

IN THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

---

FESTO CORPORATION,  
Plaintiff-Appellee,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD.,  
a/k/a SMC CORPORATION, and SMC PNEUMATICS, INC.,  
Defendants-Appellants.

---

On Remand from the Supreme Court of the United States  
After Appeal from the United States District Court  
for the District of Massachusetts, Saris, J.

---

**BRIEF FOR THE ASSOCIATION OF PATENT LAW FIRMS  
AS AMICUS CURIAE**

---

*Principal attorney of record:*  
JOSHUA R. RICH

*Of counsel:*  
PAUL S. TULLY  
S. RICHARD CARDEN  
*McDonnell Boehnen  
Hulbert & Berghoff*  
300 S. Wacker Drive  
Chicago, Illinois 60606  
(312) 913-0001

---

---

## CERTIFICATE OF INTEREST

Counsel for *amicus curiae* Association of Patent Law Firms certifies the following:

1. The full name of every party represented by me is:

Association of Patent Law Firms

2. The name of the real party in interest represented by me is:

Association of Patent Law Firms

3. All parent corporations and any publicly held companies that own 10% or more of the stock of the party represented by me is:

None

4. The name of all law firms and the partners or associates the appeared for the party represented by me in the trial court or are expected to appear in this court are:

Joshua R. Rich  
Paul S. Tully  
S. Richard Carden  
McDONNELL BOEHNEN  
HULBERT & BERGHOFF  
300 S. Wacker Drive  
Chicago, Illinois 60606

## TABLE OF CONTENTS

Argument .....	1
I. DETERMINATION OF <i>FESTO</i> ESTOPPEL IS A QUESTION OF LAW SOLELY FOR THE COURT .....	1
II. COURTS DETERMINING THE APPLICATION AND SCOPE OF <i>FESTO</i> ESTOPPEL SHOULD APPLY THE FACTORS SET FORTH BY THE SUPREME COURT, VIEWED THROUGH THE PRISM OF THE PATENT PROSECUTION PROCESS .....	5
Conclusion .....	10
Certificate of Compliance .....	11
Certificate of Service .....	12

## TABLE OF AUTHORITIES

### Cases

<i>Adelberg Labs., Inc. v. Miles, Inc.</i> , 921 F.2d 1267 (Fed. Cir. 1990) .....	3
<i>Cybor Corp. v. FAS Techs., Inc.</i> , 138 F.3d 1448 (Fed. Cir. 1998) .....	4
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i> , 122 S. Ct. 1831 (2002) .....	<i>passim</i>
<i>Haynes Int’l, Inc. v. Jessop Steel Co.</i> , 8 F.3d 1573 (Fed. Cir. 1993), <i>on reh’g</i> 15 F.3d 1076 (Fed. Cir. 1994) .....	3
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996) .....	2
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) .....	1, 2, 7
<i>Pitney Bowes, Inc. v. Hewlett-Packard Co.</i> , 182 F.3d 1298, 1309 (Fed. Cir. 1999) .....	5, 6, 7
<i>WMS Gaming, Inc. v. International Game Tech.</i> , 184 F.3d 1339, 1347 (Fed. Cir. 1999) .....	4

### Regulations

37 C.F.R. § 1.111 .....	6
-------------------------	---

## ARGUMENT

As the Supreme Court of the United States sought to do in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 122 S. Ct. 1831 (2002), this Court must strike a balance between the application of the doctrine of equivalents, an issue of fact for a jury, and prosecution history estoppel, an issue of law for the court. The proper balance, considering Seventh Amendment concerns, existing allocation of duties between the court and finder-of-fact, and issues of practicality, requires a court to determine as a question of law both whether a narrowing amendment is of the type that would bar application of the doctrine of equivalents (hereinafter, “*Festo* estoppel”) and the scope of such an estoppel. In doing so, the court should consider primarily intrinsic evidence, but should have discretion to receive extrinsic evidence of the knowledge of one of ordinary skill in the relevant art at the time of filing of the amendment at issue. The court should use that information to decide materiality, foreseeability, and other issues.

### **I. DETERMINATION OF *FESTO* ESTOPPEL IS A QUESTION OF LAW SOLELY FOR THE COURT**

The determination of *Festo* estoppel, like other questions of construction of patent documents, should be made by the court as a question of law. Both this Court and the Supreme Court have had occasion to consider who should construe patent documents and determine the scope of the patent right. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370

(1996). Both courts found that claim construction, including prosecution history estoppel – of which *Festo* estoppel is one form – is a question of law solely for the court. Indeed, because the issues to be resolved in relation to *Festo* estoppel are almost identical to other claim construction issues, they are especially appropriate for resolution as questions of law.

In *Markman*, the Supreme Court recognized that the very type of exercise required to determine the application and scope of *Festo* estoppel was especially appropriate for the court:

The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis. Patent construction in particular is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be.

517 U.S. at 388-89 (citation omitted); *see also Markman*, 52 F.3d at 987

(analogizing claim construction to statutory interpretation). The Court reached the issue, and the conclusion that claim construction is a question of law, because it found (after extended inquiry) that the Seventh Amendment does not require a jury to resolve the issue. 517 U.S. at 376-84. In addition, the Court found an important value in obtaining a court's uniform interpretation of claim terminology. *Id.* at 390. "Uniformity would, however, be ill served by submitting issues of document construction to juries." *Id.* at 391. The Supreme Court thus found that practical

issues and the existing allocation of burdens between the court and jury suggested claim construction should be a question of law, and the Seventh Amendment did not prohibit it. *Id.* at 372.

Because prosecution history estoppel is part of claim construction, and *Festo* estoppel is one aspect of prosecution history estoppel, *Markman* further dictates that *Festo* estoppel should be resolved as a question of law. Indeed, the Supreme Court recognized in *Festo* that issues of prosecution history estoppel are subsumed in claim construction as a question of law. *Festo*, 122 S. Ct. at 1838 (“Estoppel is a rule of patent construction that ensures that claims are interpreted by reference to those that have been cancelled or rejected.” (internal quotations omitted)).

Although this is a different analysis from other estoppels, which are questions of fact, there is an important reason for the distinction. Other estoppels require *subjective* reliance by a party; prosecution history estoppel is an *objective* doctrine, based on the public’s need to be able to rely on an inventor’s representations during prosecution of a patent application. *Compare, e.g., Adelberg Labs., Inc. v. Miles, Inc.*, 921 F.2d 1267, 1273 (Fed. Cir. 1990) (requiring detrimental reliance by the accused infringer) to *Haynes Int’l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1578 (Fed. Cir. 1993), *on reh’g* 15 F.3d 1076 (Fed. Cir. 1994) (“The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude,

from the prosecution history, that the applicant gave up to procure issuance of the patent.”). For that reason, unlike other estoppels, courts resolve prosecution history estoppel as a question of law. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1460 (Fed. Cir. 1998) (*en banc*). In turn, the Supreme Court has made it clear that *Festo* estoppel is to be treated as a form of prosecution history estoppel although prosecution history estoppel generally narrows the scope of claims for purposes of literal infringement while *Festo* estoppel narrows the scope of claims for purposes of the doctrine of equivalents. *Festo*, 122 S. Ct. at 1838-42. Thus, addressing *Festo* estoppel as a question of law is nothing more than a natural extension of *Markman*.

Viewing the *Festo* estoppel inquiry as an extension of *Markman* makes it clear that the issues to be resolved are more analogous to the questions of law resolved in claim construction than the questions of fact they may appear to be. As discussed below, a court considering *Festo* estoppel may need to establish the knowledge of one of ordinary skill in the art to determine the foreseeability of equivalence of a substituted element. While that inquiry is similar to that seen in a jury’s analysis of obviousness under 35 U.S.C. § 103 or of the doctrine of equivalence, it is also similar to the court’s construction of claims drafted in “means-plus-function” format under 35 U.S.C. § 112, ¶ 6. *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1347 (Fed. Cir. 1999). That is, courts

already resolve the factual inquiries underlying *Festo* estoppel as questions of law as part of the *Markman* process. There is simply no reason to shift this existing allocation of responsibility from the court to a jury.

## **II. COURTS DETERMINING THE APPLICATION AND SCOPE OF *FESTO* ESTOPPEL SHOULD APPLY THE FACTORS SET FORTH BY THE SUPREME COURT, VIEWED THROUGH THE PRISM OF THE PATENT PROSECUTION PROCESS**

Consistent with other issues of claim construction under *Markman*, courts should determine the application and scope of *Festo* estoppel based on objective indicia without resort to extrinsic evidence whenever possible. That is, the Court should make the *Festo* surrender decision primarily from intrinsic evidence – the claims, specification, and prosecution history. In doing so, however, the Court may consider the scope of the prior art known to one of ordinary skill in the art. In order to ascertain that knowledge, a court should have discretion to receive expert testimony and other extrinsic evidence in the same manner as it currently does with regard to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999). In short, the *Festo* estoppel inquiry should be folded into the *Markman* process. Through that process, the Court can best consider and address the factors established by the Supreme Court: materiality, foreseeability, and other issues. *Festo*, 122 S. Ct. at 1842. A court can do so through the underlying inquiries set forth below.

The *Festo* estoppel inquiry should begin – and often end<sup>1</sup> – with the intrinsic evidence of claim meaning. This evidence is, of course, also the evidence relevant to a *Markman* decision. *Pitney Bowes*, 182 F.3d at 1308-09. The claim amendments that may give rise to *Festo* estoppel are reflected in the prosecution history; the prosecution history will almost always indicate expressly why the amendments are made. That is, most amendments are made in response to an examiner’s rejection and explained in remarks associated with the filing of the amendments. 37 C.F.R. § 1.111. Through providing remarks, an applicant is able to indicate the intended meaning of its amendments and influence the potential scope of *Festo* estoppel. However, those remarks must be read in the context of the entire prosecution history; because the remarks are self-serving, the rejections and objections to which they respond, and any reply from the examiner, will provide the public greater insight into the scope of protection sacrificed through amendment.

Another potential type of evidence of the meaning of claim amendments is that relating to the knowledge of one of ordinary skill in the art at the time the amendment is made. Most likely to be introduced in the form of expert testimony or documents (whether printed publications or patents), such evidence may assist

---

<sup>1</sup> The presumption is that a claim amendment is intended to sacrifice all protection under the doctrine of equivalents: “[W]hen the court is unable to determine the purpose underlying a narrowing amendment – and hence a rationale for limiting the estoppel to the surrender of particular equivalents – the court should presume that the patentee surrendered all subject matter between the broader and the narrower language.” *Festo*, 122 S. Ct. at 1842.

the court in determining what the applicant knew or should have known in amending its claims, an inquiry necessary to determine the foreseeability of an alleged equivalent. As the *Pitney-Bowes* court stated,

Although the patent file may often be sufficient to permit the judge to interpret the technical aspects of the patent properly, consultation of extrinsic evidence is particularly appropriate to ensure that his or her understanding of the technical aspects of the patent is not entirely at variance with the understanding of one skilled in the art.

*Pitney-Bowes*, 182 F.3d at 1309.

Among the other possible sources of evidence, it is clear that after-the-fact testimony regarding the subjective intent of the applicant would be improper. As this Court stated in *Markman*,

No inquiry as to the subjective intent of the applicant or PTO is appropriate or even possible in the context of a patent infringement suit. The subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (except as documented in the prosecution history).

52 F.3d at 985. Given that *Festo* estoppel arises out of changes documented in the prosecution history, and that an inventor has an opportunity and motive to explain the reasons for any claim amendments in his prosecution filings, there is no reason to leave open the option of after-the-fact testimony that could vary the meaning of what is expressly set forth in the prosecution history. *See Festo*, 122 S. Ct. at 1840 (relying on whether applicant intended to surrender subject matter “conflates the patentee’s reason for making the amendment with the impact the amendment has

on the subject matter.”). After-the-fact subjective testimony is neither available to those in the marketplace who seek to order their behavior according to an objective understanding of the prosecution of a patent nor especially reliable, given the fallibility of human memory.

The court should use the admissible evidence to consider the issues applicable to *Festo* estoppel. The Supreme Court’s first potential exception to *Festo* estoppel is an immaterial change in claim language. That exception should only be available for amendments made either voluntarily or in response to rejections or objections under 35 U.S.C. § 112; changes needed to overcome prior art rejections under 35 U.S.C. §§ 102 & 103 cannot be considered immaterial. Further, an amendment excepted from *Festo* estoppel must not change claim meaning. Amendments within the scope of the first exception to *Festo* estoppel would include those that make explicit something originally implicit in the claim and set forth in the specification, changes in claim form that merely simplify phraseology, and amendments that correct typographical errors. Again, however, any change in claim meaning would not fall within the first exception.

The second exception to *Festo* estoppel is an amendment that is asserted against an equivalent that was unforeseeable at the time of the amendment. This exception should involve five inquiries. First, was the element in question part of an “after developed” technology, arising from a “subsequent change in the art.” In

considering that question, it is not sufficient that the specific embodiment be new; the technology (including substantially similar embodiments) must arise after the making of the amendment. Second, could the applicant have claimed the subject matter of the element in question at the time of prosecution, but ultimately choose not to do so. Third, would a “skilled patent drafter” have appreciated or foreseen the potential limitations created by the amended claims. Fourth, was the amendment performed in such a way as to foreclose all known or future equivalents. Fifth, would a decision by the court allowing for equivalence of the element in question “disrupt the settled expectations of the inventing community.” If the answer to the first inquiry is in the negative or the answer to any of the other inquiries is in the positive, the “unforeseeability” exception to *Festo* estoppel should not be available to the patentee. Importantly, all of these inquiries should be made objectively, not subjectively. *Festo*, 122 S. Ct. at 1842 (“The patentee must 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”).

The third exception to *Festo* estoppel is other indicia of the lack of estoppel. One situation in which the third “catch all” exception might apply would be when there is widespread acquiescence to the patentee’s assertion of the scope of the claims. In deciding whether there is such acquiescence, it is vital that the

acquiescence actually be to the scope of the claims; it is not enough that others in the market have chosen alternative approaches to the same problem. Other situations may arise in which it would be inequitable to apply *Festo* estoppel to a claim amendment. Such situations will, however, be quite rare and the court should be cautious not to allow the narrow equitable exception to *Festo* estoppel to swallow the entire rule.

### CONCLUSION

The court should resolve *Festo* estoppel as a question of law. The court should consider primarily intrinsic evidence of claim meaning in doing so, but should also have discretion to receive extrinsic evidence of the knowledge of one of ordinary skill in the relevant art at the time of the amendment at issue, in order to resolve underlying factual inquiries.

Respectfully submitted,

---

Joshua R. Rich  
Paul S. Tully  
S. Richard Carden  
*McDonnell Boehnen  
Hulbert & Berghoff*  
300 S. Wacker Drive  
Chicago, Illinois 60606  
(312) 913-0001

## **CERTIFICATE OF COMPLIANCE**

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, I certify that this brief complies with the type volume limitations of Rule 29(d) and the Court's September 20, 2002 Order. Exclusive of the portions of the brief exempted by Rule 32(a)(7)(B)(iii) and Rule 32(a)(7)(C) of the Rules of the United States Court of Appeals for the Federal Circuit, this brief contains 2,469 words. As permitted by Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, I have relied upon the word count of the word processing program used to prepare this brief (Microsoft Word 2000) in preparing this certificate.

---

Joshua R. Rich

Dated: October 21, 2002

**CERTIFICATE OF SERVICE**

I certify that two true and correct copies of the attached BRIEF OF ASSOCIATION OF PATENT LAW FIRMS AS *AMICUS CURIAE* will be served on the following counsel via first class mail, postage prepaid, on the date noted below:

For Plaintiff-Appellee:

Charles R. Hoffman  
HOFFMAN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, NY 11791  
Telephone: 516-822-3550  
Facsimile: 516-822-3582

For Defendants-Appellants:

Arthur I. Neustadt  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, Virginia 22202  
Telephone: 703-413-3000  
Facsimile: 703-413-2220

Date: \_\_\_\_\_

\_\_\_\_\_  
Joshua R. Rich  
McDONNELL BOEHNEN  
HULBERT & BERGHOFF