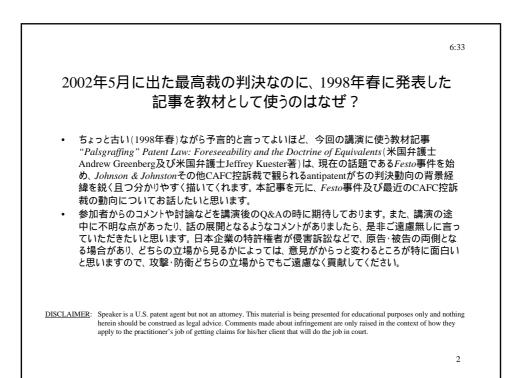
Festo事件とその背景にある 米国CAFC控訴裁の判決経緯 及び今後の展望

Gerry Peters, U.S. Patent Agent <u>gerrypeters@compuserve.com</u> KTK, Osaka, Japan 23 August 2002



6:30

Kuester氏らが言う 「An Invitation From the Supreme Court and a Federal Circuit RSVP」とは、どういうこと?

"These "various legal limitations" to which the court refers are often described in rule-based formulations. The formulations serve as a kind of "safe harbor" to which a prospective defendant might tread with some hope of prevailing on a motion for summary judgment notwithstanding the incantation of the magic words: "the Doctrine of Equivalents is a question of fact for the jury to decide. See *Hilton Davis.*" As discussed below, the Federal Circuit appears to have taken the Supreme Court's invitation to heart, and case law continues to emerge with dicta tending to give greater comfort to courts inclined to grant summary judgment of noninfringement."

-From "Palsgraffing" Patent Law, by Andrew Greenberg and Jeffrey Kuester (bolding added)

"With regard to the concern over unreviewability due to **black box jury verdicts**, we offer only guidance, not a specific mandate. Where the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment. See Fed. Rule Civ. Proc. 55; Celotex Corp. v. Cartett, 477 U.S. 317, 322 -323 (1986). If there has been a reluctance to do so by some courts due to unfamiliarity with the subject matter, <u>we are confident that the Federal Circuit can remedy the</u> problem. Of course, the various legal limitations on the application of the doctrine of equivalent, district courts are oble evidence and after the jury verdict, Fed. Rule Civ. Proc. 56; Fed ext Corp. V. Cartett, a matter of law at the close of the evidence and after the jury verdict, Fed. Rule Civ. Proc. 56; Fed ext Civ. Proc. 50. Thus, under the particular facts of a case, if prosecution history estoppel would apply or if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve. Finally, in cases that reach the jury, a special verdict and/or interrogatories on each claim element could be very useful in facilitating review, uniformity, and possibly postverdict judgments as a matter of law. See Fed. Rule Civ. Proc. 49; Fed. Rule Civ. Proc. 50. We leave it to the Federal Circuit how best to implement procedural improvements to promote certainty, consistency, and reviewability to this area of the law."

-Footnote 8 from Warner Jenkinson v. Hilton Davis (USSC 1997; bolding and underlining added)



6:39

「Foreseeability」は、いったいどこにあった?

USSC Festo判決(2002年5月)を一言で凝縮すれば、それは「foreseeability」となるでしょう。さて、「foreseeability」を基準にする考え方の根元はどこにあったでしょうか? 「Foreseeability」を置くと、多くの実務家はCAFC Festo判決(2000年11月)中Rader判事 の反対意見が語る「after-arising technology」を思い浮かべますが、実はKuester氏らの Palsgraffing記事(1998年春)のきっかけとなったのはSage Products v. Devon Industries 事件(CAFC 1997)です。下記の引用文では、最近のJohnson & Johnston事件が取り上 げると同じ問題(いわゆるclaim it or lose it = CIOLI法則)を取り上げるMaxwell 事件と foreseeabilityを結び付けようとするCAFC側の考え方に特に注目していただきたい。

"... [A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this **foreseeable** alteration of its claimed structure. Cf. **Maxwell v. J. Baker, Inc.**, 86 F.3d 1098, 1108, 39 USPQ2d 1001, 1007 (Fed. Cir. 1996), cert. denied, ---- U.S. ----, 117 S. Ct. 1244 (1997) (discussing danger of allowing patentee to file and prosecute narrow claims and then, during the course of litigation, expand its exclusive rights under the doctrine of equivalents, thereby avoiding examination of the broad subject mater).

This court recognizes that such reasoning places a premium on **forethought** in patent drafting. Indeed this premium may lead to higher costs of patent prosecution. However, the alternative rule – allowing broad play for the doritine of equivalents to encompass **foreseeable** variations, not just of a claim element, but of a patent claim – also leads to higher costs. ... "

-Sage Products v. Devon Industries (CAFC 1997; bolding added)

5

「Foreseeability」のSage Products以外の"Roots" その-

過失法上のPalsgraf v. Long Island Railroad (NY 1928)

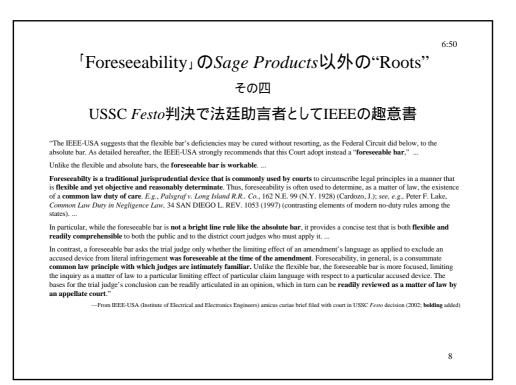
"The use of foreseeability tests measured by the court as a precondition for permitting cases to proceed with fact findings governing liability is not novel. In *Palsgraf v. Long Island Railroad*, 162 N.E. 99 (N.Y. 1928), Judge Cardozo introduced to negligence law the notion that **foreseeability of a risk of injury** to a particular plaintiff is needed to create a **duty of care**, and such foreseeability was a precondition of any liability to that particular plaintiff. Thus, instead of foreseeability being just a measure of the scope of damages after a finding of liability (as suggested in Judge Andrews' dissent in *Palsgraf*) the foreseeability of the injury will first be considered by the court as a threshold matter of law.

Taken beyond the particular facts of *Sage*, this foreseeability principle could operate to *substantially* narrow the availability of the Doctrine of Equivalents as a vehicle to defeat a defendant's motion for summary judgment of noninfringement. Accordingly it is a surprising result. On the other hand, as discussed in Section IV below, *Sage* can also be seen as a natural consequence of a progression of case law dating as far back as 1881."

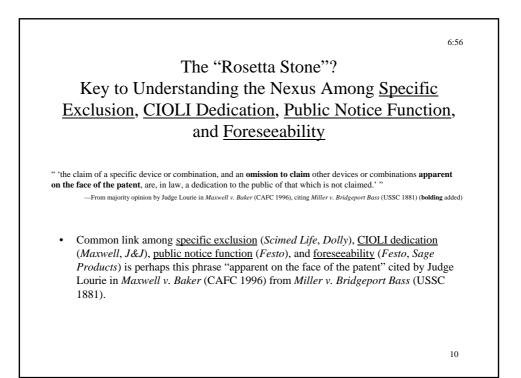
-From "Palsgraffing" Patent Law, by Andrew Greenberg and Jeffrey Kuester (bolding added)

6.44 「Foreseeability」のSage Products以外の"Roots" その二 CAFC Festo判決(2000年11月)中Rader判事の反対意見 "Prosecution history estoppel is an estoppel doctrine. Estoppel prevents a litigant from denying an earlier admission upon which another has already relied.^{15*} Black's Law Dictionary 570 (7th ed. 1999). In the case of patent law, the admission is the applicant's surrender of claim scope to acquire the patent. Today's rule forfeits all protection of the doctrine of equivalents whenever applicants amend their claims, regardless of whether they in fact surrendered coverage. By definition, applicants could not have surrendered something that did not even exist at the time of the claim amendment, namely after-arising technology. The court reasons today that it will not inquire about the scope of an estoppel because it cannot with certainty ascertain the scope of the applicant's surrender. Although that premise is questionable for the reasons enunciated by Judges Michel and Linn, one thing is beyond question: That premise does not apply to after-arising technology. Because after- arising technology was not in existence during the patent application process, the applicant could not have known of it, let alone surrendered it. Nonetheless, the court would apply an estoppel where none exists and defeat the doctrine of equivalents. [15]* This patent law version of "estoppel" varies from classical estoppel because an accused infringer need not have relied at all on the prior admission." -From J. Rader dissent in CAFC Festo decision (2000; bolding added)

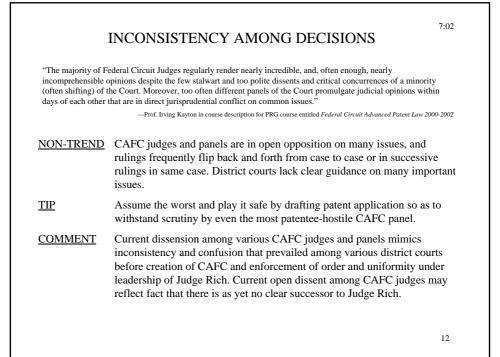
6:47 「Foreseeability」のSage Products以外の"Roots" その= USSC Festo判決で法廷助言者として合衆国訟務長官の趣意書 "The courts should exercise discipline in assessing assertions from patent holders that claim amendments could not have been crafted with greater precision, lest they invite wholesale return to the court of appeals' "flexible bar approach," which that court properly concluded is "unworkable." Pet. App. 25a. That inquiry should proceed as a matter of law. See Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) (courts, rather than juries, construe patent claims). It is not likely to be burdensome because the courts have a ready benchmark for evaluating such claims. A court can compare the actual claim amendment against the alternative claim formulations that a person of ordinary skill in the art could have adopted to provide literal coverage of the alleged equivalent. Given the versatility of language, patent holders will face a substantial obstacle in overcoming the presumption that their narrowed claims encompass no more than they literally embrace. But that challenge would not be insurmountable if the technology is complex or the alleged distinctions are trivial. See Pet. App. 107a-108a (Michel, J., dissenting in part) (noting that certain fields, such as biotechnology, place particular demands on literalism in describing the scope of a claim). ... Festo may make such a showing, for example, by demonstrating that the allegedly equivalent elements are laterdeveloped technologies that were not known to persons of ordinary skill in the art and were therefore not surrendered through the claim amendments. Or Festo may make such a showing by demonstrating that persons of ordinary skill in the art could not reasonably have drafted a patent claim that literally encompassed the allegedly equivalent elements." -From U.S. (Solicitor General) amicus curiae brief filed with court in USSC Festo decision (2002; bolding added) 7



17	
Kues	ster Haikus
All Elements Dula	"Tf
<u>All-Elements Rule</u> :	"If you didn't get it then, you won't get it later"
<u>PHE</u> :	"If you tried, but gave it up to get what you got the you won't get it later"
Prior Allowability Rule (Rule of Wilson):	"If you couldn't have gotten it then, you won't get later"
Dedication Rule (CIOLI):	"If you disclosed alternatively and didn't get it the you won't get it later"
Foreseeability Rule:	"If you should have tried to get it then, you won't get it later"
	—From "Palsgraffing" Patent Law, by Andrew Greenberg and Jeffrey Ku



Specific Trends and Non-Trends in Recent CAFC Decisions



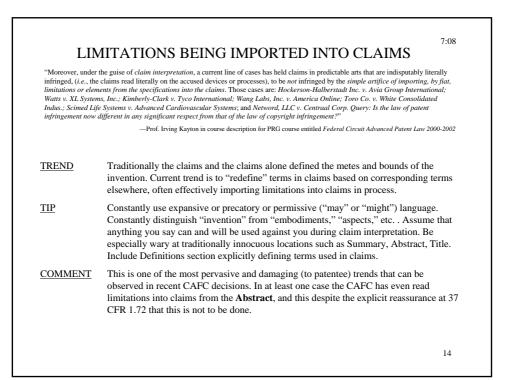
IS THERE A DIFFERENCE BETWEEN "TOP" AND "TOP PORTION"?

"[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure."

-From per curiam opinion in Sage Products v. Devon Industries (CAFC 1997)

7.05

<u>TREND</u>	Close calls viz DOE increasingly being resolved in favor of defendant. DOE reluctantly applied to give applicant even trivial variants which applicant failed to claim. Unprecedented levels of omniscience, perfection, and exhaustiveness now being demanded of applicant.
TIP	Write many claims of varying scope, perspective, and type. Include laundry list of alternative structures. Don't rely on DOE to capture alternative structures. Fight indefiniteness rejections for right to use broadening language to fill gap left by disappearing DOE.
<u>COMMENT</u>	<i>Sage Products</i> is one place where use of a broadening term like "top portion" may have saved applicant where "top" alone was insufficient to task (location of slot for disposal of hypodermic syringes). Be sure to translate 部, 部材, etc. Similarly, "time period" may be broader than "time," just as one other example of this issue.
	13



	7:11
OBJE	ECTS, ADVANTAGES, BENEFITS, AND EFFECTS BEING READ INTO CLAIMS
TREND	Statements of object, advantage, benefit, or effect are increasingly being read into claims as limitations (i.e., if accused device does not display stated advantage, etc. then infringement not found).
TIP	Be careful of overzealous statements of object, advantage, benefit, or effect (once having met the applicable threshold of usefulness, etc., any further such statements add little to patentability). Be careful to properly distinguish invention from various embodiments (e.g., say "one or more embodiments of the invention" rather than "the invention"), aspects, etc. so that it is clear that not all embodiments need display stated advantage.
<u>COMMENT</u>	Present incarnation of CAFC frequently holds applicant to letter of specification, reading same into claims, so carefully distinguishing "invention" from "aspects," "embodiments," etc. can mean difference between infringement and no infringement. Consistent use of precatory or permissive ("may" or "might") language pointing out possibility of alternative structures and expanding boundaries of invention can also be effective if not taken to excess. See, for example, <i>Dawn Equipment v. Kentucky Farms</i> (CAFC 1998), <i>Kraft Foods v. International Trading, Vehicular Technologies v. Titan Wheel</i> (CAFC 1998), Also see <i>Gentry Gallery v. Berkline</i> (CAFC 1998), slide on written description requirement and "omitted element" rule, and slide on "specific exclusion" principle quoting <i>Scimed Life Systems v. Advanced Cardiovascular Systems</i> (CAFC 2001).
	15

infringement pur	's new law, table salt dissolved in water will not be an adequate description of the composition for poses, since the sodium chloride molecule no longer 'exists': in dissolution the sodium and chloride ions will r bonds to each other, in interaction with molecules of water."
	Dissent by Judge Newman in Exxon v. Lubrizol (CAFC 1996; bolding added)
<u>TREND</u>	Picayune dissection and deconstruction of language of claim to reach a finding of no infringement. Exemplary of trend to put <u>form</u> (linguistic issues) over <u>substance</u> (judgment on merits or attempt to do equity).
TIP	Imagine that your claims are going to be scrutinized by the proofreader from hell, and try to bulletproof them appropriately. Be careful of even seemingly harmless inconsistencies in language that could provide a point of attack.
<u>COMMENT</u>	CAFC majority in <i>Exxon</i> relied at least in part on title of invention to bolster what some might say was a strained interpretation of claim or an importation of a limitation into claims from specification A similar problem occurs when a strict reading of claim language would result in nonsense claim, as in <i>Process Control v. Hydreclaim</i> (CAFC 1999), even though one skilled in art might arguably have been able to discern what was intended. A similar example to illustrate this sort of linguistic picayunishness would be requiring the applicant to say "the height of X is greater than <i>the height of</i> Y" instead of the more common "the height of X is greater than Y." For detailed analysis of <i>Exxon</i> , see <i>Note: To Thine Own Claim Be True: The Federal Circuit Disaster in Exxon Chemical Patents, Inc. v. Lubrizol Corp.</i> , by Jason M. Okun, published at Cardozo Law Review 21 Vol. 1335 (2000) and available at http://www.cardozo.yu.edu/cardIrev/v21n4/okun.pdf.

EQU	JITY BEING REPLACED BY CATALOG OF RULES	
	on of equivalency is not unlike determination of substantial similarity in copyright law or determination of ess in patent law. Such determinations require judicial wisdom, not a catalog of narrow rules ."	
	-From Commentary by Judge Newman, dissenting, in Pennwalt v. Durand-Wayland (CAFC 1987; bolding added)	
<u>TREND</u>	Whereas the court previously was content to weigh the equities between patentee and accused infringer, consistent with the patentee-hostile stance of <i>Sage Products</i> it now tends to resolve any ambiguity to detriment of patentee and to require satisfaction of various rules to overcome newly instituted presumptions, assumptions, and biases now retroactively held against patentee.	
<u>TIP</u>	Since form is now often more important than substance, learn where CAFC's "hot buttons" are (e.g., public notice function, narrowing amendments, foreseeability, omniscience and thoroughness viz listing o alternative structures, linguistic perfection), and carefully maneuver through maze of rules (e.g., avoid narrowing amendments post-Festo, qualify references to "the invention," be sure specification and claims mesh, etc.). Alternatively, reevaluate whether it may be more cost-effective to forego patent protection altogether and instead "design around," for example using the blueprint laid out by Judge Michel in his <i>Festo</i> dissent (however, beware of reversal or remand by USSC).	f
COMMENT	"Catalog of rules" certainly serves to "conserve of judicial resources," but is often inequitable and when taken to excess is arguably inconsistent with the goals of the patent system in the first place (see slides on conservation of judicial resources and on points made by Prof. Chisum). This trend is most visible in the CAFC's <i>Festo</i> decision (CAFC 2000). Whereas equity was often previously used to save patentee from finding of no infringement (e.g., DOE), current trend is to invoke equitable doctrines only to detriment of patentee; e.g., estoppel in <i>Festo</i> (CAFC 2000), laches in <i>Symbol Technologies v. Lemelson</i> (CAFC 2002).	
	17	

<u>TREND</u>	In re Zurko (Dickinson v. Zurko at USSC; 1998), In re Sang-Su Lee (CAFC 2000), and other decisions applying the Administrative Procedures Act to patent law have contributed to a trend away from willingness of court to act as "super-examiner" and instead toward insistence on holding PTO and patentee to record made during prosecution.
<u>TIP</u>	Remember that you will not get a second chance to "make the record." At same time you are prosecuting application with goal of speedy allowance, need to remember that you are creating record which will be used if case goes to court.
<u>COMMENT</u>	Previous incarnations of the CAFC often carried out extensive review of prior art and were often willing to reevaluate patentability and other issues, asking questions like "What would a reasonable examiner have allowed?" and making what amounted to court-mandated amendments to claims such as might have been available through reissue procedures. The present CAFC does not hesitate to hoist the patentee on its own petard even based on relatively minor deficiencies and even where the equities would seem to weigh in favor of the patentee, and insists that any correction of deficiencies have been completed before the case reaches the CAFC. On the other hand, applicant can now hold PTO to APA record-making standards; for example, by throwing unsupported statements or undocumented decisions on part of examiner (e.g., related to obviousness) back at examiner for proper record-making as prescribed by APA.

NEW "SPECIFIC EXCLUSION PRINCIPLE" OVERRRULES TRADITIONAL "RULE OF ADDITION"

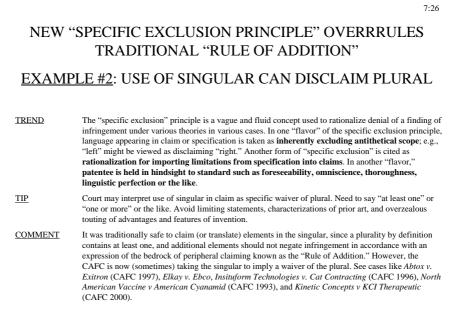
<u>EXAMPLE #1</u>: "OR" \rightarrow XOR

"Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.

... Having specifically identified, criticized, and disclaimed the dual lumen configuration, the patentee cannot now invoke the doctrine of equivalents to "embrace a structure that was specifically excluded from the claims." *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400, 29 USPQ2d 1767, 1771 (Fed. Cir. 1994). A particular structure can be deemed outside the reach of the doctrine of equivalents because that structure is clearly excluded from the claims whether the exclusion is express or implied."

-From per curiam opinion in Scimed Life Systems v. Advanced Cardiovascular Systems (CAFC 2001)

<u>TREND</u>	The "specific exclusion" principle is a vague and fluid concept used to rationalize denial of a finding of infringement under various theories in various cases. In one "flavor" of the specific exclusion principle, language appearing in claim or specification is taken as inherently excluding antithetical scope ; e.g., "left" might be viewed as disclaiming "right." Another form of "specific exclusion" is cited as rationalization for importing limitations from specification into claims . In another "flavor," patentee is held in hindsight to standard such as foreseeability, omniscience, thoroughness, linguistic perfection or the like.
TIP	Court may interpret use of "or" in claim as specific waiver of "both." Need to say "x or y or both" or "x and/or y" or the like. Avoid limiting statements, characterizations of prior art, and overzealous touting of advantages and features of invention.
COMMENT	Clearest example of this is in <i>Kustom Signals v. Applied Concepts</i> (CAFC 2001), where "or" in the claim meant that accused device with "both" did not infringe, and this despite use of the open transition "comprising," which is rather difficult to resolve with the longstanding principle that presence of additional elements in the accused device should not negate infringement ("Rule of Addition"). Think for a minute about how subjective a proposition it is to distinguish that which constitutes a "specific exclusion" vs. that which merely stakes out a boundary in peripheral claim "space." The reader may be surprised at how many hits a search on "and/or" in the claims of recently issued U.S. patents will bring, given that many older texts teach that "and/or" should be avoided because it will precipitate an indefiniteness rejection.
	19



MISMATC	TH BETWEEN SPECIFICATION AND CLAIMS CA LEAD TO FINDING OF INVALIDITY	N
<u>TREND</u>	Previous incarnations of CAFC tended to read claims to preserve validity, but CAFC seems more willing now to simply throw claims out and leave patentee with nothing when there is a mismatch between specification and claims.	İ
<u>TIP</u>	Scope of claims should be commensurate with number of embodiments and variations disclosed in specification. Include healthy range of narror and broad claims to maximize likelihood that at least some claims will survive in litigation.	
<u>COMMENT</u>	<i>Gentry Gallery v. Berkline</i> (CAFC 1998) and <i>Tronzo v. Biomet</i> (CAFC 1998) are two examples of this trend. This trend is even harsher than reading limitation into claims from specification, since this trend results in claims being found <u>invalid</u> , often leaving the patentee with <u>nothing</u> to enforce. Also see slide on written description requirement and "omitted element" rule.)
		21

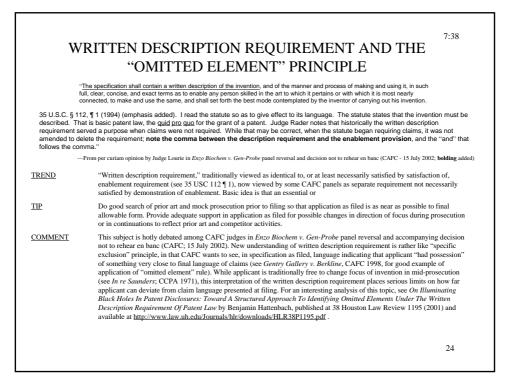
		7:32
	HARMONIZATION	
TREND	Harmonization of U.S. patent law with patent law of other countries, notably those of Europe and Japan.	
TIP	International perspective can give practitioner clues as to where U.S. patent law will go in future.	
<u>COMMEN</u>	[Harmonization played or likely played a role in such shifts in patent la as the movement of claim interpretation out of the hands of juries and into the hands of judges under the ruling in <i>Markman v. Westview Instruments</i> (USSC; 1996), 18-month publication, importation of limitations into claims, and the general trend which can be observed toward a greatly narrowed or crippled DOE, to name a few examples.	
		22

JOHNSON & JOHNSTON DEDICATION

"I have a much different view of this case. Because none of the seven claims here even remotely suggests that one need apply 'tension' to the suture in order to make the legs of the claimed anchor member dig into the cancellous bone tissue and because our precedents coursel against using the term 'comprising' to include disclosed but unclaimed subject matter, the district court correctly concluded that, as a matter of law, the '557 patent does not cover Ethicon's accused method, which indisputably requires this 'tensioning' step. Indeed, one of the asserted claims in this case expressly disclaims the need for 'any manipulation of the [anchor] member other than inserting the member into the bone.' "

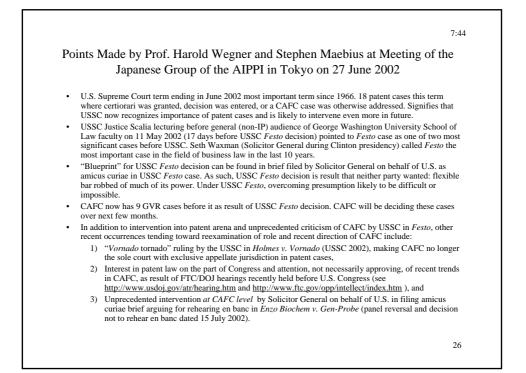
-Judge Michel dissent in Smith & Nephew v. Ethicon (CAFC 2001)

<u>TREND</u>	The dedication rule is yet another limitation on the DOE. Dedication of unclaimed species also furthers the trend away from entitlement to a genus based on disclosure of one or more species. Finally, the philosophy espoused above by Judge Michel is reminiscent of the specific exclusion principle in its ability to place subject matter beyond the purview of the DOE even though arguably within the scope of the invention under a traditional peripheral-claim-type reading of the claim.	7
TIP	Be sure to claim any and all variant structures which are disclosed. Bear in mind that overzealousness in teaching the invention may increase the likelihood of dedicated subject matter. Means plus function claims can be used to advantage as insurance to capture everything in specification.	
<u>COMMENT</u>	In Johnson & Johnston (CAFC en banc; 2002), the CAFC ruled that disclosed but unclaimed embodiments—even trivial and patentably indistinct variants—are dedicated to the public and cann be recaptured under DOE. Above, Judge Michel's statement of the dedication rule appears to rende it powerful enough to overrule the Rule of Addition, narrowing the DOE not only with respect to unclaimed species but also with respect to species which might otherwise have been understood as falling within a claimed genus.	
	23	



Points Made by Donald Chisum at Seminars Hosted by Morrison & Foerster LLP in Osaka and Tokyo on 11 and 13 June 2002

- USSC chastised CAFC very harshly, allowing for typical moderation and reserve commonly employed by appeals court when addressing lower court.
- USSC criticized CAFC for ignoring specific USSC guidance as well as USSC and CAFC precedent as detailed by Judge Michel in his dissent in Festo (CAFC 2000).
- In Warner Jenkinson v. Hilton Davis (USSC 1997), USSC had made it clear that DOE and PHE is settled law and can only be changed by Congress, and further that courts should exercise great caution in not upsetting or disrupting settled property rights of patentees. "Conservation of judicial resources" is an insufficient excuse for such disruption.
- "Rebuttable presumption," established by USSC in Warner Jenkinson v. Hilton Davis (USSC 1997) is real and not just the complete bar by another name.
- CAFC absolute bar is inconsistent with purpose of estoppel in first place and establishment of rebuttable presumption in the second. Flexible bar is respectful of real practice before USPTO.
- USSC established three categories for rebutting presumption:
 - 1) Unforeseeability,
 - 2) Peripheral or tangential rationale for amendment, and
 - 3) Some other reason patentee could not reasonably have been expected to draft literal claim reading on accused device.
- PHE likely to be handled like claim interpretation, e.g., through vehicle of Markman hearing or the like, as question of law to be resolved by judge, not jury (and so subject to de novo review by appeals court).
 - Two themes to be seen in USSC Festo decision:
 - 1) Caution against excessive use of per se rules, and
 - 2) Caution against altering rules that affect property rights or disrupt business transactions.
 - With regard to lessons for CAFC from USSC with regard to other cases (e.g., J&J), CAFC may read USSC Festo decision either as:
 - 1) Warning against overuse of per se rules, or
 - Establishing or reinforcing notion of foreseeability and related notions recently employed by CAFC to detriment of patentee. Language
 used by USSC in its *Festo* decision will be the subject of much litigation in CAFC in coming years.
- USSC Festo decision signals entrance to era of balance between pro-patent and anti-patent in which the Golden Rule ("moderation in all things") should serve as guide, rather than unreviewable jury decisions on one hand and court-created per serules on other.



Unspoken Reason Behind CAFC Festo Decision: "Conservation of Judicial Resources"

"The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. For this reason, the clearest rule of patent interpretation, **literalism, may conserve judicial resources but is not necessarily the most efficient rule**. The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described. See *Winans v. Dennead*, 15 How. 330, 347 (1854)."

-From USSC Festo decision (USSC 2002; bolding added)

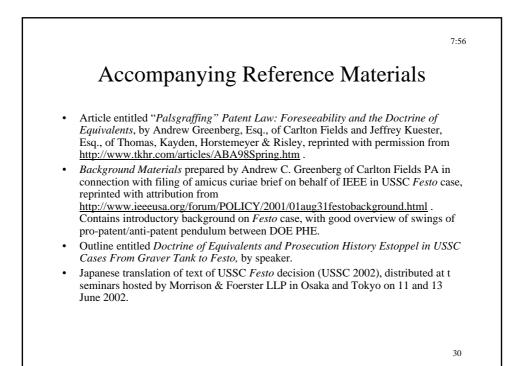
USSC mention of "conservation of judicial resources" here, a phrase not to my recollection
used in any of the briefs, may signal that USSC understands ulterior motive of CAFC in
seizing on public notice function. Borrowing from Kuester's analogy of a USSC and CAFC
RSVP, USSC is here signaling that excessive use of per se rules on part of CAFC represents
"wearing out of welcome" or over-presumptuousness of CAFC.

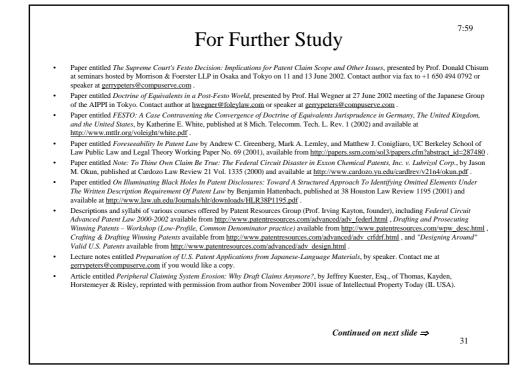
27

	PRACTICE TIPS
	Form is often more important now than substance, and linguistic skills are often more important than technological content.
	Pay careful to attention to singular v. plural issues. Use of singular in claims is now often a disclaimer of plural.
	Pay careful attention to alternative expressions. "And/or" is back in vogue. May also want to say "x or y or both."
•	Good to broaden out coverage by listing alternative examples of structure, but in light of J&J now better to avoid gratuitous listin of alternatives unless include same in claims.
•	Include specific claims for all embodiments disclosed. Strategic use of MPF and SPF claims can help ensure against disclosed be unclaimed subject matter and provide some measure of protection under DOE as guaranteed at 35 USC 112 ¶ 6.
•	Minimize discussion of prior art, benefits, advantages, characteristic or important or essential features, effects.
•	Use permissive or precatory language: "may" or "might" instead of "is." Don't forget boilerplate.
•	Always qualify description by describing features in terms of description of embodiments, aspects, etc. rather than in terms of description of invention itself.
•	Do a good search of prior art before filing, catching at least all prior art that examiner will see. Do mock prosecution before filin, and draft good number of claims of varying scope, type, and perspective. Be sure that most or all will be allowed <i>as filed</i> . Specification should mesh tightly with claims.
•	Be sure that all translation and drafting errors are corrected <i>before filing</i> . Even minor amendments to correct such errors will trigger rebuttable presumption.
•	Use functional language, linking expressions, Markush groups, terms of approximation, and other linguistic devices and stratagems to ensure that claims will have adequate <i>literal</i> scope. "Never put a number in an independent claim" (quote from practitioner friend of Lance Chandler).
•	Keep continuation pending and make use of two-year broadening reissue to redraft claims to read <i>literally</i> on infringing devices they appear in the market. (But watch out for laches and heightened written description requirement.)
•	When amending do not argue; when arguing do not amend. Amend and argue only to the minimum extent necessary to overcom rejection and preferably in way as to give up only comparatively valueless scope.
•	Attack prima facie case behind rejections where warranted. Pursue rejections in appeals rather than amending or otherwise distinguishing over prior art and thus creating PHE.
	2

Hypothetical Scenarios Demonstrating How Translation Issues Might Prejudice Rights of Client

- Resolving ambiguity in text based on embodiment depicted in drawings. Imagine that applicant needs full ambiguity of text to prevail against infringer.
- Tweaking of scope of claims relative to that of supporting specification. Imagine that mismatch between specification and claims causes invalidity or failure to read on what would otherwise be an infringing device.
- Inconsistent use of terminology disturbs antecedence or lexicography. Imagine that CAFC penalizes applicant for lack of clarity (CAFC free to apply unfavorable definition of its choice).
- · Improper parsing of original leads to "nonsense claim" during claim construction by CAFC.
- Arbitrary resolution of number (i.e., singular vs. plural) in way that is narrower (or broader), or different in meaning, than original. CAFC increasingly holding applicant to stated number ("specific exclusion" replacing "rule of addition").
- Arbitrary resolution of conjunctive or disjunctive linking terms (e.g., and, or, and/or, etc.). CAFC increasingly holding applicant to stated relationship ("specific exclusion" replacing "rule of addition").
- Use of articles (e.g., a, the, the aforesaid, etc.) in way that is narrower (or broader), or different in meaning, than original.
- Rewriting of Japanese pseudo-Jepson claim as U.S. "comprising" claim. Imagine, for example, that CAFC at some time in future decides to
 penalize applicants who fail to draft improvement claims in form recommended at 35 USC 112.
- Conversely, failure to redraft Japanese-style "characterized" claim as U.S. "comprising" claim when required to do so may seriously affect rights
 of applicant.
- Rewriting Japanese means-plus-function claim as apparatus claim in attempt to enlarge DOE causes disclosed matter to go unclaimed (dedicated to public and not recapturable under DOE based on 2002 en banc CAFC Johnson & Johnston ruling).
- Amendment made necessary due to poor translation or unwelcome "clarification" on part of translator invokes CAFC Festo surrender, preventing assertion of DOE as to amended element and giving infringer a free ride.
- Distinction between respective vs. collective listing of elements. Scope of claim often relies heavily on what constitutes what and whether things collectively or respectively comprise other things (like elements and compounds). If these fine points are left undefined by applicant, CAFC may define them to detriment of patentee.
- Arbitrary choice of verb tense and/or voice (e.g., use of present or past tense or of indicative or declarative voice) limits scope of claim to
 temporal order or sequence or to structure, etc. not necessarily intended to have been mandatory in original.





8:02 For Further Study (Cont.) Continued from previous slide: Article entitled Recent Changes to U.S. Patent Laws: "The Perils of Poor Patent Application Drafting", by Irah Donner, Esq., of Hale & Dorr, reprinted with permission from author from March 2002 issue of Intellectual Property Today (IL USA). Elements of United States Patent Law, by Donald Chisum with Japanese 対訳 by Toshiko Takenaka, ISBN 4-8419-0276-7, 2nd Edition publ. 2000 by Yushodo Press, Tokyo, JAPAN. 米国特許法逐条解説, by ヘンリー幸田, ISBN 4-8271-0264-3, 4th Edition publ. 2001 by 発明協会, Tokyo, JAPAN. 日/米国際訴訟の実務と論点 訴状の送達から判決の執行まで、by藤田泰弘、ISBN 4-535-51147-0、1st Edition publ. 1998 by 日本評 論社, Tokyo, JAPAN. Electronic and Software Patents: Law and Practice, ed. Steven Lundberg & Stephen Durant, 1st Edition publ. 2000 by BNA Books (division of Bureau of National Affairs), Washington DC USA. Patent Prosecution: Practice & Procedure Before the U.S. Patent Office, by Irah Donner, 1st Edition publ. 1999 by BNA Books (division of Bureau of National Affairs), Washington DC USA. Patent Law: A Practitioner's Guide, by Ronald B. Hildreth, 3rd Edition publ. 1998 by Practising Law Institute, NY USA. How to Write a Patent Application, by Jeffrey Sheldon, Release 8 publ. 2000 by Practising Law Institute, NY USA. Landis on Mechanics of Patent Claim Drafting, ed. Robert Faber, 4th Edition publ. 1997 by Practising Law Institute, NY USA. Professor Irving Kayton's Patent Practice Series (Home Study Library), by Irving Kayton, publ. Patent Resources Group (VA USA). Chisum on Patents, by Donald S. Chisum, publ. by Matthew Bender, ISBN 0-8205-1525-6, available through http://bookstore.lexis.com/bookstore . Manual of Patent Examining Procedure (MPEP); Section 706.03(c) and (d); all of Chapter 2100 but especially 2106 ff. and 2146 ff., available by download from http://www.uspto.gov/web/offices/pac/mpep/index.html or by purchase from Superintendent of Documents, U.S. Government Printing Office, Washington, DC 20402 CAFC case summaries in Japanese by Kenichi Osawa, see http://www.ipcircle.com/usipcrrecent.htm Materials for understanding criteria used by the PTO for assessing obviousness of business methods patent applications, see http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm .

GLOSSARY OF TERMS AND ABBREVIATIONS

CAFC	U.S. Court of Appeals for the Federal Circuit
CCPA	Court of Customs and Patent Appeals (predecessor to CAFC).
CIOLI	Claim It Or Lose It. Also formerly called Rule of Maxwell v. Baker (CAFC 1996), now Rule of Johnson & Johnston v. R. E. Service (CAFC 2002). Referring to irrevocable dedication of subject matter disclosed in specification but not claimed.
DOE	Doctrine of equivalents
GVR	Grant-vacate-remand. Procedure employed by higher court in remanding case to lower court without in-depth examination of case on merits when intervening precedential higher court case creates likelihood that lower court should change its ruling.
J&J	Johnson & Johnston v. R. E. Service (CAFC 2002). See CIOLI.
LPCD	Low-profile, common-denominator. Term coined by PRG staff for type of practice suitable in light of recent CAFC decisions. See Drafting and Prosecuting Winning Patents – Workshop (Low-Profile, Common
	Denominator practice) available from http://www.patentresources.com/wpw_desc.html .
MPF	Means-plus-function (or means for performing a function). Statutory type of claim defined at 35 USC 112 ¶ 6. Likely to be construed as shorthand for structure disclosed in specification.
PHE	Prosecution history estoppel
Rule of Wilson	After Wilson Sporting Goods v. David Geoffrey (CAFC 1990). Referring to Court's mental exercise of constructing hypothetical claim which would literally read on accused device and then inquiring as to whether such a claim would have been allowable over prior art, valid, etc.
SPF	Step-plus-function (<i>or</i> steps for performing a function). Statutory type of claim defined at 35 USC 112 ¶ 6. Likely to be construed as shorthand for acts disclosed in specification.
USSC	U.S. Supreme Court
WD	Written description (requirement). See 35 USC 112 ¶ 1. Especially important in <i>Enzo Biochem v. Gen-Probe</i> (15 July 2002). Note that U.S. Solicitor General took unusual step of filing amicus curiae brief at CAFC level in this case, arguing for rehearing en banc.
Vornado "tornado"	After Holmes v. Vornado (USSC 2002). USSC decision dethroning CAFC from position as sole court with exclusive jurisdiction for appeals in patent cases. Certain patent cases now appealable to district courts as result of this ruling.
	33