



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Intermatic, Inc.***  
**v.**  
***Lamson &  
Sessions Co.***

Nos. 00-1101,  
-1116, 01-1028  
Federal Circuit  
Dec. 17, 2001

***"[Prosecution  
history  
estoppel may]  
apply to a  
claim limitation  
that was  
narrowed in  
order to obtain  
allowance of a  
claim during  
reexamination,  
despite the fact  
that the  
resulting  
estoppel may  
retroactively  
extend to  
original,  
unamended  
claims."***

On December 17, 2001, the Federal Circuit affirmed the district court's entry of judgment on the jury verdict that Lamson infringed reexamined U.S. Patent 5,280,135 under the doctrine of equivalents. The patented technology related to a weatherproof electrical outlet cover. With respect to prosecution history estoppel, the Federal Circuit noted:

Claim 14, as originally filed, required that the "insert [be] adapted to be mounted in the base . . . ." That claim, as was the case with the remainder of the claims of the '135 patent, was not amended during the initial prosecution . . . . During reexamination, however, . . . Intermatic amended claim 14 to require that the insert be "adapted to be accommodated with[in] the aperture in the base," and argued that the claim as amended was patentable over the prior art. . . .

When an amendment narrows the scope of a claim for a reason relating to patentability, no range of equivalents is available for that amended claim limitation. Accordingly, because the "insert within the aperture" limitation in reexamined claim 14 was added for a reason relating to patentability, i.e., to avoid the prior art, Intermatic is barred from obtaining any range of equivalents for that limitation.

Furthermore, that equivalence bar extends to all of the claims in which the "insert within the aperture" limitation appears. In *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, this court addressed the question whether prosecution history estoppel applies to a claim containing a limitation that was added to another, separate claim to avoid prior art, where that limitation appeared in the claim in its original form and was not amended during prosecution. [T]he court in *Builders* held that prosecution history estoppel barred the patentee in that case from asserting equivalence between the accused structure and claim 10 of its patent as a result of the addition of the same "passage" limitation in claim 1 to avoid the prior art.

We conclude that the principles espoused in *Builders* equally apply to a claim limitation that was narrowed in order to obtain allowance of a claim during reexamination, despite the fact that the resulting estoppel may retroactively extend to original, unamended claims, and hold that any estoppel generated by such an amendment applies to all other claims in the patent containing that limitation. To conclude otherwise would be "to exalt form over substance," and subject a limitation to multiple ranges of equivalence depending upon whether or not that limitation was amended in any particular claim. Moreover, arguments made to distinguish prior art during reexamination proceedings are retroactively applied to limit the scope of a claim limitation as of the issue date of the patent, not the date those arguments were made. For purposes of prosecution history estoppel, we see no reason to treat amendments made during reexamination differently. We therefore reject Intermatic's assertion at oral argument that the timing of a narrowing amendment dictates the applicability of prosecution history estoppel, and conclude that none of the claims at issue are entitled to any range of equivalents regarding the "insert within the aperture" limitation under the law set forth in *Festo*.