Prosecution History Estoppel in a Post-Festo World: How Flexible Is the Supreme Court’s “Flexible Bar”? 

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The Court of Appeals for the Federal Circuit (CAFC) thought it sounded the death knell for the doctrine of equivalents in its Festo VI decision in 2000. The CAFC decided that whenever a claim amendment gives rise to prosecution history estoppel, no range of equivalents are available for the amended claim amendment. This “complete bar” to equivalents claims would have largely eviscerated the doctrine, making it unavailable in nearly every case where the patentee had amended claims during prosecution. Left for dead, many believed the doctrine would slowly wither away. However, on appeal, the Supreme Court resuscitated the doctrine of equivalents by rejecting the “complete bar” and adopting in its place a “flexible bar” approach to prosecution history estoppel and the doctrine of equivalents. The Supreme Court recognized in its 2002 Festo VIII decision that while narrowing amendments give rise to a presumption of estoppel, patentees are entitled to an opportunity to rebut the presumption “where the amendment cannot reasonably be viewed as surrendering a particular equivalent.”

Specifically, the Supreme Court stated that the presumption is rebutted if the patentee can prove that: (1) the equivalent was unforeseeable at the time of the amendment; (2) the rationale underlying the amendment bore no more than a tangential relation to the equivalent in question; or (3) there was some other reason suggesting that the patentee could not reasonably be expected to have described the alleged equivalent when it narrowed the claim.

The Supreme Court’s Festo VIII decision is consistent with its earlier efforts in Graver Tank and Warner Jenkinson to preserve the doctrine of equivalents notwithstanding widespread criticism that the doctrine “conflicts with the definitional and public-notice functions of the statutory claiming requirement.” Echoing its holdings in Graver Tank and Warner Jenkinson, the Court explained in Festo VIII that because language in patent claims may be imprecise or fail to capture every nuance of the invention, “[i]mportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying.” Accordingly, the Festo VIII Court reaffirmed that the “scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.”

Still, those who thought the Supreme Court’s decision might have rescued the doctrine of equivalents from the absolute prosecution history estoppel bar did not count on the Federal Circuit’s continuing role in applying the Supreme Court’s standard. During the past five years, the CAFC has applied the Supreme Court’s “flexible bar” in nearly twenty cases and has limited the outer boundaries of the “flexible bar.” While the CAFC has paid lip service to the Supreme Court’s admonition that the “flexible bar” is not “just the complete bar by another name,” a close examination of the CAFC’s decisions in post-Festo prosecution history estoppel cases suggests that the “flexible bar” is not very flexible at all.

I. Rebuttal of the Presumption Based on “Unforeseeability”

The first prong of the three-pronged rebuttal test instituted by the Supreme Court in Festo VIII “requires a patentee to show that an alleged equivalent would have been ‘unforeseeable at the time of the amendment and thus beyond a fair interpretation of what was surrendered.’” In its Festo remand decision (Festo IX), the CAFC explained that the first rebuttal criterion presents “an objective inquiry, asking whether the alleged equivalent would have been unforeseeable to one of ordinary skill in the art at the time of the amendment.” If the equivalent represented technology developed after the time of the amendment (“e.g., transistors in relation to vacuum tubes, or Velcro® in relation to fasteners”) or technology not known in the relevant art, the equivalent would not have been foreseeable. In contrast, technology known in the prior art would likely be foreseeable at the time of the amendment.

In Pioneer Magnetics, the first CAFC case to address the unforeseeability prong, the relevant amendment during prosecution of the patent-in-suit had the substantive effect of changing the claim term “multiplier” to a “switching analog multiplier circuit.” Pioneer argued that the non-switching multiplier circuit in the accused device was equivalent to the amended “switching analog multiplier circuit” limitation. Because Pioneer amended the asserted claim to distinguish the invention from prior art “which disclosed a power supply containing a non-switching multiplier,” the amendment gave rise to the presumption that Pioneer had surrendered equivalents to the amended “switching analog multiplier circuit” limitation. Moreover, because the prior art disclosed the alleged equivalent non-switching multiplier circuits, the CAFC held that the alleged equivalent was “foreseeable at the time of the amendment.” The Pioneer Magnetics lesson: if an alleged equivalent is disclosed in the prior art, a patentee cannot rebut the presumption of surrender based on unforeseeability.

This principle was underscored by the CAFC’s decision in Talbert Fuel. The issue of infringement in Talbert Fuel focused on the claim limitation of a gasoline boiling
The point range of 121°F to 345°F. The 345°F temperature limit had been added by Talbert Fuel to the asserted claims at the examiner’s urging, to distinguish prior art that included hydrocarbon fuels with an endpoint within the range of 390°F to 420°F. The CAFC considered whether the alleged equivalent Unocal fuels with boiling range endpoints starting at 373.8°F were unforeseeable at the time Talbert amended its claims to add a 345°F limit. Citing Pioneer Magnetics, the CAFC decided that because “the prior art embrace[d] the alleged equivalent . . . that subject matter cannot be found to have been unforeseeable at the time of the amendment.”

While Talbert Fuel purportedly adopts the same principle set forth in Pioneer Magnetics—that an alleged equivalent set forth in the prior art cannot be unforeseeable at the time of the amendment—in reality it expands that holding beyond the narrow confines of the Pioneer Magnetics decision. In Pioneer Magnetics, the exact equivalent at issue, a non-switching multiplier circuit, had been disclosed in the prior art. In Talbert Fuel, however, the boiling range limit of the alleged equivalent Unocal fuels started at 373.8°F, a limit which approached, but was not explicitly disclosed by, prior art fuels with boiling ranges starting at 390°F. Nevertheless, the CAFC decided that because the boiling range limits of the Unocal fuels were “within the space between the 345°F limit of Talbert’s amended claims and the 390°F of the [prior art] reference,” Talbert could not credibly argue that the Unocal fuels were unforeseeable at the time of its claim amendments.

Under the CAFC’s holding in Talbert Fuel, if Talbert Fuel had amended its claims to recite fuels with a boiling range limit up to 390°F, it would have captured all fuels with boiling range limits that were less than that of the prior art cited by the examiner. Because Talbert Fuel only amended its claims to recite a limit of 345°F, it presumptively surrendered—and was unable to rebut the presumption of surrender—all equivalent fuels with boiling range limits between 345°F and 390°F. Talbert Fuel suggests that when possible, applicants should respond to an examiner’s prior art-based rejection by amending claims to capture all territory between the original limitation and the prior art. A failure to do so may result in the surrender of any potential equivalents coverage for territory between the amended claim limitation and the prior art.

The patentees in Research Plastics learned the lesson taught in Talbert Fuel the hard way. The patent at issue in Research Plastics “describes the placement of ribs on the interior surface of a tube.” The patent was initially rejected as obvious over prior art that taught a tube with ribs formed near the nozzle end of the tube. In response to that rejection, Research Plastics amended the asserted claims to recite ribs that extend to the rear end of the tube. The alleged equivalent in Research Plastics was a tube with ribs located some distance from the rear edge of the tube, but “still in the rear half of the tube, well away from the nozzle.” The CAFC concluded that Research Plastics was presumptively estopped from asserting infringement of the alleged equivalent, and could not rebut that presumption under the unforeseeability prong because “it was foreseeable at the time of issuance of the patent that rib placement was a point of differentiation.” Although Research Plastics could have amended the patent to claim “ribs placed in the region between the nozzle end and the rear end of the tube, so long as it disclaimed the location adjacent to the nozzle,” its failure to claim the territory between the original limitation and the prior art resulted in the surrender of all equivalents between the amended claim element of ribs extending to the rear end of the tube and the prior art ribs adjacent to the nozzle end of the tube.

In Ranbaxy Pharmaceuticals, the CAFC addressed a different issue relating to the unforeseeability prong: whether foreseeability relates to the alleged equivalent or to the potential effects of the relevant claim amendment. The patentee in Ranbaxy amended the limitation “highly polar solvent” in the asserted claims to specify a defined group of highly polar solvents consisting of sulfoxides, amides, and formic acid. The alleged equivalent contained acetic acid which, like the solvents in the amended claims, is a highly polar solvent. The patentee argued that it was unforeseeable that the claim amendments would constitute surrender of acetic acid because acetic acid is a highly polar organic solvent “which is the obvious structural equivalent” of formic acid, one of the solvents in the amended claims. The CAFC rejected this argument, in part because “foreseeability relates to the equivalent, not to whether an amendment may result in prosecution history estoppel.” Ranbaxy provides additional clarity about the precise inquiry involved in a determination of foreseeability. The foreseeability inquiry must be focused on whether the alleged equivalent to the claimed invention was foreseeable at the time of the amendment, not whether it was foreseeable that the amendment would result in prosecution history estoppel. More precisely, the relevant question is whether it was foreseeable, when the amendment was made, that the accused equivalent could be interchanged with or substituted for the pertinent claimed element.

In a similar vein, the CAFC recently held in Amgen that even if it was objectively foreseeable that the amended claim language would read on the accused equivalent, there is still no rebuttal of the presumptive surrender of equivalents if the patentee knew about the alleged equivalent at the time of the amendment. In Amgen, the patentee argued that the district court erred “in finding that a 165-amino acid equivalent was foreseeable” because it expected the amended claims to “cover all human EPO, regardless of whether or not the EPO had 165 or 166 amino acids.” The CAFC rejected this argument, explaining that it raised a claim construction issue, which was irrelevant to the rebuttal of the Festo presumption. Instead, the relevant inquiry was whether one skilled in the art would have known about the alleged equivalent at the time of the amendment. In Amgen, “because the patentee admittedly knew about the 165-amino acid equivalent at the time of the [relevant] amendment,” the alleged equivalent was foreseeable.
In *Glaxo Wellcome*, the CAFC rejected another argument offered by a patentee to prove that an alleged equivalent was unforeseeable.43 During prosecution of the patent-at-issue in *Glaxo Wellcome*, “the examiner required Glaxo to restrict the claims to a particular controlled drug release agent, i.e., HPMC.”44 The CAFC found that by amending the claims to recite HPMC, “Glaxo surrendered other controlled sustained release agents known to act as equivalents of HPMC,” including the alleged equivalent sustained release agent known as HPC.45 Glaxo argued that it could not have been “expected to have drafted a claim that would have literally encompassed the alleged equivalent” because an amendment to add the alleged equivalent HPC agent would have drawn a new matter rejection from the examiner.46 The CAFC disagreed, noting that “new matter prohibitions are not directly germane to the doctrine of equivalents or the patentee’s proof to overcome the *Festo* presumption.”47 The CAFC explained that the critical inquiry is not whether an applicant could or could not have properly claimed an equivalent at the time of the amendment because of the new matter doctrine, but instead whether the applicant could have foreseen the alleged equivalent at the time of the amendment.48 Because both HPMC and HPC were known sustained release agents at the time of the amendment, Glaxo could not rebut the presumption of surrender under the unforeseeability prong.

Under *Glaxo Wellcome*, an attempt to rebut the *Festo* presumption on the grounds that it would have been futile to add the alleged equivalent because of the new matter doctrine will fail. Accordingly, if an equivalent is foreseeable when a patentee is amending claims, but that equivalent would draw a new matter rejection because it was not foreseeable at the time of the patent application, the patentee should file a continuation-in-part application to disclose and claim the additional subject matter so as not to risk surrendering the equivalent because of prosecution history estoppel.49

II. Rebuttal of the Presumption Based on “Tangential Relation”

The second rebuttal criterion “requires a patentee to demonstrate that ‘the rationale underlying the narrowing amendment [bore] no more than a tangential relation to the equivalent in question.’”50 The CAFC explained in *Festo IX* that “the inquiry into whether a patentee can rebut the *Festo* presumption under the ‘tangential’ criterion focuses on the patentee’s objectively apparent reason for the narrowing amendment.”51 Because “that reason should be discernible from the prosecution history record,” the CAFC instructed courts to rely only on the prosecution history record and, when necessary, “testimony from those skilled in the art as to the interpretation of that record,” to determine whether a patentee has established a merely tangential reason for a narrowing amendment.52

In *Festo IX*, the CAFC held “that an amendment made to avoid prior art that contains the equivalent in question is not tangential; it is central to allowance of the claim.”53 This principle was first illustrated in Pioneer Magnetics. As noted above, Pioneer amended its patent claims to include a switching analog multiplier, which distinguished its invention from prior art that disclosed a non-switching multiplier.54 The alleged equivalent, like the prior art, contained a non-switching multiplier.55 The CAFC decided that the amendment “was clearly not tangential to the equivalent in question; the amendment was made to avoid the very prior art that contained the equivalent.”56

The CAFC reached a similar conclusion in Business Objects. The patent in Business Objects concerned an improvement for searching relational databases that consisted of a method allowing users to query the database without knowing a query language or understanding the structure of the relational database.57 The relevant amendment in Business Objects was a limitation relating to a query that claimed a method for “associating a first familiar name with a first returned value, wherein the familiar name is also associated with . . . a WHERE clause.”58 While conceding that the inclusion of the “associating step” limitation was a narrowing amendment giving rise to a *Festo* presumption, Business Objects argued that the presumption should be rebutted because the amendment was only tangentially related to the accused equivalent. The CAFC disagreed, noting that Business Objects had argued to the examiner that the relevant amendment rendered the asserted claim allowable over the prior art because the prior art did not associate “WHERE clauses with a familiar name.”59 Because Business Objects’ equivalents infringement case was premised on the fact that the accused products associated something equivalent to a WHERE clause to a familiar name, the CAFC decided that Business Objects could not rebut the *Festo* presumption based on the “tangential” criterion.60

Pioneer Magnetics and Business Objects demonstrate that a patentee cannot rebut the *Festo* presumption if the amendment is made to avoid prior art that encompasses the alleged equivalent. But, as the CAFC stated in Chimie, “[i]t does not follow . . . that equivalents not within the prior art must be tangential to the amendment.”61 In Chimie, Rhodia, the patentee, argued that its claim amendment to add the limitation “dust-free and non-dusting” did not estop it from asserting infringement under the doctrine of equivalents because the alleged equivalent “spray dried silica microspheres” was not encompassed by the “powdered or granulated silicas” prior art cited by the examiner.62 The CAFC disagreed, noting that “Rhodia misunderstands the scope of the inquiry into the relationship between the narrowing amendment and the accused equivalent.”63 The court explained that Rhodia had amended its claim to incorporate limitations distinguishing its invention from the prior art on a variety of grounds, including the fact that the claimed silica was “dust-free and non-dusting.”64 Because “Rhodia’s articulation of these characteristics was not limited to the form of silica produced . . . Rhodia presumptively surrendered all forms of silica with dust levels too great to be considered ‘dust-free and non-dusting.’”65 Accordingly, the CAFC held that Rhodia could not rebut the *Festo* presumption because “the relative dustiness of Rhodia’s invention was at issue
during prosecution and thus the reason for the narrowing amendment cannot be said to be tangential to an equivalent that has that characteristic.\textsuperscript{66}

In Festo IX and Biagro Western Sales the CAFC addressed a different issue: can a patentee show that the rationale underlying an amendment was no more than tangentially related to the asserted equivalent if the prosecution history revealed no reason for the amendment? In light of the court's insistence that the rationale underlying the amendment be found exclusively in the prosecution history record, it is not surprising that the court found no rebuttal.

In Festo IX, one of the two asserted patents was amended during prosecution to add the limitation that the outer shell of the device be made of a magnetizable material.\textsuperscript{67} Although the alleged equivalent was made of a nonmagnetizable alloy, Festo argued that the defendant infringed under the doctrine of equivalents.\textsuperscript{68} In an attempt to overcome the presumption of surrender, Festo contended that the “magnetizable” limitation was added in response to a §112, ¶1 rejection, but “was unnecessary to respond to (and thus only tangential to) the §112 rejection.”\textsuperscript{69} The CAFC agreed that the “magnetizable” limitation was unnecessary to respond to the examiner’s rejection, but concluded that Festo did not satisfy the “tangential” criterion because it had failed to identify any rationale for the amendment, let alone show that the rationale for the “magnetizable” amendment was only tangential to the accused equivalent.\textsuperscript{70} Because courts are not permitted to consider evidence outside of the prosecution history when evaluating the “tangential” criterion, the absence of a rationale for the “magnetizable” amendment in the prosecution history effectively closed off any opportunity for Festo to argue that the amendment was only tangential to the accused equivalent.

In Biagro, the patentee made a narrowing amendment to add the limitation “wherein said phosphorous-containing acid or salt thereof is present in an amount of about 30 to about 40 weight percent” to the claimed fertilizer invention.\textsuperscript{71} Even though the amendment had been made “to overcome a prior art fertilizer that was not concentrated,” Biagro argued that the reason for the amendment was no more than tangential to the alleged equivalent fertilizer with a phosphate concentration of nearly 60 percent “because only the lower limit of the claimed range was necessary to distinguish over the prior art.”\textsuperscript{72} In essence, Biagro maintained that “there was no reason for adding an upper limit of 40 percent” after it had added the lower 30 percent limit to distinguish the claimed fertilizer from the prior art fertilizer.\textsuperscript{73} Relying on Festo IX, the CAFC rejected Biagro’s argument, concluding that “since the prosecution history shows no reason for adding an upper limit to the concentration range, Biagro cannot claim that the rationale for the amendment is merely tangential.”\textsuperscript{74}

The CAFC’s decisions in Pioneer Magnetics and Business Objects demonstrate that an amendment made to avoid prior art that encompasses the alleged equivalent is never tangential. The Chimie decision stands for the proposition that even when prior art does not include the alleged equivalent, the equivalent may still not be tangential to the equivalent. And under Festo IX and Biagro, an absence of a rationale for the amendment in the prosecution history will doom an attempt to rebut the presumption of surrender based on the “tangential” criterion. How then can a patentee successfully rebut the Festo presumption? Insituform and Primos—the only two cases to date where the CAFC decided that the patentee rebutted the Festo presumption under any of the three criteria—provide some answers to that difficult question.

The patent in Insituform disclosed “a method for performing pipe repair without removing the damaged pipe from the ground. The method involves installing a liner into the pipe.”\textsuperscript{75} Original application claim 1, which set forth “a process for impregnating a flexible tube liner with resin prior to insertion of the liner into a damaged pipe,” was rejected during prosecution over a prior art patent that disclosed “both the use of a continuous vacuum and the creation of that vacuum from only a single vacuum source at the far end of the tube opposite the resin source.”\textsuperscript{76} The patentee overcame the objection “by amending application claim 1 to include … the limitations of original dependent claims 2-4,” including the limitation of creating a vacuum through a window in the liner “by means of a [single] cup applied to the window.”\textsuperscript{77} The CAFC decided that this amendment gave rise to prosecution history estoppel, presumptively barring Insituform’s claim that defendants’ method of tube liner impregnation, which used four to six cups “to draw a vacuum from a corresponding number of slits in the tube liner,” infringed claim 1 under the doctrine of equivalents.\textsuperscript{78} Ultimately, however, the CAFC agreed with Insituform that the rationale for the amendment to claim 1 bore “only a tangential relation, if that, to the equivalent in question, a process using multiple cups.”\textsuperscript{79} The CAFC explained that the rationale for the amendment was to distinguish the prior art based on the fact that Insituform’s process did not have the disadvantage of a single, large vacuum source at the far end of the tube liner.\textsuperscript{80} Because there was “no indication in the prosecution history of any relationship between the narrowing amendment and [the accused] multiple cup process,” Insituform “successfully rebutted the Festo presumption.”

Insituform demonstrates that rebuttal of the Festo presumption is possible even when the effective result of the amendment is related to the accused equivalent so long as the rationale for the amendment has nothing to do with the equivalent. In Insituform, even though the amendment to the original asserted claim added a limitation to the claimed process that narrowed the invention from a multiple cup to a single cup process and the alleged equivalent consisted of a single cup process, the CAFC upheld rebuttal based on the tangential relation criterion.\textsuperscript{81} The CAFC’s holding turned entirely on the fact that Insituform had clearly demonstrated that the rationale for the amendment—distinguishing the claimed invention from prior art with a single, large vacuum source—had nothing to do with the accused equivalent multiple cup process.\textsuperscript{82}

In Primos, the patent disclosed a diaphragm mouth call that hunters use to simulate animal sounds compris-
ing, among other things, a frame, a membrane stretched over the frame, and a plate extending upward from the frame and over a portion of the membrane. The patentee added a limitation that the plate in the claimed diaphragm mouth call be “differentially spaced” above the membrane to distinguish the mouth call from prior art that “consisted of a shelf-like structure positioned on top of the membrane without any spacing.” Preliminarily, the CAFC upheld the district court’s finding that the only territory surrendered by the patentee as a result of the “differentially spaced” amendment consisted of “plates that are not differentially spaced above the membrane.” Based on this finding, the court held that “because the accused device’s dome includes the spacing, the amendment was merely tangential to the contested element in the accused device, and thus prosecution history estoppel does not apply to prevent the application of the doctrine of equivalents.”

Taken on its own, Primos suggests that rebuttal based on the tangential relation criterion is possible if the patentee can prove that the relevant amendment was made to distinguish the claimed invention from prior art based on a feature of the prior art that is not present in the alleged equivalent. The patentee in Primos added the limitation “differentially spaced” to distinguish the invention from a prior art structure positioned on top of a membrane without any spacing. Because the accused product included spacing between the structure and the membrane, the CAFC decided that the amendment was tangential to the accused device.

Unfortunately, the CAFC has not consistently applied the Primos holding. For example, in Biagro, as noted above, the patentee amended the asserted claim to add the limitation “wherein said phosphorous-containing acid or salt thereof is present in an amount of about 30 to about 40 weight percent.” This amendment was made to distinguish the claimed fertilizer from prior art fertilizer that was not concentrated. The alleged equivalent, by contrast, was “a fertilizer with a phosphate concentration of nearly 60 percent.” Under Primos, Biagro should have successfully rebutted the Festo presumption because the relevant amendment was made to distinguish the claimed invention (i.e., fertilizer with a phosphate concentration of 30 percent to 40 percent) from prior art based on a feature of the prior art (i.e., non-concentrated fertilizer) that was not present in the alleged equivalent. But unlike in Primos, in Biagro the CAFC decided that the patentee failed to rebut the Festo presumption.

III. Rebuttal of the Presumption Based on “Other Reason”

The third rebuttal criterion requires a patentee to show “some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.” In its Festo remand decision, the CAFC proclaimed that this criterion is “a narrow one” that “may be satisfied when there was some other reason, such as the shortcomings of language, why the patentee was prevented from describing the alleged equivalent when it narrowed the claim.” Determination of the “other reason” criterion should be limited to the prosecution history record. Just as a patentee cannot rebut the Festo presumption under the “unforeseeability” or “tangential relation” criteria if the alleged equivalent is disclosed in the prior art, rebuttal under the “other reason” criterion fails if the equivalent is in the prior art because “there can be no other reason the patentee could not have described the substitute in question.”

Patentees have not succeeded in rebutting the Festo presumption based on the “other reason” criterion in the few cases where they have raised the issue. In Festo IX, for example, Festo argued that the alleged equivalent nonmagnetizable sleeve was inferior to the claimed magnetizable sleeve. Festo explained that the patentee “could not reasonably have been expected to have drafted a claim to cover what was thought to be an inferior and unacceptable design.” The CAFC disagreed, concluding that the patentee could have described the equivalent sleeve “but chose not to do so because that ‘inferior’ element was not a part of his invention.” Because “there was no linguistic or ‘other’ limitation to prevent [the patentee] from describing the accused equivalent,” Festo could not satisfy the “other reason” criterion.

Like its holding in Festo IX, the CAFC in Amgen held that the patentee could not satisfy the “other reason” criterion because he “knew about the alleged equivalent 165-amino acid sequence at the time of the amendment,” but chose to limit the asserted claims to a 166-amino acid sequence. The court rejected Amgen’s argument (and the district court’s ruling) that “the patentee could not have reasonably been expected to have described the 165-amino acid equivalent because those of skill in the art would have interpreted the amendment to cover the 165-amino acid equivalent.”

Citing Biagro, where the CAFC rejected the patentee’s argument that the “other reason” criterion applied when the patentee understood the amended claim language to refer to the alleged equivalent, the CAFC explained that whether a person of skill in the art may have thought that the claims encompassed the equivalent “does not excuse the patentee’s failure to claim the equivalent.” Because “there were no shortcomings of language that might have prevented the patentee from claiming EPO having 165 amino acids...the patentee could have reasonably been expected to accurately point out and particularly claim the 165-amino acid sequence.”

IV. Conclusion

Almost five years of CAFC case law suggests that the Supreme Court had legitimate cause for concern that the “presumption” it articulated in Festo VIII could become “just the complete bar by another name.” With only two exceptions, the CAFC has rejected every attempt by a patentee to rebut the presumption of surrender, and not once has the CAFC found rebuttal under the “unforeseeability” or “other reason” criteria. There are a few important lessons that emerge from this still-developing body of law. First, if the alleged equivalent is disclosed or encompassed by the prior art, there will be no rebuttal.
under any of the three criteria. Therefore, if an amendment that gives rise to estoppel was made during prosecution of a patent, the party against whom the patent is asserted should scour the prior art to determine whether the accused equivalent feature in its product is disclosed in the prior art. Finding prior art that encompasses the alleged equivalent is a sure-fire method of defeating an attempt by the patentee to rebut the Festo presumption.

Second, patentees cannot rebut the presumption of surrender with respect to territory left unclaimed between the prior art cited by the examiner and the amended claim limitation. Accordingly, if at all possible, patent prosecutors should respond to an examiner’s prior art objection by claiming all territory that does not include the prior art. Third, if a patentee becomes aware of additional material that is equivalent to the subject matter disclosed in an original patent application when amending claims during prosecution, but amending the claims to add that material would draw a new matter rejection, the patentee should consider filing a continuation-in-part application to capture the additional material. A failure to do so will likely result in the permanent surrender of the additional material. Fourth, when amending claims during prosecution, patent prosecutors should consider explaining the reason for the claim amendments. While it is unlikely that courts will conclude that the stated rationale for the amendment is tangential to an alleged equivalent, if the patentee fails to explain the rationale for the amendment during prosecution and the rationale is not clear from the prosecution history, there is no chance that the patentee will later rebut the Festo presumption based on the “tangential relation” criterion. In short, the lack of flexibility in the so-called “flexible bar” means that prosecutors must carefully and thoughtfully respond to rejections during patent prosecution and that litigators must identify and creatively deal with narrowing amendments in the prosecution history record.

Endnotes
2. Id. at 569.
4. Id.
5. Id. at 741.
8. Id. at 732.
9. Id. at 741.
11. Id. at 1369.
12. Id.
13. Id.
14. Id. at 1355.
15. Id. at 1357.
16. Id.
17. Id.
19. Id.
20. Id.
21. Id. at 1359.
22. Id.
23. Pioneer Magnetics, 330 F.3d at 1357.
24. Id.
25. Id.
26. It is possible, of course, that an amendment claiming all territory up to, but not including, the prior art could prompt an obviousness rejection.
28. Id. at 1292.
29. Id. at 1293.
30. Id.
31. Id. at 1294.
32. Id. at 1299.
33. Id. at 1298.
34. Ranbaxy Pharm., Inc. v. Apotex, Inc., 350 F.3d 1235 (Fed. Cir. 2003)
35. Id. at 1240.
36. Id. at 1238.
37. Id. at 1241.
38. Id.
40. Id. at 1311-12.
41. Id. at 1313.
42. Id.
44. Id. at 1352.
45. Id.
46. Id. at 1354 (explaining that the new matter doctrine prevents a patentee from adding new material to the claims for which it had no support in the specification at the time of the original filing) (quoting Festo VIII, 535 U.S. at 741).
47. Id.
48. Id.
49. Id. at 1355 n.2. It should be noted that filing a continuation-in-part application is not a remedy available in all circumstances. For example, if the new matter that the patentee seeks to claim in a continuation-in-part application is already publicly known at the time of the amendment, the claims in the continuation-in-part application that recite the new matter may be rejected based on that prior art.
50. Festo IX, 344 F.3d at 1369 (quoting Festo VIII, 535 U.S. at 740).
51. Id.
52. Id. at 1369–70.
53. Id. at 1369.
54. Pioneer, 330 F.3d at 1357.
55. Id.
56. Id.
58. Id. at 1369–70.
59. Id. at 1374.
60. Id.
61. Chimie v. PPG Industries, Inc., 402 F.3d 1371, 1383 (Fed. Cir. 2005) (“As we have stated, ‘an amendment made to avoid prior art that contains the equivalent in question is not tangential.’ It does not follow, however, that equivalents not within the prior art must be tangential to the amendment.”) (quoting Festo IX, 344 F.3d at 1369).
62. Id. at 1382–83.
63. Id. at 1383.
64. Id.
65. Id. (emphasis added).
cases each year, around 1% of the judge’s caseload. Because the number
of patent cases reaching trial each year has been relatively steady
at around 100 for many years, on average each district judge has one
patent trial every seven years.” Id. at 17 (prepared statement of John B.
Pegram, Esq.). See also Kimberly A. Moore, Forum Shopping in
Patent Cases: Does Geographic Choice Affect Innovation, 79 N.C. L.
Rev. 890, 930 (2001) (“individual district court judges are not seeing
a sufficient number of patent cases to allow them to develop expertise in
resolving these types of highly technical disputes.”).

13. See Hearings, supra note 12, at 10 (“If all patent cases in a
given district were consolidated in one or more designated trial
court judges, they would have a better chance to develop expertise
in this area. The high claim construction reversal rate of district
court judges supports the need for such specialization.”) (prepared
statement of Kimberly Moore).


15. LegalMetric Finds Judges’ Experience Does Not Help in
worldwire.com/pressreleases/15326.