine of equivalents in such a situation, however, the Court in *Festo VIII* set forth three criteria which, if any are satisfied, would except a patent from this harsh rule. In the intervening years since that decision, however, the Federal Circuit has emasculated each of the potential exceptions, effectively reinstating the complete bar in cases where a narrowing amendment is found in the file history. Most recently, the Federal Circuit has undermined the “foreseeability” criterion by holding that mere knowledge of the existence of a structure prior to an amendment is sufficient to render it a foreseeable equivalent. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo XIII)*, 493 F.3d 1368, 1381-82 (Fed. Cir. 2007).

This result goes directly against the Supreme Court’s rejection of the Complete Bar Rule, and also has severely negative public policy ramifications. Specifically, the de facto complete bar diminishes the value of thousands of issued and unexpired patents, thereby decreasing the efficacy of the patent system as an engine of innovation. This Rule, and the associated weakening of the doctrine of equivalents gives inventors an incentive to engage in various dilatory prosecution tactics that greatly increase the costs of obtaining patent protection and compound the workload backlogs faced by the Patent Office. The Court should act resolutely to undo some of the harm wrought by the Federal Circuit in this area of the law and grant the petition for writ of certiorari.

**ARGUMENT**

The Patent Act confers upon inventors the “right to exclude others from profiting by the patented invention.” *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 215 (1980). In exchange for a limited monopoly, inventors must describe their inventions in “full, clear, concise, and exact terms.” *Festo VIII*, 535 U.S. at 731 (quoting 35 U.S.C. § 112). However, due to the inherently imprecise nature of the written word, “[t]he language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty.” *Id.* “The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy.” *Topliff v. Topliff*, 145 U.S. 156, 171 (1892). As a result, it has long been established that the “scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.” *Festo VIII*, 535 U.S. at 732 (citing *Winans v. Denmead*, 56 U.S. (15 How.) 330 (1854)); accord *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950).

However, the scope of the judicially-created doctrine of equivalents has been carefully tailored over the course of decades of jurisprudence to ensure that inventors cannot unfairly expand the frontier of their monopoly to the detriment of the public and the inventing community. Besides the doctrine of prosecution history estoppel, several other limitations have been crafted in an attempt to achieve an equitable balance between providing

adequate protection for inventors and encouraging free competition and secondary innovation.<sup>2</sup>

Prosecution history estoppel is one of the most venerable limitations to the doctrine of equivalents and the one that has been litigated in the instant case for almost twenty years. The purpose of prosecution history estoppel is to prevent a patentee from claiming subject matter surrendered during prosecution of a patent. *See Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995). This Court has held that any amendment made during prosecution for a reason related to patentability triggers a presumption that the patentee surrendered “the territory between the original claim and the amended claim.” *Festo VIII*, 535 U.S. at 740. Nonetheless, the Court unanimously rejected the notion that prosecution history estoppel acts as a complete bar to application of the doctrine of equivalents to an amended element. *Id.* at 737.

The Court instead set forth three scenarios which, if satisfied, would rebut the presumption of estoppel: (1) the equivalent was unforeseeable at the time of the amendment; (2) the rationale underlying the amendment bears no more than a tangential relation

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<sup>2</sup> For example, the all limitations rule requires that the accused device have an equivalent for every limitation contained in the claim. *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987). Under the public dedication doctrine, if an inventor discloses a range of possible equivalents in the patent’s specification but does not claim all of them, the unclaimed equivalents are deemed to have been dedicated to the public. *Johnson & Johnston Assoc. v. R. E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002).

to the equivalent in question; and (3) some other reason suggesting that the patentee could not have reasonably been expected to have described the substitute in question. *Festo VIII*, 535 U.S. at 740-741.

**I. The Federal Circuit Has Improperly and Against This Court’s Precedent Re-Established the Complete Bar Rule by Systematically Eliminating Each of the Three “Exceptions” Thereto**

The Federal Circuit, seemingly displeased with the Court’s decision in *Festo VIII*, started the process of dismantling the three exceptions immediately upon remand by limiting the evidence that may be introduced with respect to the latter two to the prosecution history. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo X)*, 344 F.3d 1359, 1370 (Fed. Cir. 2003). In the intervening four plus years, numerous cases have shown that those exceptions are all but impossible for patentees to prove.<sup>3</sup>

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<sup>3</sup> The Petitioner states that the Federal Circuit has never found an equivalent to be unforeseeable and set forth a long list of cases in which the patentee has failed to overcome its burden of proving one or more of the exceptions. Pet. at 18 fn.2 and accompanying text. FICPI is likewise unaware of any such cases and directs the Court’s attention to two more Federal Circuit decisions that found equivalents to be foreseeable: *Ranbaxy Pharm., Inc. v. Apotex, Inc.*, 350 F.3d 1235 (Fed. Cir. 2003); *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352 (Fed. Cir. 2003).

A. The Tangential Relation Criterion Is Severely Limited

The Federal Circuit has stated on several occasions that “the tangential relation criterion for overcoming the Festo presumption is very narrow,” purposefully limiting the inquiry to the file history alone. *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 480 F.3d 1335, 1342 (Fed. Cir. 2007). In no uncertain terms, Judge Rader expressed his disdain for the criterion, calling it impossibly ambiguous and questioning whether the only two Federal Circuit cases that have held an amendment to be tangential were even correctly decided. *Id.* at 1346-48 (Rader, J., concurring). “[T]he factual circumstances that could give rise to the tangential rebuttal principle will very rarely occur (even less often successfully).” *Id.* at 1348.

B. The Residual “Some Other Reason” Criterion Is Virtually Meaningless

As for the residual “some other reason” criterion, FICPI is unaware of any Federal Circuit decision which has found the test satisfied to rebut the presumption of estoppel. *See, e.g., Amgen v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1313 (Fed. Cir. 2006) (citing *Festo X*, 344 F.3d at 1370) (“[T]he third way to rebut the Festo presumption, the ‘some other reason’ route, is a narrow one.”).

C. After *Festo XIII*, It Is Foreseeable that the Foreseeability Criterion as Analyzed by the Federal Circuit Will Never Be Satisfied

The sole surviving criterion, which asks whether an equivalent was foreseeable at the time of the presumption-causing amendment, has been dealt a mortal wound in *Festo XIII*. 493 F.3d at 1382. By holding that “[a]n equivalent is foreseeable [at the time of the amendment] if one skilled in the art would have known that the alternative existed in the field of art as defined by the original claim scope, even if the suitability of the alternative for the particular purposes defined by the amended claim scope were unknown,” the Federal Circuit has eliminated the foreseeability criterion as a viable means of overcoming the presumption of estoppel and reinstated the absolute bar. Specifically, it is difficult to conceive of a situation where an equivalent would not be known in the field of an invention for *some* purpose.

**II. The Federal Circuit’s Decision to Divorce an Equivalent’s Purpose from the Inquiry as to Its Foreseeability Is both Illogical and Unjust.**

Without the ability to overcome prosecution history estoppel, the pendulum of rights swings drastically away from patentees and the doctrine of equivalents becomes all but a dead letter. *See also* John R. Allison & Mark A. Lemley, *The (Unnoticed) Demise of the Doctrine of Equivalents*, 59 Stan. L. Rev. 955, 967 (2007) (finding through an empirical study of all 413 decisions turning upon the doctrine

of equivalents between May 1999 and August 2005 that the patentee prevailed in only 29 instances—about 7% of the time).

A. The Foreseeability Criterion Must Be an Equivalent for the Intended Purpose.

Logic dictates that without a tie to an intended purpose, the foreseeability of an equivalent article becomes coextensive with the imagination. Any material, from cardboard to carpeting could be said to have been known in the art at the date of the amendment, yet be completely foreign to a person of ordinary skill in the art standing in the inventor's shoes at the time of the narrowing amendment. *See Festo XIII*, 493 F.3d at 1385-86 (Newman, J., dissenting) (“If persons of ordinary skill in this field cannot be charged with foreseeing that an aluminum alloy sleeve would be a technological equivalent to a magnetizable metal sleeve, then the aluminum sleeve does not meet the criterion of foreseeability.”)

B. The Complete Bar Rule Is Unfair to the Inventing Community

The doctrine of equivalents and prosecution history estoppel are each firmly rooted in equity. *See Festo X*, 344 F.3d at 1367. Equity demands that a party to be estopped is cognizant of the factual circumstances surrounding his act that results in the waiver of rights. *See Am. Elec. Lab., Inc. v. U.S.*, 774 F.2d 1110, 1113 (Fed. Cir. 1985) (holding that in the related doctrine of equitable estoppel, the party to be estopped must be aware of the facts). The doctrine of equivalents protects an inventor from losing the benefit of the invention simply because the inventor

was unable to predict advances in scientific knowledge. *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1310 (Fed. Cir. 1998). Thus, the Federal Circuit has recognized that it may be unfair to penalize an inventor for failing to claim an equivalent based on a technological advance occurring after a narrowing amendment takes place. *Id.* at 1311. The rationale applies with equal force with respect to equivalents which, at the time of amendment, were unknown to be useful in the context of the claimed invention. In either case, the critical element of knowledge is missing. There cannot be an “estoppel” without an intentional, knowing act or omission.

In the case at bar, it was undisputed that a person of ordinary skill in the art at the time of the narrowing amendment would have been unaware that an aluminum sleeve performed the same magnetic shielding function as a magnetizable sleeve. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo XI)*, 2005 WL 1398528, at \*7 (D. Mass. June 13, 2005). Given this fact, Festo could not have known (or intended) that a non-magnetizable sleeve, such as aluminum, was an equivalent useful for purposes of its invention. Therefore, Festo should not be penalized for its lack of knowledge.

### **III. The Federal Circuit’s Post-*Festo VIII* Jurisprudence Detrimentally Affects the Patent System by Dangerously Narrowing the Doctrine of Equivalents**

Under the guidance of the Federal Circuit, the prosecution history estoppel inquiry consists of three

questions. *Festo X*, 344 F.3d at 1366 (citing *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1356 (Fed. Cir. 2003)). First, a court must determine whether the inventor filed a amendment narrowing the scope of her claims. *Id.* If so, the second inquiry is whether the reason for the narrowing amendment was substantially related to patentability. *Id.* Under *Warner-Jenkinson*, the amendment is presumed to be substantially related to patentability unless the patentee can prove otherwise using only the prosecution history. *Id.* Finally, if the patentee is unable to meet this burden and the narrowing amendment is found to be substantially related to patentability, the patentee must struggle against the *Festo VIII* presumption of estoppel by attempting to fit into one of the three enumerated exceptions. *Id.* at 1366-67.

In today's patent prosecution environment, applications that issue into patents are commonly amended. One recent empirical study found that approximately 40% of issued patents are subject to at least one amendment, "generally to make them narrower." Mark A. Lemley & Bhaven N. Sampat, *Is the Patent Office a Rubber Stamp?* 42 (Stanford Pub. Law and Legal Theory Working Paper Series, Research Paper No. 999098, July 2007), [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=999098](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=999098). Thus, patentees of a large percentage of issued patents are as a practical matter precluded from asserting the doctrine of equivalents.

A. The Expansion Of Prosecution History Estoppel Greatly Reduces the Value of Patents and Encourages Copying

The narrowing of the doctrine of equivalents has a number of adverse impacts on the patent system. As factual scenarios that would allow a patentee to escape the presumption of prosecution history estoppel have proven to be practically non-existent under the Federal Circuit's jurisprudence, a patentee's ability to harness the doctrine of equivalents is drastically limited. This is particularly troubling, because as this Court has noted, without the doctrine of equivalents, the rights conferred by a patent grant would be "a hollow and useless thing." *Graver Tank*, 339 U.S. at 607.

A weak doctrine of equivalents permits copyists to come closer to literal infringement. A competitor can examine the prosecution history, and if any narrowing amendment is discovered, the competitor is free to exploit the patent disclosures by copying the entire invention, making only minor modifications to fall outside the literal scope of the claims. The presumptive burden against the patentee in such a case practically ensures the competitor that a patent infringement suit filed against it will fail. This dramatically lowers the utility of the patent system, and is particularly harmful in certain complex fields where the number of potential analogues to a patented invention is the greatest.

For example, in the context of pharmaceutical patents, drug companies generally file broad claims that are amended during prosecution. Examiners frequently require pharmaceutical compound claims

to be defined by their formulations, which must be described in the specification. *See* 35 U.S.C. § 112. No matter how thorough a patentee is in including lists of potential formulations, however, there are always equivalents that may be left out. Under the Federal Circuit's recent jurisprudence, it appears unlikely that narrowed claims would benefit from the doctrine of equivalents, and a competitor can dodge the patent by simply marketing a product that incorporates the same active ingredient but uses an excipient, or vehicle, that is not expressly included in the claim. *See Smithkline Beecham Corp. v. Excel Pharm., Inc.*, 356 F.3d 1357 (Fed. Cir. 2004) (holding that although the allegedly infringing product contained the same active ingredient, it used an excipient that was not listed in the amended claim, and therefore the doctrine of equivalents would be barred by prosecution history estoppel unless the patentee could prove that the competitor's excipient was not foreseeable at the time of amendment). Biotechnology patents would suffer similar harm, as a competitor may circumvent a nucleotide or amino acid sequence claim that has been subject to amendment simply by changing a single element.

This is not only an unfair usurpation of the inventor's expectations and rights, but also a perversion of the public notice function served by patents—the very function that prosecution history estoppel is meant to safeguard. An amendment in a patent's prosecution history now becomes a scarlet letter, outlawing the patentee from accessing the doctrine of equivalents and encouraging predation by opportunistic imitators.

B. The Elimination of the Doctrine of  
Equivalents Increases Costs to both  
Inventors and the Patent Office

Second, the patent prosecution process will be detrimentally affected. Because any amendment to the claims creates a virtually irrefutable presumption against the inventor, patent prosecutors have a greater incentive to file arguments, and appeals if necessary, rather than amend claims. If the arguments are rejected, patentees will more readily seek the filing of continuation applications rather than risk relinquishing any rights. Similarly, inventors will utilize more independent claims in the original application in order to avoid any adverse presumption if any amendments are needed. *See also Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131 (Fed. Cir. 2004) (en banc) (holding that the rewriting of dependent claims into independent form coupled with the cancellation of the original independent claims creates a presumption of prosecution history estoppel). Independent claims are more expensive and time-consuming to prosecute. Also, *Festo XIII's* narrowing of the foreseeability exception increases an inventor's incentive to include laundry lists of possible equivalents in the specification and claims, further increasing the time spent prosecuting and examining a patent application. Finally, after a patent subject to amendment is issued, a patentee seeking to prevent a competitor from skirting around the language of the claims may seek a broadening reissue patent to obtain literal coverage, rather than taking any chances with the doctrine of equivalents.

In sum, all of these effects lead to greatly increased prosecution costs to obtain effective patent protection, not to mention greatly increased work for the already overstretched examiners at the Patent Office.<sup>4</sup> Individual inventors and small companies are disproportionately harmed, as they are likely poorly equipped to absorb the increased prosecution costs, and will suffer inferior protection for their innovations as a result.

## CONCLUSION

For the foregoing reasons, this Court should grant the Petition for a writ of *certiorari*.

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<sup>4</sup> See U.S. Government Accountability Office, U.S. PATENT AND TRADEMARK OFFICE – Hiring Efforts Are Not Sufficient to Reduce the Patent Application Backlog, Report to the Ranking Member, Committee on Oversight and Government Reform, House of Representatives 1 (Sept. 4, 2007),

<http://www.gao.gov/new.items/d071102.pdf> (“[I]ncreases in both the volume and complexity of patent applications have lengthened the amount of time it takes the agency to process them. As a result, the inventory of patent applications that have not yet been reviewed, called the backlog, has been growing for over 15 years—since fiscal year 2002 alone, the backlog has increased by nearly 73 percent to about 730,000 applications.”).