



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Festo Corp.
v.
Shoketsu
Kinzoku Kogyo
Kabushiki Co.***

No. 95-1066
Federal Circuit
Sept. 20, 2002

***“[W]hether
rebuttal of the
presumption of
surrender,
including
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or reasonable
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whether a
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can rebut the
presumption.”***

On September 20, 2002, the Federal Circuit ordered the parties to brief certain issues on remand from the U.S. Supreme Court, which held that a narrowing amendment made for reasons related to patentability raises a rebuttable presumption that a complete bar to the doctrine of equivalents for the amended claim element attaches. The Federal Circuit stated:

[T]he Supreme Court . . . held that [a] patentee’s decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. 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. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence. . . . The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.

Claims of both Festo patents at issue were narrowed by amendments during prosecution.

We must now consider what further action to take in this case. To help us in that determination, we order the parties to submit briefs on the following issues:

1. Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.

2. What factors are encompassed by the criteria set forth by the Supreme Court.

3. If a rebuttal determination requires factual findings, then whether, in this case, remand to the district court is necessary to determine whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted, or whether the record as it now stands is sufficient to make those determinations.

4. If remand to the district court is not necessary, then whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted.

The case will be heard en banc on the basis of the briefs already filed and the additional briefs addressing the questions set forth above. . . . Amicus curiae briefs addressing the first two issues are welcomed from bar associations, trade or industry associations, and the government. . . . Oral argument, if any, will be scheduled in a later order.