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THE SUPREME COURT'S COMPLICITY IN FEDERAL CIRCUIT FORMALISM

Timothy R. Holbrook†

I. INTRODUCTION

Congress created the United States Court of Appeals for the Federal Circuit in 1982 to bring greater uniformity to the country's patent laws.¹ Drawing on this purpose, the Federal Circuit has expanded this call for uniformity by also emphasizing the need for predictability and certainty in the law. The court thus has articulated fairly formalistic approaches to a number of issues. The use of bright-line rules, however, is often at the cost of fairness. In the area of property law, Professor Carol Rose highlighted this tension, and noted the historical, pendulum-like shifts between clear, hard-edged, "crystal" rules and uncertain "muddy" rules that afford greater fairness.² Professor Chisum identified this same tension in patent law in his important piece, published in this journal in 1998, coining the phrase "the Fair Protection-Certainty Conundrum."³

The Federal Circuit increasingly has articulated rules of law to promote certainty, at the expense of fairness. The root of this bias likely derives from the court's Congressional mandate to promote uniformity and certainty in patent law.⁴ This rules-based approach, however, is not without critics. Professor Jay Thomas recently detailed the evolution of this shift to formal, simplistic rules, noting

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1. S. REP. NO. 97-275, at 7 (1981), *reprinted in* 1982 U.S.C.A.N. 11, 12.

2. See Carol M. Rose, *Crystals and Mud in Property Law*, 40 STAN. L. REV. 577, 577-79 (1988).

3. Donald E. Chisum, *The Scope of Protection for Patents After the Supreme Court's Warner-Jenkinson Decision: The Fair Protection—Certainty Conundrum*, 14 SANTA CLARA COMPUTER & HIGH TECH. L. J. 1 (1998).

4. See, e.g., *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1359 (Fed. Cir. 1999) ("We apply Federal Circuit law to patent issues in order to serve one of the principal purposes for the creation of this court: to promote uniformity in the law with regard to subject matter within our exclusive appellate jurisdiction").

that this approach may in fact impair innovation, not facilitate it.⁵ Professor Arti Rai also has expressed the view that such formalism impairs innovation policy.⁶ This Essay posits, however, that not all of the blame should fall on the Federal Circuit's shoulders. The Supreme Court has expressly encouraged this approach in its recent patent jurisprudence. This Essay will first identify the various ways in which the Federal Circuit has opted for the "certainty" side of the Fair Protection-Certainty Conundrum. Next, the Essay surveys recent Supreme Court cases which show that the Supreme Court has enabled this shift, making the Court complicit in the Federal Circuit's formalism agenda.

II. FORMALISM AT THE FEDERAL CIRCUIT

The tendency towards crystal rules at the Federal Circuit transcends any particular issues in patent law. For example, in the context of the on-sale bar to patentability under 35 U.S.C. § 102(b), the court has required that, to be "on-sale," the invention must have been subject to a formal commercial offer to sell, as defined by general principles of contract law.⁷ Similarly, the court requires a formal commercial offer for infringement under 35 U.S.C. § 271(a)'s "offer to sell" form of infringement.⁸ The court reasoned under both of these scenarios that the requirement of a formal commercial offer would facilitate greater certainty in the respective law.⁹

The Federal Circuit has articulated formalistic rules in the context of the written description requirement for patents on genes. The court generally requires the disclosure of the entire genetic sequence,¹⁰ although recently the court appears to have liberalized this

5. John R. Thomas, *Formalism at the Federal Circuit*, 52 AM. U. L. REV. 771, 774-75 (2003).

6. See generally Arti K. Rai, *Engaging Facts and Policy: A Multi-Institutional Approach to Patent System Reform*, 103 COLUM. L. REV. 1035 (2003).

7. *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1047 (Fed. Cir. 2001). For criticism of this standard, see Timothy R. Holbrook, *Liability for the "Threat of a Sale": Assessing Patent Infringement for Offering to Sell an Invention and Implications for the On-Sale Patentability Bar and Other Forms of Infringement*, 43 SANTA CLARA L. REV. 751, 780-84 (2003) [hereinafter Holbrook, *Threat of a Sale*].

8. *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1254-55 (Fed. Cir. 2000); see generally Holbrook, *Threat of a Sale*, *supra* note 7.

9. *Group One*, 254 F.3d at 1047 (noting court's interest in bringing "greater certainty" to the on-sale bar of the law by requiring formal commercial offers); *Rotec*, 215 F.3d at 1254-55 (relying on the on-sale bar standard to define § 271(a)'s "offer to sell").

10. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1567-68 (Fed. Cir. 1997); see generally Janice M. Mueller, *The Evolving Application of the Written Description Requirement to Biotechnological Inventions*, 13 BERKELEY TECH. L.J. 615 (1998).

harsh standard by allowing some functional description, so long as the structure that performs that function is known in the art field.¹¹ The court has also turned its attention to obviousness.¹² Whereas the Supreme Court's test for obviousness identified four relevant factors,¹³ the Federal Circuit has elevated a fifth factor as a bright-line requirement—the need for some teaching or motivation to combine prior art references to yield the claimed invention.¹⁴

Two key areas, however, most dramatically highlight the Federal Circuit's formalistic agenda—claim construction and the doctrine of equivalents. One of the most significant steps the Federal Circuit took towards formalism was removing the jury from the most important step in a patent infringement suit—the construction of the claim language. In *Markman v. Westview Instruments*, the court concluded that claim construction is a pure matter of law to be decided by the judge and, consequently, reviewed on appeal *de novo*.¹⁵ The clear motivating factor behind this step was to eliminate, or at least minimize, the role of juries in patent cases, with the hope that greater certainty and predictability would result.¹⁶

The doctrine of equivalents, however, has remained the court's favorite avenue for impressing its formalistic agenda. The Federal Circuit entered the fray surrounding the doctrine of equivalents in *Pennwalt Corp. v. Durand-Wayland, Inc.*¹⁷ The court held that the doctrine of equivalents required an “element-by-element comparison.”¹⁸ The court reiterated the traditional tripartite,

11. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 964 (Fed. Cir. 2002) (“[T]he written description requirement would be met for all of the claims of the ‘659 patent if the functional characteristic of preferential binding to *N. gonorrhoeae* over *N. meningitidis* were coupled with a disclosed correlation between that function and a structure that is sufficiently known or disclosed”).

12. See 35 U.S.C. § 103 (2000) (precludes patents on inventions that are “obvious” in light of the prior art). In other words, patents will not be granted on trivial innovations.

13. Specifically, the scope and content of the prior art, the differences between the relevant claim and the prior art, the level of ordinary skill in the art, and secondary indicia of non-obviousness, such as commercial success, long felt but unsolved need, and the failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

14. See, e.g., *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1288 (Fed. Cir. 2002); see also Thomas, *supra* note 5, at 773.

15. 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc).

16. See Craig Allen Nard, *Process Consideration in the Age of Markman and Mantras*, U. ILL. L. REV. 355, 359-61 (2001).

17. 833 F.2d 931 (Fed. Cir. 1987) (en banc).

18. *Id.* at 935.

“function-way-result,”¹⁹ but went on to note that, because each claim element is essential, “the plaintiff must show the presence of every element or its substantial equivalent in the accused device.”²⁰ The court thus first articulated the All-Elements Rule in applying the doctrine of equivalents, a formalistic rule.

The specter of uncertainty continued to surround the doctrine of equivalents, however. The court subsequently revisited the issue en banc in *Hilton Davis Chemical Co. v. Warner-Jenkinson Company*.²¹ In what was arguably a victory for the anti-formalists, the court concluded, in a splintered decision, that infringement under the doctrine is a question of fact for the jury, subject to deference on appeal.²² The court also decided that equivalency was available in all cases, and the triple identity test was not the exclusive standard for assessing equivalency.²³ Instead, the key inquiry for equivalency was whether the accused device was insubstantially different from the claimed invention.²⁴ The triple identity helps inform this inquiry, but it is not the sole test available.²⁵

After *Hilton-Davis*, the courts’ attention turned away from the substance of the doctrine of equivalents itself and looked to formalizing the legal limitations on the doctrine. For example, the Federal Circuit recently held en banc that an equivalent that is disclosed in the patent specification, but not claimed, falls into the public domain, precluding coverage under the doctrine of equivalents.²⁶ The court has used a similar specification disclaimer

19. *Id.* at 934. The Supreme Court articulated this test in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) (“[A] patentee may invoke this doctrine to proceed against the producer of a device ‘if it performs substantially the same function in substantially the same way to obtain the same result’”).

20. *Pennwalt*, 833 F.2d. at 935. For the argument that the Supreme Court altered the *Pennwalt* test, see *infra* note 38.

21. 62 F.3d 1512 (Fed. Cir. 1995) (en banc). Professor Chisum identified two schools at the Federal Circuit regarding the doctrine of equivalents that lead to the court taking *Hilton Davis* en banc. The first school viewed the doctrine as available in every case, and not an exception; the test for equivalency was the tripartite “function-way-result” test, and the ultimate determination of infringement by equivalents was a fact question for the jury. Chisum, *supra* note 3, at 14-15. The second school viewed the doctrine as available only in exceptional cases, that the triple identity test was not the exclusive test, and that a judge must determine if an equitable threshold had been crossed in order to apply the doctrine. *Id.* The ultimate outcome in *Hilton Davis* was a mixture of these schools.

22. *Hilton Davis*, 62 F.3d at 1522.

23. *Id.*

24. *Id.* at 1521-22.

25. *Id.* at 1522.

26. *Johnson & Johnston Assocs. Inc. v. R.E. Service Co.*, 285 F.3d 1046, 1054-55 (Fed. Cir. 2002) (en banc).

principle to preclude the application of the doctrine of equivalents where the patentee, in the specification as opposed to the prosecution history, surrenders relevant subject matter by explicitly disclaiming coverage of a given embodiment.²⁷

The most recent—and audacious—shift to crystal rules occurred in the Federal Circuit's en banc decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, which addressed the appropriate scope of prosecution history estoppel.²⁸ There, the court concluded that any amendment to a claim precludes *all* equivalents as to that added claim limitation. The court essentially eviscerated the protection afforded by the doctrine of equivalents—which is intended to provide a level of fairness to the patentee—if the inventor made an amendment to a claim, a rather routine event during prosecution of a patent application. As such, the Federal Circuit's approach dramatically lessened, if not eliminated, the availability of the doctrine of equivalents to patent holders.

III. THE SUPREME COURT—FACILITATING FORMALITY

The Federal Circuit has promoted an agenda favoring the creation of bright-line legal rules which arguably aggrandize power at the appellate level and which create unfairness to various parties for the sake of certainty in the law. The court, however, is not the court of last resort for patent cases; its decisions are still subject to discretionary review by the Supreme Court. In the view of Professor Mark Janis, however, this review effectively is non-existent.²⁹ In his view, the court in essence has abdicated its role in substantive patent

27. See, e.g., *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1345 (Fed. Cir. 2001); *Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1382-83 (Fed. Cir. 2000). This principle appears to be an estoppel of sorts, where the words of the patentee are held against her. See, e.g., *Vehicular*, 212 F.3d at 1382 (“Finally, to the extent that Tractech employees may have testified that they did not believe a back-up spring was necessary for satisfactory performance, that testimony is contradicted by the clear statements to the contrary in the ‘015 patent”). Technically, though, this doctrine is not prosecution history estoppel because the disclaimer is contained in the specification as filed; the surrender of subject did not occur by claim amendment or arguments made to the Patent Office.

28. 234 F.3d 558, 56 U.S.P.Q.2d 1865 (Fed. Cir. 2000) (en banc). Prosecution history estoppel precludes a patentee from obtaining coverage under the doctrine of equivalents of subject matter he surrendered while prosecuting the patent before the Patent Office. *Id.* at 564.

29. Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. Ill. L. Rev. 387; see also Rai, *supra* note 5, at 1038 n.4 (“Notably, because the Supreme Court, at least historically, has rarely reviewed Federal Circuit cases, the Federal Circuit's formalist jurisprudence has typically constituted the final word on patent questions.”); see also Thomas G. Field, *The Role of Stare Decisis in the Federal Circuit*, 9 FED. CIR. B.J. 203, 223 (1999) (explaining why the Supreme Court does not perform exacting review of the Federal Circuit).

law to the Federal Circuit by its invisibility. It is true that many of the patent cases taken by the Supreme Court are “patent cases” only in the sense that they involve a patent; rarely do they involve substantive patent law.³⁰ But Professor Janis speaks too strongly by suggesting that the Supreme Court has been invisible. To the contrary, although its decisions have been sparse, the Court has encouraged the Federal Circuit’s shift to formalism and bright-line rules in those substantive cases it has decided. Thus, its complicity is more than one of omission—the Supreme Court has actively encouraged the Federal Circuit’s drive towards bright-line rules. A review of the Supreme Court’s recent patent decisions elucidates this subtle prodding.

A. *Markman v. Westview Instruments—The Beginning*

The Supreme Court reviewed, and affirmed, the aforementioned Federal Circuit decision in *Markman*. Although it used slightly different reasoning, the Court ultimately concluded that claim construction was a question of law for the judge, not the jury.³¹ The reasoning of the Court, however, was more circumspect than the Federal Circuit’s. The Court recognized that claim construction is a “mongrel practice”³² and could contain factual considerations. The Court nevertheless concluded that a judge is the best actor to interpret a patent’s claims as a functional matter.³³ In reaching this conclusion, the Court emphasized the need for uniformity and certainty in the construction of patent claims.³⁴ Specifically, the Court reasoned that

Uniformity would, however, be ill served by submitting issues of document construction to juries. . . . [W]hereas issue preclusion could not be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive

30. The Supreme Court has reviewed a number of Federal Circuit patent cases, but those cases have involved procedural issues, *Nelson v. Adams USA, Inc.*, 529 U.S. 460 (2000), the Federal Circuit’s jurisdiction, *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826 (2002); *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800 (1988), state sovereign immunity, *College Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999), the intersection of two areas of intellectual property, *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 534 U.S. 124 (2001) (intersection of utility patents and plant patents), or the allocation of responsibilities in the patent system, *Dickinson v. Zurko*, 527 U.S. 150 (1999) (requiring Federal Circuit to apply APA standards of review to PTO determinations).

31. *Markman v. Westview Instruments*, 517 U.S. 370, 391 (1996).

32. *Id.* at 378. The use of such language lead to a split in authority at the Federal Circuit over the appropriate standard of review, which the court resolved in *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1454-55 (Fed. Cir. 1998) (en banc) (holding that claim construction is renewed de novo on appeal).

33. *Markman*, 517 U.S. at 388.

34. *Id.* at 390-91.

issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.³⁵

The Court thus drew upon the same reasoning favored by the Federal Circuit when it articulates its bright-line rules—the need for certainty and uniformity. The reasoning of the Court, therefore, added support for the Federal Circuit’s preference for crystal rules.

B. Warner-Jenkinson—*Further Encouragement of Formalism*

The Supreme Court also reviewed the Federal Circuit’s decision in *Hilton Davis*.³⁶ While reaffirming the continuing vitality of the doctrine of equivalents, the Court noted its concern that the doctrine “has taken on a life of its own that is unbounded by the patent claims,” thereby “conflict[ing] with the definitional and public-notice functions of the statutory claiming requirement.”³⁷ To combat this problem, the court adopted the All Elements Rule, which requires the doctrine to be applied on an element-by-element basis.³⁸ The Court also articulated a rebuttable presumption with respect to prosecution history estoppel: if the reason for an amendment is not known, the

35. *Id.* at 391.

36. Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997).

37. *Id.* at 28-29.

38. *Id.* at 41. Some commentators view this test as essentially the Court adopting the standard articulated in *Pennwalt*. See, e.g., Laura C. Wideman, Note: Warner-Jenkinson v. Hilton Davis: *Doctrine of Equivalents Clarified?*, 45 WAYNE L. REV. 271, 275 (1999) (discussing *Pennwalt* by stating that “[f]or each element, there must be a corresponding element in the accused device that performs substantially the same function, the same way, to obtain the same result”); Chisum, *supra* note 3, at 30 (“The Supreme Court’s ‘all elements’ approach to equivalency was adopted earlier by the 1988 Federal Circuit in the en banc *Pennwalt* decision . . .”). The Supreme Court’s test, however, is apparently narrower than *Pennwalt*’s. The *Pennwalt* test only applies the “way” portion of the tripartite test on a limitation-by-limitation basis. Warner-Jenkinson, in contrast, applies all three components of the test to the relevant claim limitation. See, e.g., *Warner-Jenkinson*, 520 U.S. at 40 (noting the inquiry of “whether a substitute element matches the function, way, and result of the claimed element”). Federal Circuit case law after *Pennwalt* confirmed that the all-elements rule was only relevant to the “way” portion of the triple identity test: “[a]lthough each claim limitation may not literally be found in the accused structure, the ‘substantially the same way’ prong of the *Graver Tank* test is met if an equivalent of a recited limitation has been substituted in the accused device.” *Coming Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989). The court further noted that the remainder of the triple identity test requires inquiry as to whether the accused device “performs substantially the same *overall* function to obtain the same *overall* result as the claimed invention.” *Id.* at 1258 (emphasis added). As such, the test articulated in *Warner-Jenkinson* is narrower than that of the Federal Circuit’s approach, seemingly adding more certainty to this area of the law.

court should presume the reason was related to patentability.³⁹ The patentee, of course, has the opportunity to rebut this presumption.⁴⁰ Again, the Court relies on the Federal Circuit's favorite mantras—certainty and public notice—to reach its decision in this case, perhaps further emboldening the Federal Circuit's efforts.

C. *Pfaff v. Wells Electronics—The Surprise and Perhaps Most Telling Case*

Perhaps the most surprising case reviewed by the Supreme Court over the past twenty years is *Pfaff v. Wells Electronics*.⁴¹ The case did not involve any constitutional issues, such as the right to a jury trial, and instead dealt strictly with the appropriate standard for the on-sale bar under 35 U.S.C. § 102(b), which precludes a patent if the invention was on sale in this country more than one year before an application for a patent is filed.⁴² The Court articulated a two-prong test for the bar: before the critical date,⁴³ the invention must be subject to a commercial offer to sell and must be ready for patenting, which can be demonstrated by a reduction to practice⁴⁴ of the invention or by diagrams sufficient to enable a person of skill in the art to make the invention.⁴⁵ The Court rejected the Federal Circuit's "substantially complete" standard in favor of the "ready for patenting test," recognizing that the Federal Circuit's approach "seriously undermines the interest in certainty."⁴⁶ Thus, in this case, the Court criticized the Federal Circuit for using a vague standard and, in its place, articulated a *more formalistic* approach. *Pfaff*, therefore,

39. *Warner-Jenkinson*, 520 U.S. at 33.

40. *Id.*

41. 525 U.S. 55 (1998); see generally Timothy R. Holbrook, *The More Things Change, the More They Stay the Same: Implications of Pfaff v. Wells Electronics, Inc. and the Quest for Predictability in the On-Sale Bar*, 15 BERKELEY TECH. L.J. 933 (2000) [hereinafter Holbrook, *More Things Change*].

42. 35 U.S.C. § 102(b) (2000).

43. The critical date is the date one year before the application date. In re Epstein, 32 F.3d 1559, 1564 n.5 (Fed. Cir. 1994) ("One year before the filing of the application is referred to as the 'critical date' for purposes of measuring the 'in public use or on sale' status").

44. "Reduction to practice" is a term of art in patent law that basically means that the inventor has constructed a physical, functional version of the invention. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376 (Fed. Cir. 1986) ("Actual reduction to practice requires that the claimed invention work for its intended purpose.") (citation omitted).

45. *Pfaff*, 55 U.S. at 67-68.

46. *Id.* at 65-66. The success of this approach in bringing certainty is questionable. See Holbrook, *More Things Change*, *supra* note 41, at 955-66.

demonstrates that, far from being invisible, the Supreme Court in fact is encouraging the formalistic tendencies of the Federal Circuit.⁴⁷

D. *Festo*—Turning Point or Outlier?

The Supreme Court also reviewed the Federal Circuit's decision in *Festo* and, in a move against formalism, rejected the bright-line, absolute surrender rule for prosecution history estoppel.⁴⁸ Instead, the Court articulated another presumption—courts should presume a complete surrender of equivalents unless the patentee can demonstrate that the equivalent was unforeseeable at the time of the amendment, that the amendment was only tangentially related to the asserted equivalent, or that for some other reason estoppel is inappropriate.⁴⁹ *Festo* potentially represents a shift in the Supreme Court's encouragement of Federal Circuit formalism. The Court seems to be communicating that the Federal Circuit had finally gone too far down the "certainty" side of the fair protection-certainty spectrum.

IV. CONCLUSION

Undisputedly, the Federal Circuit favors the use of bright-line rules that favor certainty over fairness. Recent Supreme Court cases demonstrate that it, too, favors such rules—but only up to a point. Indeed, the Supreme Court's decisions, with the exception of *Pfaff*, prefer to enhance certainty not by altering substantive rules of patent law but instead by implementing more procedural rules, such as the rebuttable presumptions of *Warner-Jenkinson* and *Festo*, or offering guidance to improve reviewability.⁵⁰ This procedural approach is perhaps the more appropriate middle ground, and *Festo* may represent the Court's efforts to rein in the Federal Circuit's penchant to articulate formalistic substantive rules. Whether that effort is successful remains to be seen. On remand in *Festo*, the Federal

47. See Thomas, *supra* note 5, at 780-81.

48. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002).

49. *Id.* at 740-41. Some commentators have suggested that this test is significantly different than the pre-*Festo*, flexible rule. See, e.g., Thomas, *supra* note 5, at 786. These same two concepts—foreseeability and tangentialness—were present in pre-*Festo* Federal Circuit case law. See *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1475, 1477 (Fed. Cir. 1998) (noting that accused device involved later-developed technology and that amendments overcame prior art significantly different than the claimed invention and the accused device, respectively).

50. See *Warner-Jenkinson*, 520 U.S. at 39 n.8 (suggesting special verdicts, summary judgment, and rigorous application of legal limitations to improve reviewability and certainty).

Circuit appears to have lessened its formalism to some extent.⁵¹ While concluding that prosecution history estoppel remains a question of law for the court,⁵² the court did recognize that rebuttal of the *Festo* presumption may involve factual issues, for which evidence outside of the public record may be required.⁵³ The Federal Circuit has also abandoned its formalistic approach to the *Warner-Jenkinson* presumption. Formerly, if the *Warner-Jenkinson* presumption applied, prosecution history estoppel barred all equivalents as to that limitation.⁵⁴ Now, pursuant to its most recent decision in *Festo*:

If, however, the court determines that a narrowing amendment has been made for a substantial reason relating to patentability—whether based on a reason reflected in the prosecution history record *or on the patentee's failure to overcome the Warner-Jenkinson presumption*—then the third question in a prosecution history estoppel analysis addresses the scope of the subject matter surrendered by the narrowing amendment.⁵⁵

The Federal Circuit thus has retreated, to a certain extent, from its harsh, formalistic tendencies, at least with respect to prosecution history estoppel. Time will tell if this represents a sea change in Federal Circuit thinking or merely a minor step off its formalistic path. Time will also tell if the Supreme Court will intervene in the future to ensure that the Federal Circuit does not stray too far down that path.

51. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003).

52. *Id.* at 1367.

53. *Id.* at 1369 (“Therefore, in determining whether an alleged equivalent would have been unforeseeable, a district court may hear expert testimony and consider other extrinsic evidence relating to the relevant factual inquiries”).

54. See *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 832 (Fed. Cir. 1999) (“Finding the Supreme Court’s language clear, we hold that in circumstances in which the *Warner-Jenkinson* presumption is applicable, . . . the prosecution history estoppel arising therefrom is total and completely ‘bars’ the application of the doctrine of equivalents as to the amended limitation”).

55. *Festo*, 344 F.3d at 1367 (emphasis added).



Donald S. Chisum, *The Scope of Protection for Patents after the Supreme Court's Warner-Jenkinson Decision: The Fair Protection-Certainty Conundrum*

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This Article reviews development of the doctrine of equivalents, culminating with the Supreme Court's last input on the doctrine in the 20th Century. It reminds us that the doctrine mediates a tension between the conflicting policy goals of fairness and certainty of claim scope. By emphasizing this policy "conundrum" was not amenable to bright line rules, the Article portends the then current state of the Doctrine after *Festo*.

Exemplary citations to the original article include:

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed. Cir. 2000).

Raj S. Dave, *A Mathematical Approach to Claim Elements and the Doctrine of Equivalents*, 16 HARV. J. LAW & TECH. 507 (2003).

Jason Schultz, *Intellectual Property: B. Patent: 3. Infringement: a) Doctrine of equivalents: Chiuminatta Concrete Concepts Inc. v. Cardinal Industries, Inc. & Dawn Equipment Co. v. Kentucky Farms, Inc.*, 14 BERKELEY TECH. L.J. 173 (1999).

John R. Thomas, *On Preparatory Texts and Proprietary Technologies: The Place of Prosecution Histories in Patent Claim Interpretation*, 47 UCLA L. REV. 183 (1999).

