

## U.S. SUPREME COURT REJECTS EFFORTS TO LIMIT PATENT DOCTRINE OF EQUIVALENTS

On Tuesday, the United States Supreme Court issued an important decision in a much-anticipated patent case (at least by patent lawyers). The Court rejected recent efforts to severely limit the patent doctrine of equivalents. Historically, the doctrine has allowed a court to find that a patent has been infringed even though the literal language of the patent did not cover the infringing product. The doctrine allows patent holders to prevent others from making, using or selling "equivalents" to the claimed invention that would not otherwise be covered by the claims. Because the Supreme Court has rejected the attempt to limit the doctrine of equivalents, the decision should be viewed as a victory for patent owners seeking to enforce their patents.

To understand exactly what the Supreme Court decided, a little background is in order. A patent is made up of written "claims" which describe exactly what the patented invention is. At its simplest, to have a patent infringement, the infringing product must be covered by the literal language of the patent claims (i.e., literal infringement).

Under the doctrine of equivalents, however, a product will be held infringing -- despite the absence of literal infringement -- if there are only "insubstantial" differences between the product and the "claim" language.

In a controversial opinion, the lower court, the Federal Circuit, held that if the patent applicant amended its application to more narrowly claim and/or describe the claimed invention, then the patent holder was completely barred from using the doctrine of equivalents to allege infringement of the amended element.

Now, in a unanimous decision, the Supreme Court has reversed the Federal Circuit and held that a narrowing amendment does not automatically bar the use of the doctrine of equivalents for the amended element. Rather, the use of the doctrine of equivalents will be allowed if the patent holder can show that the narrowing amendment did not address the particular kind of equivalent used by the alleged infringer. The patent holder can carry this burden, for example, by showing that the equivalent was unforeseeable at the time of the application or that the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question. *I-Law* is looking forward to seeing how courts and patent holders deal with carrying this burden.

The case is *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 00-1543, and can be found at this link.  
<http://caselaw.lp.findlaw.com/cgi-bin/getcase.pl?court=US&navby=case&vol=000&invol=00-1543>

The Supreme Court's decision is already receiving mixed reviews from commentators, which can be found at these links.  
[http://ipcenter.bna.com/PIC/ippic.nsf/\(Index\)/324212A7951F52E885256BC8004C11A5?OpenDocument](http://ipcenter.bna.com/PIC/ippic.nsf/(Index)/324212A7951F52E885256BC8004C11A5?OpenDocument)  
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For further assistance with the doctrine of equivalents or other patent issues, please contact Rich Oney, Susan Stone Rosenfield or other members of Fennemore Craig's Intellectual Property Group at the numbers below.

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