

A PROPOSAL TO RESTRICT THE PATENT LAW DOCTRINE OF EQUIVALENTS WHILE A STATUTORY REMEDY IS AVAILABLE

*Eric J. Faragi**

INTRODUCTION

The patent law doctrine of equivalents, a judicially created doctrine of relief, allows a plaintiff to succeed in a patent infringement action even though the accused infringer has not literally infringed the plaintiff's patent.¹ In such a case, the court will find infringement if the defendant's potentially infringing subject matter is equivalent to what the patentee claims.² The doctrine effectively allows the patentee to broaden the patent claim beyond its literal scope to include subject matter that performs "substantially the same function in substantially the same way to obtain the same result as the claimed subject matter."³ This has the potential of broadening the patentee's monopoly and the scope of protection beyond the initial intentions set forth in the patent application.⁴

There are dangers, however, associated with the doctrine of equivalents—most notably, the uncertainty that the doctrine creates.⁵ Generally speaking, courts should limit infringement to literal infringement when possible.⁶ Such a limitation is consistent with recent case law from the United States Court of Appeals for the Federal Circuit,⁷ which has emphasized the need to narrow a

* J.D. 2004, Seton Hall University School of Law; M.S. 2000, Florida Atlantic University; B.E. 1993, Stevens Institute of Technology.

¹ *Winans v. Denmead*, 56 U.S. 330 (1853). *Winans* is the first Supreme Court case shaping the doctrine of equivalents. *Id.* For a discussion of the establishment of the doctrine of equivalents, see *infra* notes 40-66 and accompanying text.

² *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607-08 (1952).

³ DONALD S. CHISUM, *CHISUM ON PATENTS* § 18.04 (2d ed. 1999).

⁴ *Id.*

⁵ See *Graver Tank & Mfg. Co.*, 339 U.S. at 614-18 (Black, J., dissenting).

⁶ See *infra* notes 156-204 and accompanying text.

⁷ The Federal Circuit is the appeals court for all patent cases. *Holmes Group v. Vornado Air Circulation Sys.*, 535 U.S. 826, 829 (2002).

patentee's rights in cases involving the doctrine of equivalents.⁸ This Comment proposes another mechanism which courts may utilize to narrow the rights of a patentee wishing to use the doctrine of equivalents. Particularly, where the patentee has specific knowledge of a non-literal infringement and willfully does not seek a reissue, the courts should not permit the patentee to appeal to the doctrine of equivalents

In addition to being consistent with recent case law, one can also find support for limiting infringement to literal infringement in a long-standing principle of American jurisprudence—a person cannot appeal to equity when there is an adequate remedy at law.⁹ One might classify the doctrine of equivalents as a remedy in equity because a finding of infringement under the doctrine of equivalents is similar to the equitable remedy of reformation (the jury is essentially rewriting the existing claims in order to find infringement in a particular instance).¹⁰ The Federal Circuit has classified the doctrine of equivalents as an “equitable remedy,” then at least by analogy, the doctrine of equivalents should not be available when a legal, statutory remedy is adequate and available.¹¹

This “inadequate remedy at law” rule has its roots in the English court system, which was principally divided into the law courts and the equity courts.¹² Law courts were rigid in their rules and procedures, while the equity court was a separate court administered by the Chancellor that was more flexible, and focused on fairness.¹³ While the writ system and technical pleading rules of the law courts compartmentalized disputes between parties, as they confined parties

⁸ See *infra* notes 156-204 and accompanying text.

⁹ *Causeway Med. Suite v. Foster*, 43 F. Supp. 2d 604, 610 (E.D. La. 1999) (stating “[i]njunctive relief is an appeal to this Court’s equity jurisdiction. . . . It is a fundamental teaching of equity that injunctive relief is unavailable when the party seeking relief has an adequate remedy at law and will not suffer irreparable injury if the requested equitable relief is denied”) (citations omitted); *East River Sav. Bank v. Sec’y of Hous. & Urban Dev.*, 702 F. Supp. 448, 455 (S.D.N.Y. 1988) (stating “[p]laintiff does not dispute the general proposition that equitable relief is unavailable when there exists an adequate remedy at law. Moreover, an equitable claim cannot proceed where the plaintiff has had and let pass an adequate alternative remedy at law”) (citations omitted).

¹⁰ See *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990).

¹¹ *Am. Home Prods. Corp. v. Johnson & Johnson*, No. 92-1090, 1992 U.S. App. LEXIS 22941, at *7 (Fed. Cir. Sept. 10, 1992) (stating “[b]ut the doctrine of equivalents is not an automatic second prong to every infringement charge. It is an *equitable remedy* available only upon a suitable showing.”) (emphasis added).

¹² LARRY L. TEPLY & RALPH U. WHITTEN, *CASES AND PROBLEMS ON CIVIL PROCEDURE* 12 (1997).

¹³ TEPLY & WHITTEN, *supra* note 12, at 12.

to specific enumerated causes of action in order to obtain relief, parties in equity petitioned the Chancellor to persuade him to relieve them from the injustice that would occur from a strict application of the remedies of common law.¹⁴ Equity thus grew to fill in the holes left by substantive common law and to make a broader range of remedies available.¹⁵ The remedy at law was typically damages; however, if the remedy sought was equitable (typically an injunction, specific performance, rescission, or reformation), a plaintiff generally had no choice but to bring the cause of action in equity court.¹⁶ The common law courts operated as a “brake.”¹⁷ A plaintiff had to appeal to the law courts first, as the courts developed a jurisdictional rule: equity was only available when the remedy at law was unavailable or inadequate.¹⁸ This did not mean that courts of equity would only grant equitable relief.¹⁹ A court of equity could also award damages as relief provided a plaintiff established equity jurisdiction because the remedy sought at law was inadequate or unavailable.²⁰

Under current United States jurisprudence, the separate law and equity courts have largely merged.²¹ This merger, however, has produced a dilemma.²² The inadequate remedy at law rule separated the jurisdiction of the law and equity courts.²³ This rule also controlled whether equitable remedies were available.²⁴ When federal and state government legislatures merged the law and equity courts, the legislatures did not provide direction about which rules should control relief in equity.²⁵ As a result, although a court that

¹⁴ Stephen N. Subrin, *How Equity Conquered Common Law: The Federal Rules of Civil Procedure in Historical Perspective*, 135 U. PA. L. REV. 909, 918 (1987).

¹⁵ Subrin, *supra* note 14, at 920.

¹⁶ TEPLY & WHITTEN, *supra* note 12, at 12. Common law courts did occasionally grant equitable relief under the guise of “writ[s] of prohibition,” but equitable relief for the most part only came from the equity courts. T. PLUCKNETT, *A CONCISE HISTORY OF THE COMMON LAW* 679 (5th ed. 1956).

¹⁷ Subrin, *supra* note 14, at 920.

¹⁸ TEPLY & WHITTEN, *supra* note 12, at 12.

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.* at 12-13.

²² *Id.*

²³ See *Infusaid Corp. v. Intermedics Infusaid, Inc.*, 739 F.2d 661, 668 (Fed. Cir. 1984) (stating “[o]f course, the general rule is that if there is an adequate remedy at law, equitable relief is unavailable”) (citation omitted); *Pageland 29 Ltd. P’ship v. Fed. Deposit Ins. Corp.*, No. 91-1858-LFO, 1992 U.S. Dist. LEXIS 19231, at *13 (D.D.C. Nov. 2, 1993) (stating “[i]n addition, plaintiff’s allegations fail to establish the lack of an adequate remedy at law. Absent such a showing, equitable relief is unavailable”) (citations omitted).

²⁴ TEPLY & WHITTEN, *supra* note 12, at 12-13.

²⁵ *Id.* at 13.

had both law and equity jurisdiction was now granting equitable remedies, it generally only granted an equitable remedy when a legal remedy was inadequate.²⁶

The Patent Act offers a patentee a specific legal remedy—the reissue.²⁷ Using this available legal remedy, a patentee can obtain a reissue patent to expand the scope of his patent claims.²⁸ This allows the patentee to broaden his protection without relying on the court, as long as he complies with the conditions of his available legal remedy.²⁹ The doctrine of equivalents is therefore an available judicially created remedy even when there is a remedy at law, and many patent attorneys representing defendants have asked for its elimination.³⁰

Rather than proposing a complete elimination of the doctrine of equivalents, this Comment proposes limiting the doctrine of equivalents in egregious cases. Particularly, where the patentee has specific knowledge of a non-literal infringement and willfully does not seek a reissue, the courts should not permit the patentee to appeal to the doctrine of equivalents. Part I reviews the doctrine of equivalents. Part II examines the Reissue Application and the statutory rights and requirements associated with it. Part III compares these two remedies. Part IV analyzes the trend toward a narrowing of rights. Part V proposes restricting the doctrine of equivalents in egregious cases.

I. THE DOCTRINE OF EQUIVALENTS

There are two types of patent infringement: literal infringement or infringement by the doctrine of equivalents.³¹ In literal infringement, the invention “reads” on the patent claim.³² A patent

²⁶ *Id.*

²⁷ 35 U.S.C. § 251 (2000). A Reissue is an application filed for after the original patent issues. *Id.* The purpose of a reissue is to correct an inadvertent mistake, generally when the issued claims are too narrow or because the technology went in a direction where the patentee seeks broader claims. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 615 (1952) (Black, J., dissenting). The original application must support the new claims. 35 U.S.C. § 251 (2000).

²⁸ *Id.*

²⁹ *See infra* notes 147-50 and accompanying text.

³⁰ *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997).

³¹ *Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1148 (Fed. Cir. 2003).

³² “Reads” on a patent claim means “all limitations of the claim are found in the reference, or ‘fully met’ by it.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

claim defines the invention.³³ It is analogous to a real property deed that defines the metes and bounds of an estate holder's real property.³⁴ In order to infringe a claim, an infringer must use every single word in the claim.³⁵ Consider the following claim to a chair:

A sitting device comprising:

1. Four supports; and
2. A horizontal member perpendicularly connected to the four supports.

A chair with four or more legs will literally infringe this claim because of the word "comprising," a term of art, which means "including but not limited to" or "at least."³⁶ A stool with three legs, however, will not literally infringe this claim because three is not "at least" four. The patentee, therefore, cannot assert a literal infringement claim against a party using a sitting device with three legs. One must determine what is truly the invention in this hypothetical. The novelty of this arrangement can be either of the following: a specific amount of legs (four) connected to a horizontal member; or the fact that a horizontal member is connected to legs. If it is the latter, and a competitor of the patentee sees the original claim to four legs and then designs a device using three legs in order to circumvent the claim, that competitor successfully avoids the patent claim but still "practices," or uses, the invention.³⁷ When a defendant's invention, however, uses what is substantially the claimed invention, even though it is not literally infringing, the courts permit the patentee to sue under the doctrine of equivalents.³⁸ In this instance, the doctrine of equivalents would allow the patentee to sue if the court finds that four is "equivalent" to three.³⁹

A. *Establishment of the Doctrine of Equivalents*

The first Supreme Court case shaping the doctrine of equivalents was *Winans v. Denmead*.⁴⁰ The invention at issue in *Winans* involved railroad cars with circular rather than the traditional,

³³ Rambus Inc. v. Infineon Techs. AG, 318 F.3d 1081, 1088 (Fed. Cir. 2003).

³⁴ See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989).

³⁵ Cedarapids, Inc. ex rel. El-Jay Div. v. Nordberg, Inc., 895 F. Supp. 1230, 1271 (N.D. Iowa 1995).

³⁶ Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501 (Fed. Cir. 1997).

³⁷ "Practicing" means using the invention. Hartford-Empire Co. v. United States, 323 U.S. 386, 412 (1945).

³⁸ Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608 (1952).

³⁹ See *id.*

⁴⁰ 56 U.S. 330 (1853).

rectangular walls.⁴¹ The problem with the rectangular walls of the existing cars was that the stress on the walls caused them to break when filled with coal or other heavy items.⁴² The existing design allowed the railroad cars to transport a maximum weight in coal that equaled the weight of the car itself, while the patented design allowed the railroad cars to transport a maximum weight in coal of at least double that amount.⁴³ Plaintiff's circular wall design reduced the stress on the walls because the circular wall design supported the load in every direction.⁴⁴ The defendants in *Winans* made railroad cars similar to those the plaintiff produced, with the following exception: the defendant used walls of an octagonal shape rather than a circular shape, to achieve similar stress reducing results.⁴⁵ The question before the Court was whether the claims limited the patentee to circular inventions, or whether octagonal designs infringed as well.⁴⁶ The Court held for the patentee finding that octagonal was substantially similar, or "equivalent," to circular in this circumstance.⁴⁷

The Supreme Court in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*⁴⁸ set out the modern contours of the doctrine of equivalents.⁴⁹ The invention at issue in *Graver Tank* involved electric arc welding and specific fluxes, and of particular importance to the patentee was the ability to weld metal plates quickly with reliable strength.⁵⁰ The alleged infringer used a flux that was substantially similar to that of the patentee, except that the alleged infringer used a silicate with manganese, which was not an "alkaline earth metal" as claimed by the patentee, rather than a silicate with magnesium.⁵¹ In *Graver Tank*, the majority held that courts may consider one an infringer if there is equivalence between elements of an accused device and elements of the claimed invention.⁵² Writing for the majority, Justice Jackson explained that for courts to allow someone

⁴¹ *Id.* at 339.

⁴² *Id.*

⁴³ *Id.* at 331.

⁴⁴ *Id.*

⁴⁵ *Id.* at 340.

⁴⁶ *Winans*, 56 U.S. at 339.

⁴⁷ *Id.* at 344. This Court rendered this verdict when patent applications used "central claiming," and as such, a patentee is entitled to the invention in every form unless the patentee intended to disclaim such forms. *See id.* at 342; *infra* text accompanying notes 81-85.

⁴⁸ 339 U.S. 605 (1952).

⁴⁹ *Id.*

⁵⁰ *Id.* at 610.

⁵¹ *Id.*

⁵² *Id.* at 612.

to imitate a patented invention while leaving out merely minute details would convert the protection the patent grant affords into “a hollow and useless thing.”⁵³ Justice Jackson further noted that this kind of limitation would encourage an “unscrupulous copyist” to make insignificant changes to his otherwise copied subject matter to be take the copied subject matter outside the scope of the claims, and hence leaving the patentee with no recourse under the law,⁵⁴ because a person seeking to copy an invention would normally introduce some minor alterations in order to conceal the piracy.⁵⁵ The Court explained that without the doctrine of equivalents, it would have to determine infringement in patent law by rules of form rather than substance,⁵⁶ and this would deprive a patentee of “the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.”⁵⁷ In this respect, the Court noted that the essence of the doctrine of equivalents is to prevent the defendant from practicing a fraud on the patent.⁵⁸ As a result, when the defendant’s invention performs substantially the same function, in substantially the same way, producing substantially the same result, the court will find infringement.⁵⁹

⁵³ *Id.* at 607.

⁵⁴ *Graver Tank*, 339 U.S. at 607.

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.* *But see* Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 39 (1997) (finding that fraud on the patent is not the only reason to invoke the doctrine of equivalents). Practicing a fraud on the patent means “making, using, or selling a device which meets the test of equivalence when compared to a patented invention but which avoids the claim language.” *Coleco Indus. Inc. v. Int’l Trade Comm’n.*, 573 F.2d 1247, 1254-55 (C.C.P.A. 1978).

⁵⁹ *Graver Tank*, 339 U.S. at 608. In a more recent case, however, *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 (1997), the Court changed the wording of this equivalent infringement test. The Court stated:

In our view, the particular linguistic framework used is less important than whether the test is probative of the essential inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention? Different linguistic frameworks may be more suitable to different cases, depending on their particular facts. A focus on individual elements and a special vigilance against allowing the concept of equivalence to eliminate completely any such elements should reduce considerably the imprecision of whatever language is used. An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element. With these limiting principles as a backdrop, we see no

Courts designed the doctrine of equivalents to promote fairness.⁶⁰ When courts invoke the doctrine of equivalents, they essentially reform the claims of an existing patent claim to cover an insubstantial change.⁶¹ The doctrine of equivalents is designed “to relieve an inventor from a semantic strait jacket when equity requires, it is not designed to permit wholesale redrafting of a claim to cover non-equivalent devices.”⁶² Courts have realized that “[l]iteral adherence to the written claim in determining the scope of the protection can invite unfair subversion of a valuable right, which would substantially diminish the economic value of patents.”⁶³ Recently, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*,⁶⁴ the Supreme Court acknowledged that even a minor extension of protection beyond the literal wording of a patent may create substantial uncertainty about the point at which the patent monopoly ends.⁶⁵ This uncertainty can hinder “a legitimate investment in technology-based products and services.”⁶⁶

B. Arguments against the Doctrine of Equivalents

Many have argued that the doctrine of equivalents should not even exist for at least four reasons. First, the doctrine is contrary to the second paragraph of section 112 of the Patent Act.⁶⁷ Second, Congress implicitly rejected the doctrine by using the word “equivalents” in the patent statute in another context.⁶⁸ Third, courts originally created the doctrine when patent applications used central

purpose in going further and micro-managing the Federal Circuit’s particular word-choice for analyzing equivalence. We expect that the Federal Circuit will refine the formulation of the test for equivalence in the orderly course of case-by-case determinations, and we leave such refinement to that court’s sound judgment in this area of its special expertise.

Id. (emphasis added).

⁶⁰ DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW 874 (2d ed. 2001).

⁶¹ See *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990).

⁶² *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed. Cir. 1987).

⁶³ CHISUM, *supra* note 60, at 874.

⁶⁴ 535 U.S. 722 (2002).

⁶⁵ *Id.* at 727.

⁶⁶ CHISUM, *supra* note 60, at 874.

⁶⁷ *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 613-14 (1952) (Black, J., dissenting).

⁶⁸ *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 25-26 (1997) (discussing changes to 35 U.S.C. § 112 para. 6 (1994)).

claiming,⁶⁹ a style of claiming that Congress overruled by statute.⁷⁰ Finally, a statutory remedy is available through the reissue.⁷¹

Many, including Justice Black who dissented in *Graver Tank*, have argued that the doctrine of equivalents is contrary to the second paragraph of section 112 of the Patent Act, which provides that “an applicant shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.”⁷² Justice Black reiterated that the patent statute specifically requires a claim, and that a claim precisely defines the invention and is something that a defendant infringes literally.⁷³ Justice Black explained “it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms” . . . , and giving the “patentee the benefit of a grant that it did not precisely claim is no less ‘unjust to the public’ and no less an evasion of [the patent statute] merely because done in the name of the ‘doctrine of equivalents.’”⁷⁴

A second argument against the doctrine is that the patent statute uses the word “equivalents”⁷⁵ in another context and thus Congress implicitly rejected the doctrine.⁷⁶ The courts through case law, rather

⁶⁹ An example of a central patent claim is as follows: “I claim as my invention a method substantially as shown and described in my patent application.” See *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342 (1853).

⁷⁰ *Warner-Jenkinson*, 520 U.S. at 27.

⁷¹ *Graver Tank*, 339 U.S. at 614-15 (Black, J., dissenting).

⁷² *Id.* at 613-14 (Black, J., dissenting) (citing the predecessor statute to 35 U.S.C. § 112 para. 2 (2000)).

⁷³ *Id.* at 614 (Black, J., dissenting).

⁷⁴ *Id.*

⁷⁵ 35 U.S.C. § 112 para. 6 (2000).

⁷⁶ See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 27-28 (1997). The 1952 Patent Act in section 112, paragraph 6 contains a “means for” claiming provision that incorporates the term “equivalents,” which is not contained in the 1870 Patent Act. *Id.* Under the new provision, an applicant can claim his invention by the function it serves, instead of describing the element it uses (e.g., “a means of connecting Part A to Part B,” rather than “a two-penny nail”). *Id.* The decision in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946) prompted Congress to enact section 112, paragraph 6. *Id.* In that case, the Court rejected patent claims that do not particularly describe the invention but rather employ functional language. *Id.* Although section 112, paragraph 6 now allows “means for” claims, the patentee is not entitled to every conceivable “means” that will perform that function. *Id.* at 28. Instead, the patentee is only entitled to those “means” disclosed in his specification, or “equivalents” thereof. *Warner-Jenkinson*, 520 U.S. at 28. The Court noted that “[t]his is an application of the doctrine of equivalents in a restrictive role, narrowing the application of broad literal claim elements. We recognized this type of role for the doctrine of equivalents in *Graver Tank* itself.” *Id.* Section 112, paragraph 6, however, “is silent on the doctrine of equivalents as applied where there is no literal infringement.” *Id.* The Court further explained:

Because § 112, ¶ 6 was enacted as a targeted cure to a specific problem,

than Congress via statute, established the doctrine of equivalents.⁷⁷ In 1952, Congress revised the Patent Act and added the term “equivalents” with regard to a “means for” claim in the statute.⁷⁸ At that time, Congress knew that the courts were using a word such as “equivalents,” but it did not include the doctrine of equivalents in the patent statute.⁷⁹ Thus, some argue that because Congress used the word “equivalents” in other parts of the statute but remained silent about a “doctrine” of equivalents, that the doctrine should not exist.⁸⁰

A third argument against the doctrine of equivalents is that courts created it at a time when patent applications used “central claiming” as opposed to distinct claims, which the patent statute presently requires.⁸¹ A typical patent claim example during this time was “I claim as my invention an apparatus substantially as shown and described in my patent application.”⁸² A patentee was thus entitled to whatever he included in his disclosure to the Patent Office.⁸³ This type of claim language was significantly less precise than, for example, the aforementioned patent claim to a chair: “A sitting device comprising: four supports; and a horizontal member perpendicularly connected to the four supports.” In this example, regardless of the types of chairs the applicant discloses in his patent application, the current law limits his property right to specifically what he includes in the patent claims.⁸⁴ Because the patent statute now requires distinct claims, as opposed to general “central claims,”

and because the reference in that provision to “equivalents” appears to be no more than a prophylactic against potential side effects of that cure, such limited congressional action should not be overread for negative implications. *Congress in 1952 could easily have responded to Graver Tank as it did to the Halliburton decision.* But it did not. Absent something more compelling than the dubious negative inference offered by petitioner, the lengthy history of the doctrine of equivalents strongly supports adherence to our refusal in *Graver Tank* to find that the Patent Act conflicts with that doctrine. *Congress can legislate the doctrine of equivalents out of existence any time it chooses.* The various policy arguments now made by both sides are thus best addressed to Congress, not this Court.

Id. (emphasis added) (internal citations omitted).

⁷⁷ *Warner-Jenkinson*, 520 U.S. at 28.

⁷⁸ 35 U.S.C. § 112 para. 6 (2000). For further discussion of the history of this change, see *supra* note 76.

⁷⁹ *Warner-Jenkinson*, 520 U.S. at 28.

⁸⁰ *See id.* See also discussion *supra* note 76 for the Supreme Court’s treatment of this argument.

⁸¹ *Warner-Jenkinson*, 520 U.S. at 27.

⁸² *See Winans v. Denmead*, 56 U.S. (15 How.) 330, 342 (1853).

⁸³ *See id.*

⁸⁴ *See* 35 U.S.C. § 112 para. 2 (2000).

some argue that there is no longer a need for the doctrine of equivalents.⁸⁵

A fourth argument against the doctrine of equivalents is that Congress created a statutory remedy at law, the reissue, which should supplant the doctrine.⁸⁶ In *Graver Tank*, Justice Black pointed out that the patentee has a remedy at law if the patent is wholly or partly inoperative as a result of inadvertent errors of the patentee.⁸⁷ If the patent claims are too narrow as a result of an inadvertent error, the patentee is not without a legal remedy.⁸⁸ The patentee can go back to the Patent Office, admit his mistake, and seek to broaden his claims with a reissue.⁸⁹ Thus, if the claims are too narrow, there is a statutory method, not a judicially created method, to broaden the claims.⁹⁰ If Congress declared via the Patent Act that a patentee can only broaden the claims within two years of the original patent grant, the courts should not then permit broadening under the doctrine of equivalents after this statutory time period has expired.⁹¹

Although these arguments for eliminating the doctrine of equivalents may seem appealing, the courts should not eliminate the doctrine, but instead should limit its use in egregious cases. The doctrine should not be available when the patentee has specific knowledge of a non-literal infringement and willfully does not seek a reissue.

⁸⁵ See *Warner-Jenkinson*, 520 U.S. at 27.

⁸⁶ See 35 U.S.C. § 251 (2000).

⁸⁷ *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 615-16 (1952) (Black, J., dissenting). Justice Black explained:

Congress was careful to hedge the privilege of reissue by exacting conditions. It also entrusted the Patent Office, not the courts, with initial authority to determine whether expansion of a claim was justified, and barred suits for retroactive infringement based on such expansion. Like the Court's opinion, this congressional plan adequately protects patentees from "fraud," "piracy," and "stealing." Unlike the Court's opinion, it also protects business men from retroactive infringement suits and judicial expansion of a monopoly sphere beyond that which a patent expressly authorizes. The plan is just, fair, and reasonable. In effect it is nullified by this decision undercutting what the Court has heretofore recognized as wise safeguards. One need not be a prophet to suggest that today's rhapsody on the virtue of the "doctrine of equivalents" will . . . make enlargement of patent claims the "rule" rather than the "exception."

Id. (citations omitted).

⁸⁸ 35 U.S.C. § 251 (2000).

⁸⁹ *Graver Tank*, 339 U.S. at 615 (Black, J., dissenting).

⁹⁰ See *id.*; 35 U.S.C. § 251 (2000).

⁹¹ See *Graver Tank*, 339 U.S. at 615 (Black, J., dissenting). According to 35 U.S.C. § 251, a patentee has two years from the issue date of the patent to file for a reissue to broaden the original claims. *Id.*

II. THE REISSUE

The reissue, a statutory remedy that Congress originally created in the 1870 Patent Act, permits the patentee to correct an inadvertent mistake that would render the patent “wholly or partly inoperative or invalid” after a patent issues.⁹² The patentee must have made the mistake “through error without any deceptive intention.”⁹³ A patentee whose patent issues with claims that are not sufficiently broad is therefore not left without a remedy, as “inoperative or invalid” in the statute covers the situation where the claims of the patent are too narrow.⁹⁴ Courts have held that a number of reasons will satisfy the requirement of a “mistake” for purposes of the statute, thus allowing the patentee to file a reissue application in the United States Patent and Trademark Office to seek broader claims.⁹⁵ These reasons include the following: the patent attorney drafted the application poorly, the attorney did not truly comprehend the essence of the invention, the technology progressed in a direction different than that which was anticipated by the patentee, or because of some other inadvertent reason the claims in the issued patent are simply too narrow.⁹⁶

A. *Enablement in the context of a Reissue Patent*

The important policy concerning a reissue application is harm to the expectations of the public.⁹⁷ A patentee seeking to broaden his patent claims via a reissue may harm these expectations because the public, including the patentee’s competitors, may have relied on the original claim language in shaping their commercial behavior.⁹⁸ A patentee seeking a reissue must comply with the same relevant provisions of the Patent Act as an inventor seeking a non-reissue

⁹² *Miller v. Brass Co.*, 104 U.S. 350, 353 (1881); *see also* 35 U.S.C. § 251 (2000). When filing a reissue application, the patentee must surrender his original patent grant to the United States Patent and Trademark Office. 35 U.S.C. § 252 (2000). The reissue application, if it issues, will then issue with the prefix “RE” in front of the patent number. 37 C.F.R. § 1.173 (2004).

⁹³ 35 U.S.C. § 251 (2000).

⁹⁴ *See Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1055 (Fed. Cir. 2002).

⁹⁵ *Id.* Of course, the original application must support these broader claims. *Id.*

⁹⁶ *Id.*

⁹⁷ CHISUM, *supra* note 60, at 129 (acknowledging that “an inventor who attempts to broaden the scope of his claims through reissue may harm the public’s expectations, including competitors of the patentee, who have relied on the original claim language”).

⁹⁸ *Id.*

patent.⁹⁹ Thus, the reissue application must comply with sections 101,¹⁰⁰ 102,¹⁰¹ 103,¹⁰² and 112 of the Patent Act.¹⁰³ The first paragraph of section 112 has three distinct requirements: written description, best mode, and enablement.¹⁰⁴ The requirement of a written description assures the public that the inventor is in full possession of the invention prior to granting the patentee a monopoly on the invention.¹⁰⁵ The inventor must disclose the best mode he contemplated at the time of the patent application filing.¹⁰⁶

Most relevant to the doctrine of equivalents is the enablement requirement.¹⁰⁷ For an application to satisfy the enablement requirement, a person of ordinary skill in the art must be able to make and use the invention “as broadly as it is claimed”¹⁰⁸ without “undue experimentation.”¹⁰⁹ The purpose of the enablement requirement is to put the public on notice as to what the invention

⁹⁹ *Armstrong v. Emerson Radio & Phonograph Corp.*, 179 F. Supp. 95, 97 (S.D.N.Y. 1959).

¹⁰⁰ 35 U.S.C. § 101 provides that an invention must be useful to qualify for patent protection. *Id.*

¹⁰¹ 35 U.S.C. § 102 provides that an invention must be new to qualify for patent protection. *Id.*

¹⁰² 35 U.S.C. § 103 provides that an invention must be nonobvious to qualify for patent protection. *Id.*

¹⁰³ *Armstrong*, 179 F. Supp. at 97. 35 U.S.C. § 112 provides:

The specification shall contain a *written description* of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to *enable* any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the *best mode* contemplated by the inventor of carrying out his invention.

Id. (emphasis added)

¹⁰⁴ 35 U.S.C. § 112 para. 1 (2000).

¹⁰⁵ *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 434 (1822). Simply speculating on what arrangement might work to achieve the intended results is not sufficient. *See id.*

¹⁰⁶ 35 U.S.C. § 112 para. 1 (2000). If the inventor contemplated a better mode, yet concealed it from the public, the patent is invalid. *See id.*

¹⁰⁷ *See infra* notes 147-50 and accompanying text.

¹⁰⁸ *Nat'l Recovery Techs. Inc. v. Magnetic Separation Sys. Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999) (citing *In re Goodman*, 11 F.3d 1046, 1050 (Fed. Cir. 1993)).

¹⁰⁹ *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The court stated:

Factors to be considered in determining whether a disclosure would require undue experimentation . . . include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id.

actually is.¹¹⁰ The broadest patent claim one can obtain in a reissue (or a non-reissue) is therefore “equal to the scope of the enablement.”¹¹¹

Any patent not enabled is invalid.¹¹² Suits brought under the doctrine of equivalents, however, may have broadened patent claims that the patent specification does not enable.¹¹³ Consider once again the following claim to a chair:

A sitting device comprising:

1. Four supports; and
2. A horizontal member perpendicularly connected to the four supports.

Assume also that the patent specification, drawings, and claims only disclose a chair with four supports. Assume further that the patent specification makes no mention of having more than four or less than four supports, and that having less than four supports is not an obvious improvement.¹¹⁴ A competitor of the patentee may, seeing this patent, avoid literal infringement by designing and manufacturing a sitting device with three supports.¹¹⁵ Nowhere in the patent had the patentee disclosed a member with less than four supports. The competitor could not have been on notice that a sitting device with three supports would infringe this patent. Yet, the court could find infringement by the doctrine of equivalents if it found that three is equivalent to four, even though the patentee had never taught the public how to make and use a sitting device with three supports. This defeats the purpose of section 112 of the Patent Act—which prevents this type of uncertainty that the doctrine of equivalents creates.

B. Intervening Rights in context of a Reissue Patent

When a patentee obtains a reissue, he must surrender the original patent to the United States Patent and Trademark Office.¹¹⁶

¹¹⁰ See *Nat'l Recovery Techs.*, 166 F.3d at 1195-96.

¹¹¹ *Id.* at 1196.

¹¹² See 35 U.S.C. § 112 (2000).

¹¹³ Case law is silent on whether the patent specification must enable an “equivalent” claim under the doctrine of equivalents. See *infra* notes 147-50 and accompanying text.

¹¹⁴ 35 U.S.C. § 103 provides that nonobviousness is a condition for patentability. *Id.*

¹¹⁵ The competitor could not manufacture a sitting device with four or more legs because of the word “comprising.” See discussion *supra* note 36 and accompanying text.

¹¹⁶ 35 U.S.C. § 252 (2000).

Since the patentee surrenders the original patent, courts, at one point in history, acted as if it never even existed.¹¹⁷ This surrender of the original patent precluded an infringement cause of action for acts performed prior to the surrender because after the surrender, no patent existed.¹¹⁸ Further, courts would dismiss any suits filed before the surrender of the original patent for failure to state a claim on which relief could be granted.¹¹⁹

To mitigate the harsh effect of the surrender, Congress responded to the courts' treatment of the original surrendered patent by providing a form of continuity in certain circumstances if the claims of the original are carried over and "identical" in the reissue.¹²⁰ The statute requires the claims be identical in order to relate back to the issue date of the original.¹²¹ Mere similarity between the claims in the reissue and the original is insufficient, as the original claims are "dead."¹²² Liability for infringement of any new or amended claims in the reissue, therefore, commences only from the issue date of the reissue.¹²³

Congress has provided the patentee with a two-year window in which the patentee is allowed to broaden the original claims of the issued patent through the reissue process.¹²⁴ Even with this two-year

¹¹⁷ *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 827 (Fed. Cir. 1984).

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ 35 U.S.C. § 252 para. 1 provides:

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

Id.

¹²¹ 35 U.S.C. § 252 (2000). Consider an invention with three patent claims. If the patentee is satisfied with the first claim, but decides the second and third claim are wholly or partly inoperative, he can surrender the patent and seek a reissue to broaden the scope of the second and third claims. *See Seattle Box Co.*, 731 F.2d at 827. When the reissue patent issues, if a person were practicing an invention that was infringing the first claim when the original patent issued, the law will consider this person an infringer as of the day the original patent issued as long as the first claim in the reissue is identical to the first claim of the original patent. *See id.*

¹²² *Id.*

¹²³ *Id.*

¹²⁴ 35 U.S.C. § 251 (2000).

limitation, however, a reissue can unsettle a competitor's expectations.¹²⁵ The patentee's competitor may have relied on the original claim language in shaping his commercial behavior and may have capitalized on subject matter disclosed, but not claimed in the original patent.¹²⁶ During the first two years of the original patent term, the competitor may have made a significant investment "only to have the reissue lay claim to this previously unoccupied area."¹²⁷

Congress responded to this problem by creating the doctrine of intervening rights,¹²⁸ which guards against interference with a third party's expectations.¹²⁹ Under certain conditions, a reissue will not affect certain rights of those who practiced the invention prior to the issue date of the reissue.¹³⁰ As a result of practicing the invention before the reissue was granted, "an infringer might enjoy a 'personal intervening right' to continue what would otherwise be infringing activity after reissue."¹³¹ The rationale for the doctrine of intervening rights is that the public, including competitors of the patentee, obtains the right to use anything not claimed specifically in the original patent.¹³² Although in certain circumstances a patentee may recapture in a reissue subject matter dedicated to the public because he inadvertently failed to include it in the claims of the original

¹²⁵ *Seattle Box Co.*, 731 F.2d at 827.

¹²⁶ *Id.*

¹²⁷ CHISUM, *supra* note 60, at 129.

¹²⁸ 35 U.S.C. § 252 (2000).

¹²⁹ CHISUM, *supra* note 60, at 129.

¹³⁰ *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 756 F.2d 1574, 1579 (Fed. Cir. 1985). The court summarized 35 U.S.C. § 252 para. 2 as follows:

(1) No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. (2) The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which *substantial preparation was made before the grant of the reissue*, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which *substantial preparation was made, prior to the grant of the reissue*, to the extent and under such terms as the court deems equitable for the *protection of investments made or business commenced before the grant of the reissue*.

Id. (emphasis in original).

¹³¹ *Seattle Box Co.*, 756 F.2d at 1579.

¹³² *Id.*

patent, he may not do so at the “expense of innocent parties.”¹³³ A court may therefore permit a competitor to continue to practice an invention claimed in a reissue if it determines that equity dictates this result.¹³⁴

When a reissue issues, it is presumed valid.¹³⁵ It has “the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in amended form.”¹³⁶ Upon first glance, this language appears to prevent courts from protecting intervening rights. The second paragraph of section 252 of the Patent Act, however, modifies this language to protect intervening rights.¹³⁷ Further, when a defendant properly raises the doctrine of intervening rights, courts fashion a remedy using their broad equitable powers if circumstances warrant.¹³⁸ Courts have discretion to fashion the remedy from “a wide range of options available” to them.¹³⁹ If, however, the activity of the

¹³³ *Id.*; see also *Sontag Chain Stores Co. v. Nat'l Nut Co.*, 310 U.S. 281, 293 (1940) (allowing the defendant to continue to practice the invention that was later within the scope of the reissue claims where the defendant built and operated its equipment in a form that the original patent did not claim).

¹³⁴ *Seattle Box Co.*, 756 F.2d at 1579.

¹³⁵ *Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 829 (Fed. Cir. 1984); see also 35 U.S.C. § 282 (2000).

¹³⁶ 35 U.S.C. § 252 (2000).

¹³⁷ 35 U.S.C. § 252 para. 2 provides:

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.

Id.

¹³⁸ *Seattle Box Co.*, 731 F.2d at 830. 35 U.S.C § 252 para. 2 provides:

The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

Id. (emphasis added).

¹³⁹ *Seattle Box Co.*, 731 F.2d at 830.

defendant infringes a claim of the reissue that is identical to a claim in the original, the defendant will find no protection under the doctrine of intervening rights.¹⁴⁰ Consider once again the following claim to a chair:

A sitting device comprising:

1. Four supports; and
2. A horizontal member perpendicularly connected to the four supports.

Assume that a competitor of the patentee was manufacturing a sitting device with three supports at the time this patent issues. If the patentee seeks a reissue application to broaden his patent claim to cover a sitting device with three supports, even if he is successful in obtaining a reissue, the courts will allow the competitor of the patentee to continue to manufacture the sitting device with three supports because of the doctrine of intervening rights.

III. COMPARISON OF REQUIREMENTS UNDER THE DOCTRINE OF EQUIVALENTS TO THE REISSUE

The doctrine of equivalents and the reissue process coexist in patent law. Just as there is “no fundamental inconsistency between equity and common law,”¹⁴¹ there is no fundamental inconsistency between the doctrine of equivalents and the reissue process.¹⁴² As such, “the availability of the reissue process [does] not vitiate the viability of the doctrine of equivalents for products that do not literally infringe a patent.”¹⁴³ The patentee frequently uses both the doctrine of equivalents and the reissue process to broaden claims in order to capture subject matter not covered by the original claims.¹⁴⁴ The doctrine of equivalents, however, need not duplicate the patent statute’s method of correcting errors in claims.¹⁴⁵

A. *Enablement in the context of the Doctrine of Equivalents*

Whether or not a patent must enable an equivalent claim is not clear, as case law is silent on this matter.¹⁴⁶ *Wilson Sporting Goods v.*

¹⁴⁰ *Id.*

¹⁴¹ PLUCKNETT, *supra* note 16, at 679.

¹⁴² *See* Wahpeton Canvas Co. v. Bremer, 958 F. Supp. 1347, 1356 (N.D. Iowa 1997).

¹⁴³ *Id.* at 1356 (citing Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 25-26 (1997)).

¹⁴⁴ *See* Sage Prods. v. Devon Indus., 126 F.3d 1420, 1424 (Fed. Cir. 1997).

¹⁴⁵ Johnson & Johnston Assocs. v. R.E. Serv. Co., 285 F.3d 1046, 1059 (Fed. Cir. 2002) (Rader, J, concurring).

¹⁴⁶ *See infra* notes 147-50 and accompanying text.

*David Geoffrey & Associates*¹⁴⁷ prevents the doctrine of equivalents from expanding claim scope to embrace prior art.¹⁴⁸ The “equivalent claims” therefore must comply with sections 102 and 103 of the Patent Act,¹⁴⁹ but the court was silent on compliance with the enablement requirement of section 112.¹⁵⁰

The benefit to the patentee of circumventing the enablement requirement is that the patentee potentially can obtain broader coverage than he could have using the legal remedy of a reissue application, because a reissue must comply with the same relevant portions of the Patent Act as a non-reissue application.¹⁵¹ In an egregious case such as when the patentee had knowledge of the infringing activity and did not seek a reissue, the law should strictly confine the patentee to the claim scope he would be able to obtain by a reissue application.

The entire purpose of section 112 of the Patent Act is to put the public on notice as to what the patentee is claiming as his invention.¹⁵² By permitting a suit under the doctrine of equivalents in a case where the patentee knows that literal infringement does not exist, the courts are allowing the patentee to circumvent the enablement requirement.¹⁵³ This could lead to more unfairness than the injustice the doctrine of equivalents itself seeks to solve, as a patentee who did not draft claims as broadly as he should have, may in this instance make an assertion of infringement with “equivalent claims” that he did not enable. The law should force a patentee in an egregious case to avail himself of his adequate legal remedy of the reissue, prior to permitting him to seek a judicially created remedy through the doctrine of equivalents. Alternatively, courts should require equivalent claims under the doctrine of equivalents to meet the enablement requirement of section 112.

B. Intervening Rights in the context of the Doctrine of Equivalents

Although Congress has granted certain statutory protections to an infringer of claims of a reissued patent that were not identical to claims in the original patent, no such statute exists to protect someone held liable as an infringer under the doctrine of

¹⁴⁷ 904 F.2d 677 (Fed. Cir. 1990).

¹⁴⁸ *Id.* at 683.

¹⁴⁹ *Id.*

¹⁵⁰ Case law is silent on compliance with 35 U.S.C. § 112. *See id.* at 684.

¹⁵¹ *See* *Armstrong v. Emerson Radio & Phonograph Corp.*, 179 F. Supp. 95, 97 (S.D.N.Y. 1959).

¹⁵² *Athletic Alternatives v. Prince Mfg.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

¹⁵³ *See* discussion *infra* note 164.

equivalents.¹⁵⁴ In fact, if courts determine that one is infringing under the doctrine of equivalents, they are free to enjoin the infringer from practicing the invention at all, even though the infringer may have invested significant resources into practicing an invention he did not literally infringe.¹⁵⁵ When a patentee knows that a potential non-literal infringer is relying on his patent and is shaping his commercial behavior around it, the law should force the patentee to broaden his claim through a reissue application. Alternatively, the courts should provide for the same statutory intervening rights as those that are afforded an infringer of a reissue patent.

IV. ANALYSIS OF THE TREND TOWARD NARROWING OF A PATENTEE'S RIGHTS

The Federal Circuit has demonstrated a trend toward narrowing a patentee's rights, primarily in applying remedies that are equitable in nature.¹⁵⁶ First, the doctrine of equivalents may not be used to cover prior art.¹⁵⁷ Second, the patentee cannot under the doctrine of equivalents obtain patent coverage to material disclosed in the patent specification but not claimed as his invention.¹⁵⁸ Third, prosecution history estoppel¹⁵⁹ applies to patent claims amended during the prosecution of the patent.¹⁶⁰ Fourth, the defense of laches still applies to long delays in patent prosecution.¹⁶¹ Fifth, courts will construe patent claims narrowly when the claim language is ambiguous.¹⁶² This narrowing of rights is consistent with the

¹⁵⁴ See 35 U.S.C. § 252 (2000).

¹⁵⁵ A court using its equitable powers would decide this, but the application could be inconsistent in the absence of a statute on point. See *Burns v. Windsor Ins. Co.*, 31 F.3d 1092, 1097 (11th Cir. 1994) (noting possible inconsistencies in court construction of statutes absent congressional guidance).

¹⁵⁶ *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1056-59 (Fed. Cir. 2002) (Rader, J., concurring).

¹⁵⁷ *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990). A reference which would render a prospective invention as being not "new" is "prior art" under 35 U.S.C. § 102, while a reference which would render an invention as being "obvious" is "prior art" under 35 U.S.C. § 103. See *Wilson Sporting Goods*, 904 F.2d at 684.

¹⁵⁸ *Johnson & Johnston Assocs.*, 285 F.3d at 1054-55.

¹⁵⁹ "Prosecution history" refers to the "public record of the patent proceedings," such as the original as-filed patent application, correspondence to and from the Patent Office during the pendency of the application, and changes to the patent application during the proceedings. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727-28 (2002).

¹⁶⁰ *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997).

¹⁶¹ *Symbol Techs. Inc. v. Lemelson Med.*, 277 F.3d 1361, 1363, 1368 (Fed. Cir. 2002).

¹⁶² *Athletic Alternatives v. Prince Mfg.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

proposition that, in an egregious case, when a patentee knows of the non-literal infringement and willfully does not seek his legal remedy of a reissue, the remedy under the doctrine of equivalents should be unavailable.¹⁶³

The first example of the narrowing of a patentee's rights is that a patentee may not use the doctrine of equivalents to broaden claims to the point where the equivalent claims would cover prior art.¹⁶⁴ In *Wilson Sporting Goods*,¹⁶⁵ the court admitted that determining whether or not "prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer," and that visualizing a hypothetical claim often helps conceptualize the "limitation on the scope of equivalents."¹⁶⁶ The real question is whether the Patent and Trademark Office would have originally allowed the claim when the patent issued in light of the prior art.¹⁶⁷ If not, the patentee cannot broaden coverage under the doctrine of equivalents.¹⁶⁸ If the Patent and Trademark Office would have allowed the claim, then courts may find infringement under the doctrine.¹⁶⁹

As the *Wilson Sporting Goods* Court suggested visualizing a hypothetical claim, consider again the hypothetical patent claim previously discussed:

A sitting device comprising:

1. Four supports; and

2. A horizontal member perpendicularly connected to the four supports.

If at the time of this patentee's filing, a sitting device with two supports existed in the public domain, the patentee will not be allowed to broaden his claim through the doctrine of equivalents (or a reissue) to include a claim to one support.¹⁷⁰ In this instance, the patentee could only broaden his claim to read "three supports" because that is not excluded by the prior art.¹⁷¹

Another example of the narrowing of rights is that, similar to a reissue application, a patentee through the doctrine of equivalents

¹⁶³ See *infra* notes 164-204 and accompanying text.

¹⁶⁴ *Wilson Sporting Goods*, 904 F.2d at 684. This applies to 35 U.S.C. § 102 and 35 U.S.C. § 103, which the court referred to as "prior art." *Id.* The court was silent regarding 35 U.S.C. §112. See *id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Wilson Sporting Goods*, 904 F.2d at 684.

¹⁶⁹ *Id.*

¹⁷⁰ See *id.*

¹⁷¹ See *id.*

may not obtain coverage of subject matter disclosed but not claimed as his invention after the patent issue.¹⁷² As early as 1881, in the case of a reissue, courts have treated subject matter disclosed but not claimed as in the public domain.¹⁷³ This issue was unsettled until 2002 in the case involving the doctrine of equivalents, where the court applied the same rule in *Johnson & Johnston Assocs. v. R.E. Service Co.*¹⁷⁴ In *Johnson & Johnston*, the invention at issue involved metal foils used to manufacture printed circuit boards.¹⁷⁵ The patentee disclosed in his specification that aluminum was the preferred material, but other metals such as stainless steel or nickel alloys were usable.¹⁷⁶ The patentee, however, specifically limited the claims of the patent to “a sheet of aluminum” and “the aluminum sheet.”¹⁷⁷ The court held, “[h]aving disclosed without claiming the steel substrates, Johnston cannot now invoke the doctrine of equivalents to extend its aluminum limitation to encompass steel. Thus, Johnston cannot assert the doctrine of equivalents to cover the disclosed but unclaimed steel substrate.”¹⁷⁸

A further example of the narrowing of rights is that a patentee cannot recapture via the doctrine of equivalents any subject matter that he surrendered during the patent prosecution history.¹⁷⁹ In a recent case, *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,¹⁸⁰ the

¹⁷² *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1055 (Fed. Cir. 2002). In the case of a reissue, a patentee can later claim subject matter he failed to claim provided it was inadvertent and meets the other criteria of 35 U.S.C. § 251. *Id.*

¹⁷³ *Miller v. Brass Co.*, 104 U.S. 350 (1881). The Court stated “the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a *dedication to the public* of that which is not claimed.” *Id.* at 352 (emphasis added).

¹⁷⁴ 285 F.3d 1046, 1055 (Fed. Cir. 2002). The court noted:

A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter. 35 U.S.C. § 251 (2000). In addition, a patentee can file a separate application claiming the disclosed subject matter under 35 U.S.C. § 120 (2000) (allowing filing as a continuation application if filed before all applications in the chain issue). Notably, Johnston took advantage of the latter of the two options by filing two continuation applications that literally claim the relevant subject matter.

Id.

¹⁷⁵ *Id.* at 1048-49.

¹⁷⁶ *Id.* at 1055.

¹⁷⁷ *Johnson & Johnston Assocs.*, 285 F.3d at 1055.

¹⁷⁸ *Id.*

¹⁷⁹ *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997).

¹⁸⁰ *Id.*

Supreme Court reiterated this principle.¹⁸¹ The invention at issue in *Warner-Jenkinson* involved a technique for purifying dyes.¹⁸² Because the patent examiner cited some prior art involving a pH greater than nine, the attorney for the patentee amended the claim to contain a pH of six to nine.¹⁸³ The infringer used a chemical with a pH of five.¹⁸⁴ The Court found no literal infringement because five was not within the claimed range of six to nine.¹⁸⁵ Thus, the question before the Court was whether amending a claim barred the patentee from broadening that claim under the doctrine of equivalents.¹⁸⁶ The Court held that the burden is on the patentee to establish the reason for amendment.¹⁸⁷ Prosecution history estoppel will “bar” the use of the doctrine of equivalents for any amendment related to patentability, and only under special circumstances, can the presumption be rebutted.¹⁸⁸ Although the Federal Circuit in a later case¹⁸⁹ interpreted *Warner-Jenkinson* as an “absolute bar” to application of the doctrine of equivalents, the Supreme Court reconfirmed its “rebuttable presumption” holding of *Warner-Jenkinson* in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*¹⁹⁰ This changed the “absolute bar” standard the Federal Circuit attempted to implement back to a “foreseeable bar” standard.¹⁹¹

Consider the sitting device invention once again:

¹⁸¹ *Id.* at 33.

¹⁸² *Id.* at 21-22.

¹⁸³ *Id.* at 22.

¹⁸⁴ *Warner-Jenkinson*, 520 U.S. at 23.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 30-32.

¹⁸⁷ *Id.* at 33.

¹⁸⁸ *Id.* at 33-34. In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740-41 (2002), the Court summarized the circumstances where the presumption can be rebutted:

There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.

Id.

¹⁸⁹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000).

¹⁹⁰ 535 U.S. 722 (2002).

¹⁹¹ *Id.* at 740-41.

A sitting device comprising:

1. Two supports; and

2. A horizontal member perpendicularly connected to the two supports.

If the patent examiner cited prior art with two supports and the patentee then amended his claim to read “four supports,” that amendment would presumptively bar the patentee from using the doctrine of equivalents to obtain coverage for “three supports,” even if no prior art existed with three supports.¹⁹²

The Federal Circuit further narrowed a patentee’s rights in *Symbol Technologies Inc. v. Lemelson Medical*,¹⁹³ where the patentee “sat” on those rights.¹⁹⁴ In *Lemelson*, the patents at issue involved machine vision systems and identification technology and were allegedly entitled to a priority filing date¹⁹⁵ of two patent applications filed in 1954 and 1956, more than forty years before the filing of the suit.¹⁹⁶ If the patentee established this priority date, nearly every bar code scanner used in the United States would infringe these patents.¹⁹⁷ The issue on appeal was whether the equitable doctrine of laches was a valid defense to infringement.¹⁹⁸ The court held that laches was an available defense to “bar enforcement of patent claims that issued after an unreasonable and unexplained delay in prosecution even though the applicant complied with pertinent statutes and rules.”¹⁹⁹

Another example of the trend toward the narrowing of a patentee’s rights occurred in *Athletic Alternatives v. Prince Manufacturing*,²⁰⁰ where the Federal Circuit applied a narrower meaning to an ambiguous term in a patent rather than a broader

¹⁹² See *id.* at 740.

¹⁹³ 277 F.3d 1361 (Fed. Cir. 2002).

¹⁹⁴ *Id.* “Sits on his rights” in this context is referring to a patentee who had knowledge of infringing activity but did not bring action early enough. See *id.* at 1363.

¹⁹⁵ The priority filing date is the date a patent becomes prior art as against all other later inventions. DONALD S. CHISUM, CHISUM ON PATENTS § 6.02 (2d ed. 1999).

¹⁹⁶ *Lemelson*, 277 F.3d at 1363.

¹⁹⁷ See *id.* Prior to June 8, 1995, the term of a utility patent was 17 years from issuance. 35 U.S.C. § 154 (2000). Since these patents had not issued until approximately 1998, they were still valid despite the parent applications’ filing dates of 1954 and 1956. See *Lemelson*, 277 F.3d at 1363. Since applications were kept in secret until issued (now, until published), manufactures and users could not have known of the filed patents. See 35 U.S.C. § 122 (2000).

¹⁹⁸ *Lemelson*, 277 F.3d at 1363.

¹⁹⁹ *Id.* at 1363, 1366.

²⁰⁰ 73 F.3d 1573 (Fed. Cir. 1996).

meaning.²⁰¹ The invention at issue in *Athletic Alternatives* involved a method for stringing tennis racquets, and the court had to decide which interpretation of the phrase “varies between” to utilize in construing a claim against the defendant.²⁰² The court reasoned that if it allowed Athletic to assert the broader meaning of “varies between,” the court would be undermining the “fair notice function of the requirement that the patentee distinctly claim the subject matter disclosed in the patent from which he can exclude others temporarily.”²⁰³ The court explained that “[w]here there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at least entitled to a claim having the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning.”²⁰⁴

V. PROPOSAL FOR RESTRICTION OF THE DOCTRINE OF EQUIVALENTS

The Federal Circuit has demonstrated a tendency to restrict the application of the doctrine of equivalents.²⁰⁵ Accordingly, even though the Supreme Court overturned the Federal Circuit’s absolute bar standard of using the doctrine when the patentee has amended a patent claim to a foreseeable bar standard,²⁰⁶ the Federal Circuit has construed the *Festo* holding of the Supreme Court narrowly and continues to further restrict the application of the doctrine of equivalents.²⁰⁷ The Federal Circuit should also restrict the doctrine of equivalents where a patentee with specific knowledge of defendant’s non-literal infringement willfully does not file a reissue. In such an egregious case, the courts should not allow the patentee to appeal to the doctrine of equivalents because he already has a remedy at law.

In *Lemelson*, the court found that the defense of laches was still applicable as a defense to patent enforcement in cases of the patentee’s unreasonable delay in prosecuting the application.²⁰⁸ Likewise, if Congress changed the law so that seeking a broadening reissue, while available, was a prerequisite for filing suits under the doctrine of equivalents, the patentee who waits so that he falls outside

²⁰¹ *Id.* at 1581.

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ *Id.*

²⁰⁵ See *supra* notes 156-204 and accompanying text.

²⁰⁶ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740-41 (2002).

²⁰⁷ See *supra* notes 156-204 and accompanying text.

²⁰⁸ *Lemelson*, 277 F.3d at 1368.

of the two-year window for broadening claims via a reissue is also exhibiting unreasonable delay, and the courts should not permit him to appeal to the doctrine of equivalents.²⁰⁹

Simply changing the two-year limitation on broadening patent claims will not solve the issue, although it could offer some assistance.²¹⁰ Such a change, however, could create evidentiary problems. By having the time limit for broadening claims exceed two years, the situation can arise where many “infringers” can contend they relied on the original patent claims in some instances fifteen years earlier to shape their behavior, and as such should be entitled to intervening rights. This could easily become administratively infeasible, as courts could potentially have to adjudicate and grant intervening rights to many different infringers.

Finally, some may argue that the doctrine of equivalents is not an “equitable” remedy, but merely another legal remedy, albeit a judicially created one where courts construe the infringement statute broadly, and as such, the general rule of appealing to the law before equity should not apply.²¹¹ Under this argument, since a jury decides questions of infringement under the doctrine of equivalents, rather than a judge as in an equity court, the doctrine is still a legal remedy.²¹² The argument continues: if the doctrine of equivalents is a legal remedy, a plaintiff should be entitled to select whichever legal remedy he seeks (i.e., sue under the doctrine of equivalents, or reissue and sue by literal infringement) just as he chooses his cause of action when filing his complaint.

One can still classify the doctrine of equivalents as equitable,

²⁰⁹ *See id.*

²¹⁰ The solution of removing the two-year limitation on broadening claims in a reissue was proposed by Martin J. Adelman and Gary L. Francione:

The solution, however, is for Congress to repeal the two-year limitation and treat broadening and narrowing reissues alike. The Federal Circuit has stated that “[t]he purpose of the law that a broadening reissue must be applied for within two years after patent grant is to set a limited time after which the public may rely on the scope of the claims of an issued patent.” As long as the doctrine of intervening rights is enforced rigorously, however, the public will not be harmed by broadening reissues over the life of the patent. Moreover, whatever greater uncertainty would result from liberalizing the reissue rules would be more than offset by a decrease in the uncertainty engendered by use of the doctrine of equivalents.

Martin J. Adelman & Gary L. Francione, *The Doctrine Of Equivalents In Patent Law: Questions That Pennwalt Did Not Answer*, 137 U. PA. L. REV. 673, 720 (1989) (emphasis added).

²¹¹ 35 U.S.C. § 271 is the patent infringement statute.

²¹² *See Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1148 (Fed. Cir. 2003) (citing *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed. Cir. 1998)).

however, even if the jury decides infringement under the doctrine. The jury had been deciding literal infringement, so allowing the jury to decide infringement under the doctrine of equivalents was a natural progression.²¹³ Further, since infringement under the doctrine of equivalents is analogous to reformation (the jury is essentially rewriting the existing claims in order to find infringement in a particular instance), the doctrine of equivalents is better characterized as an equitable remedy.²¹⁴ Even if one cannot strictly classify the doctrine of equivalents as “equitable,” it may not be strictly “legal” because the Patent Act created a legal remedy – the reissue.²¹⁵ Thus, by analogy, the doctrine falls within the general principle that one must avail himself of his available legal remedy first, before resorting to an extra legal remedy. More importantly, the doctrine of equivalents is a dangerous doctrine and restrictions of its use are consistent with recent case law.

CONCLUSION

However the doctrine of equivalents is classified, whether merely “extra” legal or specifically as equitable, it has potential for being abused. In the egregious case where the patentee has specific knowledge of a non-literal infringement and willfully does not seek a reissue, as in *Wilson Sporting Goods, Johnson & Johnston, Warner-Jenkinson, Lemelson*, and *Athletic Alternatives*, courts should further restrict the doctrine of equivalents to promote what it was intended to promote – fairness.²¹⁶

²¹³ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1024 (Fed. Cir. 1995) (explaining that the jury decides “disputed factual questions of what the patent covered”).

²¹⁴ See *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990).

²¹⁵ 35 U.S.C. § 251 (2000).

²¹⁶ See *supra* notes 156-204 and accompanying text.