On November 29, 2000, the Court of Appeals for the Federal Circuit decided *Festo Corp. v. Shoketsu Kinzoku Kogyou Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed.Cir.2000), a decision that completely changed the way the doctrine of equivalents is applied and, as indicated by the opening quote, sowed confusion in the district courts.

While the doctrine of equivalents is still alive, it is hardly kicking. This article discusses the potential impact of the *Festo* decision on the other “equivalents” in patent law— the equivalents made available statutorily through means-plus-function claims under 35 U.S.C. § 112(6).

**Festo- “…No Range of Equivalents…”**

If an accused product avoids literal infringement of a patent’s claims, that product may still be found to infringe under the judicially created doctrine of equivalents. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). Equivalents may be found if the differences between what is claimed and the accused product are insubstantial. Differences are insubstantial if the accused product performs substantially the same function in substantially the same way to obtain the same result as the claimed invention. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950).

What may be considered equivalent is limited by prosecution history estoppel. Prosecution history estoppel applies when a patentee amends a patent application during prosecution for a reason related to patentability, or when the patentee was unable to establish a reason for an amendment that was unrelated to patentability. The Supreme Court’s decision in *Warner-Jenkinson* left open certain issues relating to precisely when and how precisely prosecution history estoppel applies to limit the application of the doctrine of equivalents.
In *Festo*, the Federal Circuit raised and answered several questions intended to resolve those issues. *Festo*, 243 F.3d at 562. The Court’s most significant holding for the purpose of this article is the following: If an amendment creates prosecution history estoppel with regard to a claim element, then there is no range of equivalents available for the amended claim element, and application of the doctrine of equivalents is completely barred. *Id.* at 569. Put another way, where a claim has been amended for reasons of patentability, the claim can only be infringed literally.

Shockwaves from the *Festo* decision are still being felt. One court recently observed, “[t]he cataclysmic portion of the ruling is, of course, [the holding regarding no range of equivalents], which involved the explicit overruling of some eight identified Federal Circuit decisions.” *TM Patents, LLP v. IBM*, 2001 U.S.Dist. LEXIS 5212, *13 (S.D.N.Y. 2001).

In *Festo*, the Federal Circuit gave primacy to the notice function of patent claims. According to the Court, a flexible approach to equivalents was “unworkable,” and inconsistent with the public notice function of the patent laws. *Festo*, 234 F.3d at 576. A “complete bar” rule gives competitors more certainty regarding the scope of a patent, and therefore makes it easier to avoid infringement. The policy behind *Festo’s* “no range of equivalents” rule is opposite the long-standing policy espoused in *Graver Tank’s*, which focused on protecting the patentee from being at the mercy of the “unscrupulous copyist.” *Graver Tank*, 339 U.S. at 607.

The *Festo* decision left many wondering what is left of the doctrine of equivalents. If narrowing amendments made for any reason related to the statutory requirements for obtaining a patent will give rise to prosecution history estoppel, when will any amendment not trigger *Festo*? Even the addition of further explanatory language under § 112(1) could be interpreted as a narrowing amendment, and thus trigger the *Festo* rule of “no range of equivalents” for that element.

Is there any way of obtaining equivalents that are not precluded by *Festo*? We think the answer may be in § 112(6).

§112(6): “…And Equivalents Thereof…”

Section 112(6) is statutory, not judicial. Section 112(6) was enacted in response to *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). In that case, the Supreme Court held invalid a claim that was drafted in functional language. Congress enacted 112(6) to statutorily overrule that holding. *Warner-Jenkinson*, 520 U.S. at 28. In enacting 112(6), Congress permitted the use of purely functional language in claims, but restricted the scope of such claims to the structure disclosed in the specification and equivalents thereof.

A means-plus-function element contemplated by § 112(6) recites a function to be performed rather than specific structure or materials for performing the function. Such an element must be construed "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." *Id.* The term "means" in a means-plus-function limitation is essentially a generic reference for the corresponding structure or structures disclosed in the specification. *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1308 (Fed. Cir. 1998). Thus, through
112(6), the Patent Act permits a range of structural equivalents not specifically disclosed in the specification of a patent.

There is no “magic language” to invoke 112(6). The Federal Circuit has stated that the use of the word “means” triggers a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses. *York Products, Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574 (Fed. Cir. 1996). However, in the next breath, the Federal Circuit stated that the “mere incantation” of the word “means” in a clause reciting primarily structure cannot invoke 112(6). *Id.* Thus, a court can ignore the “means” language if the claim is not properly drafted to recite function.

In the patent infringement context, "[to] determine whether a claim limitation is met literally, where expressed as a means for performing a stated function, the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claimed function for that structure." *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed.Cir.1987) (*in banc*) (emphasis in original). Infringement of a claim under 112(6) is properly a matter of literal infringement, without resort to the doctrine of equivalents.

Once the corresponding structure for the recited means is identified, equivalents under 112(6) are determined by considering whether the differences between the structure in the accused device and that disclosed in the specification are insubstantial. *See Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed.Cir.1993).

**Intersection of The Doctrine of Equivalents and “Equivalents Thereof” Under 112(6)**

So, where does the doctrine of equivalents end and “equivalents thereof” under 112(6) begin? The question of substantiality blurs the distinction between the two. Equivalents analysis under 112(6) and the doctrine of equivalents are not coextensive, as 112(6) requires identical, not equivalent function, and, because, as the Federal Circuit has often stated, that the analyses have different origins and purposes.

In *Chiuminatta*, the Federal Circuit blurred the line between the doctrine of equivalents and means-plus-function claims. The Federal Circuit stated that the tests for each are closely related, findings support in *Warner-Jenkinson. Chiuminatta*, 145 F.3d at 1310. A lack of equivalent structure to a means-plus-function element may therefore preclude a finding of equivalence under the doctrine of equivalents. *Id.*

However, the Federal Circuit also stated that the doctrine of equivalents may still be valid even after a finding of no structural equivalents, to protect a patentee claiming an invention in means-plus-function language from a technological advance not contemplated by the specification. In such a case, the technological advance may be so insubstantially different that it should be an infringement. *Id.*

The Federal Circuit recently went even further in breaking down any barriers between the doctrine of equivalents and means-plus-function elements, approving “a reduced version” of the well-known
tripartite test for the doctrine of equivalents to been applied to § 112(6). *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374,1379 (Fed. Cir. 2000).

Even though the doctrine of equivalents and 112(6) originally sprung from “different origins and purposes,” it could now be argued that, except in the case of some unknown technological advance, the only difference between the test for determining equivalence under the doctrine of equivalents, and the test for determining equivalence under 112(6) is the “function” factor of the test: under 112(6), in order to find infringement, the function must be identical. Under the doctrine of equivalents, the function must be substantially similar.

**Prosecution History And 112(6)- Will The Festo Rule Apply?**

Now that the Federal Circuit is treating the doctrine of equivalents and means-plus-function claims under arguably identical tests, how will prosecution affect means-plus-function claims in the post-*Festo* world?

The prosecution history of a patent still affects the interpretation of a means-plus-function claim. Positions taken before the PTO may bar an inconsistent position on claim construction under 112(6). Arguments made in support of patentability may affect the range of equivalents under 112(6). See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1457 (Fed.Cir.1998) (*in banc*).

Prior to the *Festo* decision, the Federal Circuit held that just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under § 112 ¶ 6. *Alpex*, 102 F.3d at 1221. This has always been the case in the literal infringement context, and is true of any literal claim interpretation, not just interpretation of means-plus-function claims.

With the Federal Circuit effectively merging the analysis of the doctrine of equivalents and the analysis of means-plus-function claims, the critical question becomes: Will the *Festo* rule of “no range of equivalents” apply to means-plus-function claims where the function is narrowed by amendment for reasons related to patentability? In other words, because the doctrine of equivalents and 112(6) “equivalents thereof” are being equated, can a court take away structural equivalents granted by the Patent Act?

The answer should be no. First, the majority decision in *Festo* indicated that the law concerning structural equivalents was not affected by the decision. *Festo*, 234 F.3d at 589. The Federal Circuit stated in *Festo* that a claim element recited in means-plus-function language literally encompasses the corresponding structure and its equivalents. *Id*.

Moreover, a means-plus-function claim is, by statute, inherently broader than the embodiment disclosed in the patent. Of course, the patent must provide structural support for the function claimed. But one way to avoid the “no range of equivalents” rule created in *Festo* may be to draft claims using means-plus-function language, and provide several structural examples in the specification.
Other tensions are created by limiting the range of equivalents for means-plus-function claims. The PTO gives claims their broadest reasonable interpretation consistent with the written description. Claims must be interpreted the same way for determining infringement. A means-plus-function claim should be broadly interpreted, so that the range of permissible equivalents is not foreclosed by an amendment which does not limit the claim to the structure recited in the specification.

During prosecution of a patent, a means-plus-function claim may be amended in terms of function to overcome a prior art rejection, but the specification may remain unchanged. The patentee should still be permitted a range of equivalents that perform the function of the structures shown in the specification. The only thing the patentee should not be entitled to is a structure equivalent to what was shown in the prior art reference that lead to the amendment.

**Conclusion**

*Festo* may have killed off the doctrine of equivalents, paving the way for the “unscrupulous copyist” to avoid infringement. Patentees can seek to avoid that result by properly drafted (and properly prosecuted) means-plus-function claims.

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