

No. 00-1543

**In the Supreme Court of the United
States**

OCTOBER TERM, 2000

—————
FESTO CORPORATION,

Petitioner,

v.

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

Respondents.

**On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit**

—————
REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Respondent SMC urges the Court virtually to abolish the doctrine of equivalents which has for a century and a half played an essential role in the American patent system. Without that doctrine, the copying of inventions would be rife and the incentives to make true innovative advances would be very significantly diminished. SMC and the en banc majority would, nevertheless, relegate the doctrine to the status of an historical curiosity. It would be of no use to any inventor whose initial drafting of a patent application fell short of perfection, as defined by a patent examiner.

Following the lead of the en banc majority below, SMC would accomplish its end by completely transforming the concept of estoppel. Throughout the law, estoppel arises when a party makes a representation to gain a benefit and then attempts to contradict that representation to gain a different benefit or when a party attempts to re-litigate an issue already adjudicated against him. *Davis v. Wakelee*, 156 U.S. 680, 689 (1895). In the patent context, prosecution history estoppel prevents a patentee from deliberately relinquishing subject matter by amending his application in order to obtain a patent and later invoking the doctrine of equivalents to reclaim the surrendered subject matter.

SMC pays no attention whatever to these time-honored fundamentals of estoppel doctrine, proposing instead to jettison them in favor of a blanket rule that leaves wholly out of account whether the reason for an amendment was to achieve patentability by disclaiming potentially unpatentable subject matter. Under SMC's view, and the holding below, *any* "narrowing" amendment, whatever its purpose, destroys the availability of the doctrine of equivalents so long as the amendment is, as virtually all are, loosely associated with a desire to enhance the prospects for issuance of a patent. *It does not matter, as far as SMC and the Federal*

Circuit are concerned, whether the subsequent invocation of the doctrine of equivalents is in any way inconsistent with the proffering of the amendment. To call this an “estoppel” is an insult to generations of lawyers and judges. So too is any suggestion that SMC’s test is relevant to the fair and efficient administration of the patent law; it is instead a trap for any applicant whose initial effort lacks ideal clarity in the eyes of the examiner who happens to be assigned the file.

SMC disguises the radical change in patent law it advocates by sliding back and forth between the concept of “patentability” and the concept of any “requirement” for obtaining a patent. The two are not the same. “Patentability” addresses the *substantive* worthiness of an invention for patent protection. The other “requirements” address the *form* in which an application must be cast, *e.g.*, concision and clarity of expression. An amendment to improve form has nothing to do with whether the invention’s substance is new, useful, and not obvious, the requirements for patentability. The distinction is made clear by the Patent Act and the decisions of this Court. This Court should rule unequivocally that it is only when an intentional surrender of subject matter is made for the purpose of securing issuance of the patent that prosecution history estoppel can arise and then only with respect to the surrendered subject matter and equivalents thereto.

SMC, again following the en banc majority, recommends collapsing form and substance on the theory that it will lend certainty to the law. But it will not do even that. In addition to the other manifold defects of the proposed rule, it will merely shift the area of uncertainty, and hence of litigation, from the reason for a particular amendment to the question of whether the amendment is “narrowing.” Given the difficulties of fitting language to innovative concepts, particularly in rapidly evolving areas of technology, the

issue of narrowing will often be more complex than the question of the reason for an amendment.

The decisions of this Court, culminating in *Warner-Jenkinson*, are entirely contrary to the positions SMC now urges. Neither SMC nor the en banc majority below provides any sound reason for overruling those decisions now.¹

I.

PROSECUTION HISTORY ESTOPPEL DOES NOT AUTOMATICALLY RESULT FROM EVERY CLAIM NARROWING AMENDMENT MADE TO COMPLY WITH ANY PROVISION OF THE PATENT ACT

The crux of this issue — when prosecution history estoppel arises — is the clear distinction between “patentability” and the “statutory requirements” for a patent. The Federal Circuit en banc majority, SMC, and the government as amicus use the two concepts as if they were freely interchangeable. They are not. Both the Patent Act and this Court's opinions demonstrate that “patentability” is a term that does not embrace all of the “requirements” that an applicant must satisfy to get a patent. That fact alone undermines the entire foundation of the Federal Circuit decision. The en banc majority held that every claim narrowing amendment designed to comply with any requirement of the Patent Act — including those not related to prior art — automatically creates prosecution history estoppel. Both law and common sense require rejection of that extraordinary proposition.

¹ SMC attempts to color this case by suggesting, in an almost offhand manner, that the amendments made to Festo's patents were made to avoid prior art. If that were true, it would be the main focus of SMC's brief because, under long-settled law, SMC would be entitled to judgment without more. It is not remotely true, as we will demonstrate in Point IV below.

A. As we explained in our opening brief, the Patent Act makes the meaning of “patentability” clear. Sections 101-103 are placed under the chapter heading “Patentability of Inventions.” Section 101 requires that the invention be “new and useful.” Section 102 expands upon the requirement that the invention be new by denying a patent when its subject matter is to be found in the prior art. Section 103 requires that the invention not be obvious to a person having ordinary skill in the art to which the subject matter relates. By contrast, all other requirements for obtaining a patent are set forth in “Chapter 11 — Application for Patent,” which in Section 111 sets forth such requirements as that the application must include a specification and a drawing, and in Section 112 requires that the specification contain a written description of the invention and the manner of making and using it in “such full, clear, concise, and exact terms as to enable any person skilled in the art * * * to make and use the same * * *.”

The Act thus clearly distinguishes between patentability and other requirements for obtaining a patent. The case law makes the same distinction.

B. This Court confirmed the understanding derived from a reading of the Patent Act. In *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966), the Court pointed out that the Patent Act “sets out the conditions of patentability in three sections” that state “three explicit conditions: novelty and utility as articulated and defined in § 101 and § 102, and nonobviousness * * * as set out in § 103.” Noticeably omitted from this delineation of the conditions of patentability were the requirements for obtaining a patent specified in Sections 111 and 112.

Sections 101, 102, and 103 govern the question whether a device or process is eligible for a patent, stating the substance necessary to make an invention patentable. If the invention is novel,

useful, and not obvious, it is patentable. If the examiner objects on Sections 101-103 grounds, patentability can be achieved, if at all, only by an amendment that satisfies the criteria there set forth, which often requires surrendering subject matter. Sections 111-112, by contrast, govern merely the form in which a patent application must be cast. An examiner's objection concerning requirements of form can be overcome by amending the application for greater clarity. If, for example, the examiner says it is not clear how a person skilled in the art can use a device, a clarifying amendment can satisfy him. It makes no sense whatever to say that achieving greater clarity as to how to use an invention creates an estoppel that bars the doctrine of equivalents.

The distinction between patentability and other requirements — that is between substance and form — means that the reason for an amendment governs the question of whether prosecution history estoppel is created. *Warner-Jenkinson* explicitly states: “[P]etitioner reaches too far in arguing that the reason for an amendment during patent prosecution is irrelevant to any subsequent estoppel.” 520 U.S. at 30. Rather, the Court ruled, estoppel may be generated when the amendment was necessary to avoid a concern that “arguably would have rendered the claimed subject matter unpatentable.” *Id.* at 30-31 (emphasis added). Contrary to SMC and the majority below, therefore, the reason for an amendment is determinative, and estoppel arises only when the amendment surrenders subject matter. It does not arise — indeed, does not make any sense — with respect to amendments designed to meet such requirements as concision or clarity of expression in the application or the submission of a drawing of the invention or, as in this case, the substitution of more appropriate terminology for references to “linear motors.” Amendments that merely clarify or otherwise improve the description of the invention usually do not surrender any subject matter. While clarifying amendments may

add new elements, and therefore narrow the literal scope of the claim, it does not follow that a patentee has surrendered all equivalents with respect to the amended language. *Warner-Jenkinson*, 520 U.S. at 19. A surrender of claim scope does not equal a surrender of equivalents.

This reading of *Warner-Jenkinson* is confirmed by the Court's creation of a rebuttable presumption of subject matter surrender when the reason for an amendment is unclear. SMC argues, however, that it is inconsistent with *Warner-Jenkinson's* "pointed emphasis" "on the need for public notice of patent boundaries, which would be undermined were patentees free to supplement the public record with new explanations not discernable by the public." Resp. Br. 23. But that is precisely what *Warner-Jenkinson* contemplated by establishing a presumption that unexplained amendments relate to patentability but allowing the patentee to rebut that presumption. If, as SMC would have it, *all* amendments relate to "patentability," there would be no possibility of rebuttal. In allowing the presumption to be rebutted, moreover, the Court necessarily intended recourse to material not of record, and hence often not discernable by the public. If the rebuttal material were confined to that already in the public record, there would be no doubt about the reason for the amendment and hence no office for any presumption, rebuttable or not. The centrality to the estoppel issue of the reason for an amendment is thus confirmed by the Court's creation of the rebuttable presumption. It follows that there can be no flat rule that any "narrowing amendment" generates estoppel willy-nilly.

It is curious that SMC relies so heavily upon *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942), for that case, far from supporting SMC's position, decisively rejects it. Contrary to SMC's contention, *Exhibit Supply* did not shrink the doctrine of

equivalents by adopting a rigid and absolute bar to equivalents for amended claim elements. “Rather the message of *Exhibit Supply* is that a court should not construe a narrow claim of a patent so as to render it equivalent in scope to a broader claim surrendered during the course of Patent Office proceedings on the application for a patent.” 5A Donald S. Chisum, *Chisum on Patents* § 18.02[4] at 18-34 (1998).

In *Exhibit Supply*, the patent holder sought to recapture through the doctrine of equivalents a claim that had been surrendered by amendments to overcome the examiner’s rejections of the original claim because of the prior art. The patent covered electrical conductors used in games such as pinball. The original claim referred to conductors “carried on the table.” To avoid the prior art, the claim was amended to cover that subset of conductors which, though carried on the table, were also embedded in the table. The Court understandably rebuffed the patentee’s suit for infringement by equivalents against conductors carried on the table but not embedded in it. This was a classic case of estoppel and the loss of equivalents coverage because an amendment deliberately surrendered an area of coverage to avoid prior art.

SMC’s assertion that *Warner-Jenkinson* supports its reading of *Exhibit Supply* is equally specious. *Warner-Jenkinson* cited the case only to illustrate the fact that this Court has invoked estoppel when the reason for an amendment was to avoid prior art.

SMC gains nothing by relying on *Exhibit Supply*’s statement (315 U.S. at 136) that “[b]y the amendment, he [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference.” That says only that prosecution history estoppel arises when the patent applicant deliberately

surrenders an area of coverage in order to obtain the patent. That is black letter law and it is not in the least inconsistent with Festo's position.²

SMC's novel reading of *Exhibit Supply* would mean that from 1942 to 1997, a period of 55 years, the lower courts and the Federal Circuit have been disobeying the law laid down by this Court by resolving questions about estoppel and equivalents on the basis of the reason for amendments to patent claims rather than applying an absolute bar to equivalents for a claim narrowed for any reason. It must be accounted odd, to say the least, that in that time no petitioner called this Court's attention to what would have been manifest disregard of the Court's precedent.³

² Moreover, each of the six cases cited by *Exhibit Supply* to support that statement stands only for the proposition that a claim amended to define over prior art cannot be restored to its original scope through the doctrine of equivalents. See, e.g., *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784, 790 (1931) ("The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto."); *Hubbel v. United States*, 179 U.S. 77, 80 (1900) ("While not allowed to revive a rejected claim, by a broad construction of the claim allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted."); *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U.S. 668, 677-678 (1921) ("Having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer of rotation as an operative feature of his device.").

³ SMC would subordinate the clear meaning of the Patent Act and the precedents of this Court to the PTO *Manual of Patent Examining Procedure*. Resp. Br. 24. Its reliance is wholly unwarranted. The *Manual* (which could not, in any event, override the meaning ascribed by the Patent Act, *Graham*, and *Warner-Jenkinson*) uses the term "patentability" loosely because it was not addressing the scope of estoppel. SMC's effort to elevate the *Manual* to a controlling statement of the law is frivolous.

C. SMC's only policy argument is that certainty would be achieved by adopting the en banc majority's allegedly "objective" rule that any "narrowing" amendment as to any requirement for the issuance of a patent generates estoppel regardless of the reason for the amendment or the subject matter to which it relates. The asserted gain in certainty would be illusory, however, for the test proposed is not objective.⁴

Our opening brief pointed out (at 39-40) that the new rule would put the inventor and his attorney to the choice between refusing to amend any aspect of the application to satisfy the examiner and engaging in an (often fruitless) appeal; filing an artificially narrowed claim to avoid amendments (thus also cutting back the legitimate scope of the doctrine of equivalents); or eschewing the patent system altogether and relying upon trade secret law.

In addition to these harms to the system, a massive injustice would be done to the holders of more than a million patents who had freely amended under the current law, confident that the doctrine of equivalents was available unless the amendment surrendered substance, *i.e.*, matter related to novelty, utility, and nonobviousness as set out in Sections 101-103, and then only to that extent. Those patents, under the government's position as well as SMC's, would now be rendered virtually worthless by the proposed change in the law. It is wholly unrealistic to contend, as the government does, that holders of existing patents "are properly

⁴ The Federal Circuit's new rules, which force patent applicants to avoid making amendments, do nothing to establish clarity in claiming. A patent practitioner who is attempting to guide a client in designing around a patent encounters the most difficulty when a patent has issued without amendment and thus has a "clean" prosecution history. In such cases, there is no record of claim interpretation or identification of prior art that assists in delimiting claim boundaries.

charged with knowledge that narrowing amendments would give rise to prosecution history estoppel.” Govt. Br. 21. That the prior law was to the contrary is demonstrated by the intense interest the *Festo* decision has generated. The patent bar, industry, and research institutions recognized the revolutionary nature of the en banc majority’s decision. It is simply wrong, indeed absurd, to say that holders of existing patents issued years ago should have anticipated *Festo* and adjusted their practice before the PTO accordingly.

Those are reasons aplenty to reject the new rule, but it is also clear that the rule lacks the counterbalancing virtue claimed for it, for it is in fact infected with ambiguity that will foment litigation over the issue of whether a particular amendment is or is not “scope-narrowing.” That concept necessarily requires the construction of language and, for that reason, cannot be “objective.” Judge Linn pointed out (Pet. App. 117a) that the en banc majority did not clearly articulate what it considers to be a “narrowing” amendment:

If the change is merely the substitution of one synonymous word for another or the mere clarification of language from a foreign translation, the claim drafter may intend no change whatsoever in claim scope; but the drafter’s word choice may be construed after grant of the patent to imply a different scope * * *.

In the present case, the examiner objected to the claim because he was not sure whether the device was a motor or clutch. Had the applicant’s lawyer said, “It’s a motor,” that could be regarded as a narrowing amendment or argument creating an estoppel which, under the Federal Circuit’s rule, would bar the doctrine of equivalents altogether, even though a clarification and not a surrender of subject matter was intended. Competitors could then

copy the motor with insubstantial changes and destroy the value of the patents. At the very least, the parties would have to litigate the question of whether narrowing had occurred. That would often be an unedifying debate over semantics.⁵

II.

PROSECUTION HISTORY ESTOPPEL, WHEN IT ARISES, DOES NOT AUTOMATICALLY BAR EVERY APPLICATION OF THE DOCTRINE OF EQUIVALENTS

It is one of the mysteries of SMC's argument that it seeks to support the proposition that any estoppel precludes any application of the doctrine of equivalents with statements from this Court's decisions that contradict the proposition advanced. Thus, SMC summarizes *Exhibit Supply*: "This Court held that the applicant, by its choice of narrowing amending language, automatically was abandoning any subject matter that was within the claim before amendment but outside the claim after amendment." Resp. Br. 28. That is undoubtedly correct. But the necessary implication is that the estoppel thereby created is limited to the subject matter abandoned by the amendment. As shown by our example of an amendment that narrows a claim of joinder of two

⁵ Contrary to SMC and the Federal Circuit, the law prior to *Festo* was workable and the doctrine of equivalents was properly bounded. The uncertainties of patent litigation are no more or less than those in other fields of law. A skilled patent attorney can review and interpret a file history of a patent to give guidance whether a particular product will fall within the literal scope of the claims. If the product or process falls outside of the claims, the attorney must determine if the product would be deemed an equivalent of the patented invention, *i.e.*, whether the product functions in a substantially similar way to achieve substantially the same result. If so, the role of estoppel must be assessed by reviewing the file history and prior art. While this analysis does not provide absolute certainty, advice in many fields of law rarely does.

members by any means to one of joinder by glue, the resulting estoppel properly prevents the use of the doctrine of equivalents to a joinder of members by a screw but not to joinders accomplished by the equivalent of glue, *e.g.*, a joinder by paste. Pet. Br. 32-33. This is not in the least contrary to *Exhibit Supply*, even as SMC has formulated its rule.

However one might argue the breadth of the surrender in the hypothetical, the principle is clear and, as *Festo* has shown, is supported by cases such as *Hurlbut v. Schillinger*, 130 U.S. 456 (1889); *Fay v. Cordesman*, 109 U.S. 408 (1883); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 223-227 (1880); and *Shephard v. Carrigan*, 116 U.S. 593, 598 (1886). Pet. Br. 33-34. In more recent years, the Court has taken very few patent cases and has not had to deal with this well-established principle — until *Warner-Jenkinson*. The Court there remanded for a determination whether the amendment to a claim for a dye purification process, which included a limitation to processes operating above a pH of 6.0, should bar application of the doctrine of equivalents to processes operating below that strength. Had the Court intended a complete bar approach, no such remand would have been needed; equivalence could not be found below pH 6.0. Thus, the remand clearly contemplated consideration under a flexible bar approach. Similarly, in *Festo*'s case, it would be both unjust and contrary to well-established law to hold that the mere fact of an amendment, though it did not surrender the subject area as to which the doctrine of equivalents was invoked, both created an estoppel and barred any and all use of the doctrine of equivalents.

In contrast to the “complete bar” espoused by SMC and imposed by the Federal Circuit, a “flexible bar” allows some protection against equivalents, depending on the scope of the surrender of subject matter, which in turn defines the scope of the

estoppel. SMC and the en banc majority reject the flexible bar, which had governed most cases in the past, as “unworkable.” But neither SMC nor the court offers a comprehensible reason why the flexible bar is unworkable. The decision whether an allegedly infringing device falls within or without the scope of an estoppel typically involves comparing the structure of the accused device to the structure of other devices, such as those in the prior art, that reveal the scope of the subject matter relinquished by the amendment. In other words, the task involves reasoning by analogy, which is the universal mode of legal reasoning. The standard SMC endorses would make virtually all law on any subject equally “unworkable.”

As we have earlier noted (Pet. Cert. Reply Br. 5 n.3), under the criteria propounded by SMC and the Federal Circuit, such questions as negligence, attempts to monopolize, and defamation are “virtually unascertainable.” If the cure administered below and defended here were given equal rein in other fields, these and many other areas of the law would be governed by *per se* rules. Any driver who ran into another car would be negligent, regardless of the circumstances; any firm that reached a specified market share would be guilty of attempted monopolization, no matter how that size was achieved; and any critical remark would be actionable defamation, regardless of truth. To say that applying a flexible bar is unworkable in patent law and must be replaced with a complete bar is as preposterous as imposing equivalent *per se* rules would be in these other fields of law.⁶

⁶ Explaining a prior decision upholding the Sherman Act, Justice Holmes wrote that the case went “no further than to recognize that, as with negligence, between the two extremes of the obviously illegal and the plainly lawful there is a gradual approach and that the complexity of life makes it impossible to draw a line in advance without an artificial simplification that would be unjust.” *International Harvester Co. v. Kentucky*, 234 U.S. 216,

III.**THE GOVERNMENT INCORRECTLY SEEKS TO APPLY ESTOPPEL TO ALL “NARROWING” AMENDMENTS BUT CORRECTLY CONCLUDES THAT THE DOCTRINE OF EQUIVALENTS REMAINS AVAILABLE AS TO NON-NARROWED ASPECTS OF THE CLAIM**

The government, which in the past has been on both sides of the issue, now supports the finding of estoppel arising from any narrowing amendment related to patentability, as expansively defined by SMC and the en banc majority below. The government’s conclusion is incorrect for the same reasons that SMC is wrong, as shown in points I. and II., above, but it is worth noting the government’s vacillations on the subject.

The government’s brief as amicus curiae in *Warner-Jenkinson* adopted the position that Festo takes here. There the government states, “[A]s the court correctly noted in *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698, 703 (Fed. Cir. 1990), ‘[W]henever prosecution history estoppel is invoked as a limitation to infringement under the doctrine of equivalents, a close examination must be made as to, not only what was surrendered, but also the reason for such a surrender.’” 1996 WL 172221, at *22-*23 (U.S. Apr. 11, 1996).

The government reiterated the point (*id.* at *22): “Amendments before the PTO to reflect the scope of what was enabled or to add specificity raise considerations different from those raised by amendments to avoid prior art. The purpose of the enablement requirement is not to limit the scope of the patent right, but to ensure

that the invention has been fully disclosed so that, upon the patent's expiration, the public can practice the invention.”

In the light of these statements, it is startling that the government should now tell this Court that “[t]he holders of the ‘numerous patents which have not yet expired,’ [*Warner-Jenkinson* at 32 n.6] — most of which contained amended claims — are properly charged with knowledge that narrowing amendments would give rise to prosecution history estoppel.” Govt. Br. 21. If that knowledge escaped the government in 1996, how can holders of existing patents be deemed to know what the government then denied? More particularly, how can *Festo*, whose patents issued in 1982 and 1988, be deprived of its property for relying on the law as the Federal Circuit understood it in *Insta-Foam* (1990), as the government understood it in its 1996 brief in *Warner-Jenkinson*, and as this Court expressed it in that case?

The government's amicus brief in this case admits that the *Festo* decision by the Federal Circuit changed the law, referring to the Federal Circuit's “pre-*Festo* conception of prosecution history estoppel.” Govt. Br. 19. Yet the government states that the en banc majority in this case “correctly concluded that ‘a narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element.’” Govt. Br. 13 (quoting Pet. App. 9a). The argument advanced by SMC and the government often claims that the decision below is entirely consistent with *Warner-Jenkinson*, though it is clear from the sentence just quoted that it is effectively a repudiation of *Warner-Jenkinson*. The difference is simply this: *Warner-Jenkinson* held that estoppel arises when an applicant amends his application by surrendering subject matter that might have adversely affected patentability. Patentability means the satisfaction of the three

substantive conditions set out in §§ 101-103 of the Patent Act — novelty, utility, and nonobviousness — a proposition confirmed by the Court in *Graham*. The en banc majority below and the government here frequently refer to patentability but do not define it. Instead, they shift to a narrowing amendment “made for any reason related to the statutory requirements for a patent.” That extends the definition of patentability to §§ 111 and 112. The expansion means, for example, that any change in a specification, such as the written description of the patent, may generate an estoppel. Any inquiry into the reason for the change is ruled out.

Were there any doubt that this is the position the Federal Circuit has adopted, that doubt is removed by the fact that it found Festo estopped from using the doctrine of equivalents although the company never surrendered any subject relating to the features of SMC’s product claimed to infringe under the doctrine of equivalents.

The en banc majority’s new rule, embraced by SMC and urged upon this Court, far from simplifying matters, would create a new and fruitful source of uncertainty and litigation. Injustice is to be done to patent holders, this Court’s rulings are to be overridden, and the policy of the Patent Act subverted, all to little, if any, benefit to anyone other than copyists.

IV.

THE AMENDMENTS TO THE STOLL AND CARROLL PATENTS WERE NOT MADE TO AVOID ANY PRIOR ART

The most disingenuous argument advanced by SMC is that both the Stoll and Carroll patents were amended to avoid the prior art and thus created estoppel under the traditional view of prosecution history estoppel. SMC states (Br. 20) that the Federal Circuit’s

“broader ruling” (*i.e.*, that any “narrowing” amendment triggers estoppel that eliminates the doctrine of equivalents entirely) was “not necessary to the resolution of this case.” Were that true, SMC would have been entitled to summary judgment on the first question presented. But SMC made no such motion in the district court. In fact, when the district judge expressed surprise that SMC had introduced no evidence concerning the prior art, respondent’s counsel assured him that “This is not really a prosecution history estoppel case.” Pet. App. 198a. At trial, “[n]o objection was raised to the district court’s instructions on estoppel, or to the presentation of the broad issue to the jury as part of the evidence relating to infringement.” Pet. App. 199a. On appeal, the panel carefully analyzed the prosecution history, and prior art was not found to create estoppel issues. Pet. App. 198a-199a. Upon remand from this Court for consideration of the impact of *Warner-Jenkinson*, a second panel once more did not find that prior art was the reason for any of the amendments. Pet. App. 184a-188a. At the rehearing en banc, however, SMC raised the question and the majority said that the amendments were made in part to avoid the prior art. Pet. App. 52a, 55a. This assertion was grounded in nothing in the record and constitutes fact-finding by an appellate court without authority to engage in such an exercise.

Quite apart from the record in the courts below, SMC’s attempt to raise the factual question of prior art in this Court is foreclosed by the Court’s grant of certiorari on the two questions presented. Those questions relate solely to what SMC refers to as the Federal Circuit’s “broader ruling.” In its opposition to the petition for certiorari, SMC argued that the petition should not be granted because the prior art complication made the case a “poor vehicle” for review of the legal questions presented. Festo’s reply brief contended that there was no prior art problem. The Court then

granted the writ on the two questions presented. This should settle that only the questions presented are before the Court.

Perhaps realizing that its contentions about prior art are at best a red herring, SMC nowhere asks this Court to affirm the judgment below on that basis.

CONCLUSION

For the reasons set forth above, and for the reasons set forth in Festo's opening brief, the decision of the Federal Circuit should be reversed.

Respectfully submitted.

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