

THE REST OF THE STORY: THE SUPREME COURT'S DECISION IN *FESTO*

On May 28, 2000, the United States Supreme Court issued its unanimous decision, written by Justice Anthony Kennedy, that the patent world had been anxiously awaiting. In short, the doctrine of equivalents is alive. The Supreme Court vacated the Federal Circuit's judgment and remanded the case for further proceedings consistent with its opinion.¹ In agreement with the Federal Circuit, the Supreme Court held that prosecution history estoppel arises from any amendment that narrows a claim to comply with the Patent Act, not only from amendments made to avoid the prior art.² In other words, "[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope."³ Cosmetic amendments and other amendments concerning the form of the application do not narrow the patent's scope and do not raise a prosecution history estoppel.⁴

The Supreme Court did not agree with the Federal Circuit in its rule regarding the extent of the surrendered subject matter. Going back to the rationale it espoused in *Warner-Jenkinson*⁵ for the rule that the patent holder bears the burden of proving that an amendment was not made for a reason that would give rise to estoppel, the Court agreed with the approach argued by the United States in its Brief as Amicus Curiae.⁶ In doing so, the Court held that the patent holder also should bear the burden of overcoming the presumption that the amendment surrenders the particular equivalent in question.⁷

An amendment might not be viewed as the patent holder's surrender of a particular equivalent in certain types of cases, such as: where (i) the equivalent was unforeseeable at the time of the application; (ii) the rationale underlying the amendment bears but a tangential relation to the equivalent; or (iii) some other reason exists suggesting that the patent holder could not reasonably be expected to have described the insubstantial substitute in question.⁸ To

overcome the presumption that equivalents were surrendered in these types of cases, patent holders must show that – at the time of the amendment – one skilled in art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.⁹

Because the amendments in *Festo* were made for reasons relating to patentability, the remaining question for the Federal Circuit or the District Court of Massachusetts is whether *Festo* can show that the narrowing amendments did not surrender the particular equivalents at issue.¹⁰ The remaining question for the patent world is the same: whether patent holders in future cases will be able to rebut the presumption that equivalents were surrendered?

¹ *Festo Corp. v. Shoketsu Kinzoku Kabushiki Co., Ltd.*, No. 00-1543, 2002 WL 1050479, at *13 (U.S. May 28, 2002).

² *Id.* at *9-*10.

³ *Id.* at *10.

⁴ *Id.*

⁵ *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997).

⁶ *Festo Corp.*, 2002 WL 1050479, at 12.

⁷ *Id.*

⁸ *Id.*

⁹ *Id.* at *13.

¹⁰ *Id.*