

OUTLINE

The Unfinished Tasks of *Festo*: What More Needs to Be Done to Balance the Doctrine of Equivalents and Prosecution History Estoppel

INTRODUCTION

- Supreme Court brings return of the doctrine of equivalents to amended claims.
- What key points this Note aims to convey.

II. HISTORIC DEVELOPMENT

- Conflicting purposes of the patent law.
- A. Historic Development of the Doctrine of Equivalents.
- *Winans*.
 - *Graver Tank*.
 - *Warner-Jenkinson*.
- B. Historic Development of Prosecution History Estoppel.
- The origination of prosecution history estoppel: the earlier cases and the flexible bar approach.
 - The moving of the Court toward a more strict interpretation: *Exhibit Supply*.
 - Inconsistency of the application of the prosecution history estoppel by the lower courts, including the Federal Circuit.
- C. The Implication of *Warner-Jenkinson* on Prosecution History Estoppel.
- Facts of *Warner-Jenkinson*.
 - Holdings of *Warner-Jenkinson*.
 - Unresolved issues and the problem with the Court's reasoning.

II. CASE SUMMARY

- A. Facts and Procedure History
B. The Federal Circuit's *en banc* Decision
C. The Supreme Court's Decision

III. DISCUSSION

A. Any narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel. Discuss ambiguity of the narrowing amendment.

B. The presumptive bar approach: new burden for the patentee

1. Foreseeability test

a. The foreseeability test is in contradiction to the spirit of the doctrine of equivalents as expressed in *Graver Tank*.

- Drafting original claims and amending claims serve a common function
- Uneven treatment and unfairness to different patentees
- Double standard emphasizes formality over substance

b. A uniform foreseeability test is better to balance the two functions of the patent system.

- Federal Circuit's embracing of the test is needed.

c. The lack of clear enough guidance of the Foreseeability test

- Inconsistent timing
- Judge or jury

2. The tangential relationship test and the reasonableness test

- Vagueness of tangential relationship test
- Lack of guidance of the reasonableness test
- Potential benefit of the reasonableness test to biotech patents

C. Effects of *Festo* on patent prosecution

- *Festo* placed a heavier burden on patent prosecutors
- Strategies to deal with the double standard
 - Continuation application
 - Appeal, do not amend
 - Start with well-thought claims
- *Festo* will increase prosecution cost of patents, but the extra cost is worthwhile for a better patent system

CONCLUSION