

Legal Alert

Festo XIII: Making the Unforeseeable, Foreseeable

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After nearly 20 years, two Supreme Court visits, and two Federal Circuit *en banc* reviews, a Federal Circuit panel has recently issued yet another *Festo* opinion addressing prosecution history estoppel and infringement under the doctrine of equivalents. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 05-1492, 2007 WL 1932269 (Fed. Cir. July 5, 2007). This latest *Festo* opinion holds that an alleged equivalent would have been foreseeable – and therefore, a bar to the doctrine of equivalents – if one skilled in the art would have known that the alternative existed in the field of art as defined by the original claim scope, even if the suitability of the alleged equivalent for meeting the function required within the amended claim was unknown at the time of amendment.

Under previously existing case law, a product infringes under the doctrine of equivalents when the equivalent represents an insubstantial change from the claim language or if the equivalent performs substantially the same function in substantially the same way to obtain the same result (“the function/way/result test”). This range of potentially infringing equivalents is limited under the doctrine of prosecution history estoppel: when a claim is amended for reasons related to patentability, a presumption exists that the patentee voluntarily relinquished all equivalents for the amended limitation. The patentee may overcome this presumption by demonstrating that one of three exceptions is met. One of the three exceptions arises when the accused equivalent was not foreseeable at the time of the amendment. This unforeseeability exception was the sole issue addressed in this case.

The amended limitation in Festo’s asserted rodless cylinder patent was that a cylindrical sleeve be made of “magnetizable material.” *Id.* at *3. The alleged infringing product incorporated a sleeve made of aluminum alloy, a non-magnetizable material. *Id.* Nevertheless, Festo argued that the aluminum alloy sleeve met the function/way/result test under the doctrine of equivalents because the aluminum alloy sleeve fulfilled the intended shielding function of the “magnetizable material” limitation.

Although the claim was amended during prosecution to add the “magnetizable material” limitation, Festo argued that the prosecution history estoppel was inapplicable under the “unforeseeable” exception. While aluminum alloy piston sleeves were known in the prior art, the shielding nature of an aluminum alloy sleeve was not known at the time of the amendment.

Festo argued that the aluminum alloy limitation would have failed the function/way/result test criteria at the time the amendment was made, and therefore, it would have been unforeseeable as an equivalent at the time of the amendment. *Id.* at *7.

The Federal Circuit disagreed, holding that “the foreseeability requirement does not require the knowledge that the equivalent would satisfy the function/way/result test or the insubstantial differences test.” *Id.* at *8. The court reasoned that:

If at the time of the amendment, the equivalent was known in the pertinent prior art, the applicant should not be able to recapture it simply by establishing that a property of the equivalent – irrelevant to the broader claim before amendment – was relevant but unknown with respect to the objectives of the narrower amended claim.

Id. at *9.

Judge Newman’s strong dissent declared that the opinion “further erodes the residue of the doctrine of equivalents, for its foreseeable result is to deprive amended claims of access to the doctrine of equivalents.” *Id.* at *11. She criticized that “whether technologic equivalency was known cannot be irrelevant to foreseeability, for the foreseeability bar is directed to subject matter that was foreseeably equivalent at the time of filing an amendment . . . the panel’s holding today strays from controlling precedent as well as from logic.” *Id.* at *14.



If you have any questions regarding this alert, or the services we provide, please feel free to contact any of the attorneys listed below or the Sutherland attorney with whom you regularly work.

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