

*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

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1

2002年5月に出た最高裁の判決なのに、1998年春に発表した 記事を教材として使うのはなぜ？

- ちょっと古い(1998年春)ながら予言的と言ってよいほど、今回の講演に使う教材記事 “*Palsgraffing*” *Patent Law: Foreseeability and the Doctrine of Equivalents* (米国弁護士 Andrew Greenberg及び米国弁護士 Jeffrey Kuester 著)は、現在の話題である *Festo* 事件を始め、*Johnson & Johnston* その他CAFC控訴裁で観られるantipatentがちの判決動向の背景経緯を鋭く且つ分かりやすく描いてくれます。本記事を元に、*Festo* 事件及び最近のCAFC控訴裁の動向についてお話ししたいと思います。
- 参加者からのコメントや討論などを講演後のQ&Aの時に期待しております。また、講演の途中に不明な点があったり、話の展開となるようなコメントがありましたら、是非ご遠慮無しに言っていただきたいと思います。日本企業の特許権者が侵害訴訟などで、原告・被告の両側となる場合があり、どちらの立場から見るとかは、意見がからって変わるところが特に面白いと思いますので、攻撃・防衛どちらの立場からでもご遠慮なく貢献してください。

DISCLAIMER: Speaker is a U.S. patent agent but not an attorney. This material is being presented for educational purposes only and nothing herein should be construed as legal advice. Comments made about infringement are only raised in the context of how they apply to the practitioner's job of getting claims for his/her client that will do the job in court.

2

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. 56; *Celotex Corp. v. Catrett*, 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, we are confident that the Federal Circuit can remedy the problem. Of course, the various legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict. Fed. Rule Civ. Proc. 56; Fed. Rule 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)

「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」を聞くと、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 matter).

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 doctrine 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)

「Foreseeability」の*Sage Products*以外の“Roots”

その一

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**)

「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.¹⁵² 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**)

「Foreseeability」のSage Products以外の“Roots”

その三

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 **later-developed 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)

「Foreseeability」のSage Products以外の“Roots”

その四

USSC *Festo*判決で法廷助言者としてIEEEの趣意書

“The IEEE-USA suggests that the flexible bar’s deficiencies may be cured without resorting, as the Federal Circuit did below, to the absolute bar. As detailed hereafter, the IEEE-USA strongly recommends that this Court adopt instead a “**foreseeable bar**,” ...

Unlike the flexible and absolute bars, the **foreseeable bar is workable.** ...

Foreseeability is a traditional jurisprudential device that is commonly used by courts to circumscribe legal principles in a manner that is **flexible and yet objective and reasonably determinate.** Thus, foreseeability is often used to determine, as a matter of law, the existence of a **common law duty of care.** *E.g., Palsgraf v. Long Island R.R. Co.*, 162 N.E. 99 (N.Y. 1928) (Cardozo, J.); *see, e.g.,* Peter F. Lake, *Common Law Duty in Negligence Law*, 34 SAN DIEGO L. REV. 1053 (1997) (contrasting elements of modern no-duty rules among the states). ...

In particular, while the foreseeable bar is **not a bright line rule like the absolute bar**, it provides a concise test that is both **flexible and readily comprehensible** to both the public and to the district court judges who must apply it. ...

In contrast, a foreseeable bar asks the trial judge only whether the limiting effect of an amendment’s language as applied to exclude an accused device from literal infringement **was foreseeable at the time of the amendment.** Foreseeability, in general, is a consummate **common law principle with which judges are intimately familiar.** Unlike the flexible bar, the foreseeable bar is more focused, limiting the inquiry as a matter of law to a particular limiting effect of particular claim language with respect to a particular accused device. The bases for the trial judge’s conclusion can be readily articulated in an opinion, which in turn can be **readily reviewed as a matter of law by an appellate court.**”

—From IEEE-USA (Institute of Electrical and Electronics Engineers) amicus curiae brief filed with court in USSC *Festo* decision (2002; **bolding** added)

Kuester Haikus

<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 then, you won't get it later”
<u>Prior Allowability Rule (Rule of <i>Wilson</i>):</u>	“If you couldn't have gotten it then, you won't get it later”
<u>Dedication Rule (CIOLI):</u>	“If you disclosed alternatively and didn't get it then, you won't get it later”
<u>Foreseeability Rule:</u>	“If you should have tried to get it then, you won't get it later”

—From “*Palsgraffing*” *Patent Law*, by Andrew Greenberg and Jeffrey Kuester

The “Rosetta Stone”?

Key to Understanding the Nexus Among Specific Exclusion, CIOLI Dedication, Public Notice Function, and Foreseeability

“ ‘the claim of a specific device or combination, and an **omission to claim** other devices or combinations **apparent on the face of the patent**, are, in law, a dedication to the public of that which is not claimed.’ ”

—From majority opinion by Judge Lourie in *Maxwell v. Baker* (CAFC 1996), citing *Miller v. Bridgeport Bass* (USSC 1881) (**bolding added**)

- Common link among specific exclusion (*Scimed Life, Dolly*), CIOLI dedication (*Maxwell, J&J*), public notice function (*Festo*), and foreseeability (*Festo, Sage Products*) is perhaps this phrase “apparent on the face of the patent” cited by Judge Lourie in *Maxwell v. Baker* (CAFC 1996) from *Miller v. Bridgeport Bass* (USSC 1881).

Specific Trends and Non-Trends in Recent CAFC Decisions

INCONSISTENCY AMONG DECISIONS

“The majority of Federal Circuit Judges regularly render nearly incredible, and, often enough, nearly incomprehensible opinions despite the few stalwart and too polite dissents and critical concurrences of a minority (often shifting) of the Court. Moreover, too often different panels of the Court promulgate judicial opinions within days of each other that are in direct jurisprudential conflict on common issues.”

—Prof. Irving Kayton in course description for PRG course entitled *Federal Circuit Advanced Patent Law 2000-2002*

NON-TREND CAFC judges and panels are in open opposition on many issues, and rulings frequently flip back and forth from case to case or in successive rulings in same case. District courts lack clear guidance on many important issues.

TIP Assume the worst and play it safe by drafting patent application so as to withstand scrutiny by even the most patentee-hostile CAFC panel.

COMMENT Current dissension among various CAFC judges and panels mimics inconsistency and confusion that prevailed among various district courts before creation of CAFC and enforcement of order and uniformity under leadership of Judge Rich. Current open dissent among CAFC judges may reflect fact that there is as yet no clear successor to Judge Rich.

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)

- TREND** 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.
- COMMENT** *Sage Products* 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.

LIMITATIONS BEING IMPORTED INTO CLAIMS

“Moreover, under the guise of *claim interpretation*, a current line of cases has held claims in predictable arts that are indisputably literally infringed, (*i.e.*, the claims read literally on the accused devices or processes), to be *not* infringed by the *simple artifice of importing, by fiat, limitations or elements from the specifications into the claims*. Those cases are: *Hockerson-Halberstadt Inc. v. Avia Group International*; *Watts v. XL Systems, Inc.*; *Kimberly-Clark v. Tyco International*; *Wang Labs, Inc. v. America Online*; *Toro Co. v. White Consolidated Indus.*; *Scimed Life Systems v. Advanced Cardiovascular Systems*; and *Netword, LLC v. Centraal Corp. Query: Is the law of patent infringement now different in any significant respect from that of the law of copyright infringement?*”

—Prof. Irving Kayton in course description for PRG course entitled *Federal Circuit Advanced Patent Law 2000-2002*

- TREND** Traditionally the claims and the claims alone defined the metes and bounds of the invention. Current trend is to “redefine” terms in claims based on corresponding terms elsewhere, often effectively importing limitations into claims in process.
- TIP** Constantly use expansive or precatory (“may” or “might”) language. Constantly distinguish “invention” from “embodiments,” “aspects,” etc. . Assume that anything you say can and will be used against you during claim interpretation. Be especially wary at traditionally innocuous locations such as Summary, Abstract, Title. Include Definitions section explicitly defining terms used in claims.
- COMMENT** This is one of the most pervasive and damaging (to patentee) trends that can be observed in recent CAFC decisions. In at least one case the CAFC has even read limitations into claims from the **Abstract**, and this despite the explicit reassurance at 37 CFR 1.72 that this is not to be done.

OBJECTS, 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.
- COMMENT** 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, *Dawn Equipment v. Kentucky Farms* (CAFC 1998), *Kraft Foods v. International Trading, Vehicular Technologies v. Titan Wheel* (CAFC 1998). Also see *Gentry Gallery v. Berklene* (CAFC 1998), slide on written description requirement and “omitted element” rule, and slide on “specific exclusion” principle quoting *Scimed Life Systems v. Advanced Cardiovascular Systems* (CAFC 2001).

CHEMICAL “RECIPE” CLAIM PRACTICE IN JEOPARDY

“Under the court’s new law, **table salt dissolved in water will not be an adequate description** of the composition for infringement purposes, since the sodium chloride molecule no longer ‘exists’; in dissolution the sodium and chloride ions will have broken their bonds to each other, in interaction with molecules of water.”

—Dissent by Judge Newman in *Exxon v. Lubrizol* (CAFC 1996; **bolding** added)

- TREND** Picayune dissection and deconstruction of language of claim to reach a finding of no infringement. Exemplary of trend to put form (linguistic issues) over substance (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.
- COMMENT** CAFC majority in *Exxon* 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 *Process Control v. Hydreclaim* (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 *the height of Y*” instead of the more common “the height of X is greater than Y.” For detailed analysis of *Exxon*, see *Note: To Thine Own Claim Be True: The Federal Circuit Disaster in Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, by Jason M. Okun, published at *Cardozo Law Review* 21 Vol. 1335 (2000) and available at <http://www.cardozo.yu.edu/cardlrev/v21n4/okun.pdf>.

EQUITY BEING REPLACED BY CATALOG OF RULES

“Determination of equivalency is not unlike determination of substantial similarity in copyright law or determination of nonobviousness 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**)

- TREND** Whereas the court previously was content to weigh the equities between patentee and accused infringer, consistent with the patentee-hostile stance of *Sage Products* 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.
- TIP** 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 of 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 *Festo* dissent (however, beware of reversal or remand by USSC).
- 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 *Festo* 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 *Festo* (CAFC 2000), laches in *Symbol Technologies v. Lemelson* (CAFC 2002).

APPLICATION OF APA TO PATENT LAW

- TREND** *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.
- TIP** 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.
- COMMENT** 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” OVERRULES TRADITIONAL “RULE OF ADDITION”

EXAMPLE #1: “OR” → 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)

- TREND** 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 *Kustom Signals v. Applied Concepts* (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.

NEW “SPECIFIC EXCLUSION PRINCIPLE” OVERRULES TRADITIONAL “RULE OF ADDITION”

EXAMPLE #2: USE OF SINGULAR CAN DISCLAIM PLURAL

- TREND** 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 singular in claim as specific waiver of plural. Need to say “at least one” or “one or more” or the like. Avoid limiting statements, characterizations of prior art, and overzealous touting of advantages and features of invention.
- COMMENT** It was traditionally safe to claim (or translate) elements in the singular, since a plurality by definition contains at least one, and additional elements should not negate infringement in accordance with an expression of the bedrock of peripheral claiming known as the “Rule of Addition.” However, the CAFC is now (sometimes) taking the singular to imply a waiver of the plural. See cases like *Abtox v. Exitron* (CAFC 1997), *Elkay v. Ebco, Instuform Technologies v. Cat Contracting* (CAFC 1996), *North American Vaccine v American Cyanamid* (CAFC 1993), and *Kinetic Concepts v KCI Therapeutic* (CAFC 2000).

MISMATCH BETWEEN SPECIFICATION AND CLAIMS CAN LEAD TO FINDING OF INVALIDITY

- TREND 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.
- TIP Scope of claims should be commensurate with number of embodiments and variations disclosed in specification. Include healthy range of narrow and broad claims to maximize likelihood that at least some claims will survive in litigation.
- COMMENT *Gentry Gallery v. Berkline* (CAFC 1998) and *Tronzo v. Biomet* (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 invalid, often leaving the patentee with nothing to enforce. Also see slide on written description requirement and “omitted element” rule.

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.
- COMMENT Harmonization played or likely played a role in such shifts in patent law as the movement of claim interpretation out of the hands of juries and into the hands of judges under the ruling in *Markman v. Westview Instruments* (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.

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 counsel 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)

TREND

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.

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.

COMMENT

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 cannot be recaptured under DOE. Above, Judge Michel's statement of the dedication rule appears to render 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.

WRITTEN DESCRIPTION REQUIREMENT AND THE "OMITTED ELEMENT" PRINCIPLE

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, ¶ 1 (1994) (emphasis added). I read the statute so as to give effect to its language. The statute states that the invention must be described. That is basic patent law, the *quid pro quo* for the grant of a patent. Judge Rader notes that historically the written description requirement served a purpose when claims were not required. While that may be correct, when the statute began requiring claims, it was not amended to delete the requirement; **note the comma between the description requirement and the enablement provision**, and the "and" that follows the comma."

—From per curiam opinion by Judge Lourie in *Enzo Biochem v. Gen-Probe* panel reversal and decision not to rehear en banc (CAFC - 15 July 2002; **bolding added**)

TREND

"Written description requirement," traditionally viewed as identical to, or at least necessarily satisfied by satisfaction of, enablement requirement (see 35 USC 112 ¶ 1), now viewed by some CAFC panels as separate requirement not necessarily satisfied by demonstration of enablement. Basic idea is that an essential or

TIP

Do good search of prior art and mock prosecution prior to filing so that application as filed is as near as possible to final allowable form. Provide adequate support in application as filed for possible changes in direction of focus during prosecution or in continuations to reflect prior art and competitor activities.

COMMENT

This subject is hotly debated among CAFC judges in *Enzo Biochem v. Gen-Probe* panel reversal and accompanying decision not to rehear en banc (CAFC; 15 July 2002). New understanding of written description requirement is rather like "specific exclusion" principle, in that CAFC wants to see, in specification as filed, language indicating that applicant "had possession" of something very close to final language of claims (see *Gentry Gallery v. Berkline*, CAFC 1998, for good example of application of "omitted element" rule). While applicant is traditionally free to change focus of invention in mid-prosecution (see *In re Saunders*; CCPA 1971), this interpretation of the written description requirement places serious limits on how far applicant can deviate from claim language presented at filing. For an interesting analysis of this topic, see *On Illuminating Black Holes In Patent Disclosures: Toward A Structured Approach To Identifying Omitted Elements Under The Written Description Requirement Of Patent Law* by Benjamin Hattenbach, published at 38 Houston Law Review 1195 (2001) and available at <http://www.law.uh.edu/Journals/hlr/downloads/HLR38P1195.pdf>.

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
 - 2) 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 se rules on other.

Points Made by Prof. Harold Wegner and Stephen Maebius at Meeting of the Japanese Group of the AIPPI in Tokyo on 27 June 2002

- U.S. Supreme Court term ending in June 2002 most important term since 1966. 18 patent cases this term where certiorari was granted, decision was entered, or a CAFC case was otherwise addressed. Signifies that USSC now recognizes importance of patent cases and is likely to intervene even more in future.
- USSC Justice Scalia lecturing before general (non-IP) audience of George Washington University School of Law faculty on 11 May 2002 (17 days before USSC *Festo* decision) pointed to *Festo* case as one of two most significant cases before USSC. Seth Waxman (Solicitor General during Clinton presidency) called *Festo* the most important case in the field of business law in the last 10 years.
- "Blueprint" for USSC *Festo* decision can be found in brief filed by Solicitor General on behalf of U.S. as amicus curiae in USSC *Festo* case. As such, USSC *Festo* decision is result that neither party wanted: flexible bar robbed of much of its power. Under USSC *Festo*, overcoming presumption likely to be difficult or impossible.
- CAFC now has 9 GVR cases before it as result of USSC *Festo* decision. CAFC will be deciding these cases over next few months.
- In addition to intervention into patent arena and unprecedented criticism of CAFC by USSC in *Festo*, other recent occurrences tending toward reexamination of role and recent direction of CAFC include:
 - 1) "Vornado tornado" ruling by the USSC in *Holmes v. Vornado* (USSC 2002), making CAFC no longer the sole court with exclusive appellate jurisdiction in patent cases,
 - 2) Interest in patent law on the part of Congress and attention, not necessarily approving, of recent trends in CAFC, as result of FTC/DOJ hearings recently held before U.S. Congress (see <http://www.usdoj.gov/atr/hearing.htm> and <http://www.ftc.gov/opp/intellect/index.htm>), and
 - 3) Unprecedented intervention at CAFC level by Solicitor General on behalf of U.S. in filing amicus curiae brief arguing for rehearing en banc in *Enzo Biochem v. Gen-Probe* (panel reversal and decision not to rehear en banc dated 15 July 2002).

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. Denmead*, 15 How. 330, 347 (1854).”

—From USSC *Festo* decision (USSC 2002; **holding** 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.

PRACTICE TIPS

- Form is often more important now than substance, and linguistic skills are often more important than technological content.
- Pay careful 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 listing 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 but 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 filing and draft good number of claims of varying scope, type, and perspective. Be sure that most or all will be allowed *as filed*. Specification should mesh tightly with claims.
- Be sure that all translation and drafting errors are corrected *before filing*. 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 *literal* 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 *literally* on infringing devices as 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 overcome 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.

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.

Accompanying Reference Materials

- Article entitled “*Palsgrafting Patent Law: Foreseeability and the Doctrine of Equivalents*,” by Andrew Greenberg, Esq., of Carlton Fields and Jeffrey Kuester, Esq., of Thomas, Kayden, Horstemeyer & Risley, reprinted with permission from <http://www.tkhr.com/articles/ABA98Spring.htm>.
- *Background Materials* prepared by Andrew C. Greenberg of Carlton Fields PA in connection with filing of amicus curiae brief on behalf of IEEE in USSC *Festo* case, reprinted with attribution from <http://www.ieeeusa.org/forum/POLICY/2001/01aug31festobackground.html>. Contains introductory background on *Festo* case, with good overview of swings of pro-patent/anti-patent pendulum between DOE PHE.
- Outline entitled *Doctrine of Equivalents and Prosecution History Estoppel in USSC Cases From Graver Tank to Festo*, by speaker.
- Japanese translation of text of USSC *Festo* decision (USSC 2002), distributed at seminars hosted by Morrison & Foerster LLP in Osaka and Tokyo on 11 and 13 June 2002.

For Further Study

- Paper entitled *The Supreme Court's Festo Decision: Implications for Patent Claim Scope and Other Issues*, presented by Prof. Donald Chisum at seminars hosted by Morrison & Foerster LLP in Osaka and Tokyo on 11 and 13 June 2002. Contact author via fax to +1 650 494 0792 or speaker at gerrypeters@compuserve.com.
- Paper entitled *Doctrine of Equivalents in a Post-Festo World*, presented by Prof. Hal Wegner at 27 June 2002 meeting of the Japanese Group of the AIPPI in Tokyo. Contact author at hwegner@foleylaw.com or speaker at gerrypeters@compuserve.com.
- Paper entitled *FESTO: A Case Contravening the Convergence of Doctrine of Equivalents Jurisprudence in Germany, The United Kingdom, and the United States*, by Katherine E. White, published at 8 Mich. Telecomm. Tech. L. Rev. 1 (2002) and available at <http://www.mttr.org/voleight/white.pdf>.
- Paper entitled *Foreseeability In Patent Law* by Andrew C. Greenberg, Mark A. Lemley, and Matthew J. Conigliaro, UC Berkeley School of Law Public Law and Legal Theory Working Paper No. 69 (2001), available from http://papers.ssrn.com/sol3/papers.cfm?abstract_id=287480.
- Paper entitled *Note: To Thine Own Claim Be True: The Federal Circuit Disaster in Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, by Jason M. Okun, published at Cardozo Law Review 21 Vol. 1335 (2000) and available at <http://www.cardozo.yu.edu/cardrev/v21n4/okun.pdf>.
- Paper entitled *On Illuminating Black Holes In Patent Disclosures: Toward A Structured Approach To Identifying Omitted Elements Under The Written Description Requirement Of Patent Law* by Benjamin Hattenbach, published at 38 Houston Law Review 1195 (2001) and available at <http://www.law.uh.edu/Journals/hlr/downloads/HLR38P1195.pdf>.
- Descriptions and syllabi of various courses offered by Patent Resources Group (Prof. Irving Kayton, founder), including *Federal Circuit Advanced Patent Law 2000-2002* available from http://www.patentresources.com/advanced/adv_federl.html, *Drafting and Prosecuting Winning Patents – Workshop (Low-Profile, Common Denominator practice)* available from http://www.patentresources.com/wpw_desc.html, *Crafting & Drafting: Winning Patents* available from http://www.patentresources.com/advanced/adv_crdrf.html, and *"Designing Around" Valid U.S. Patents* available from http://www.patentresources.com/advanced/adv_design.html.
- Lecture notes entitled *Preparation of U.S. Patent Applications from Japanese-Language Materials*, by speaker. Contact me at gerrypeters@compuserve.com if you would like a copy.
- Article entitled *Peripheral Claiming System Erosion: Why Draft Claims Anymore?*, by Jeffrey Kuester, Esq., of Thomas, Kayden, Horstemyer & Risley, reprinted with permission from author from November 2001 issue of Intellectual Property Today (IL USA).

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31

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/usiprecent.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>.

32

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 <i>Maxwell v. Baker</i> (CAFC 1996), now Rule of <i>Johnson & Johnston v. R. E. Service</i> (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	<i>Johnson & Johnston v. R. E. Service</i> (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 <i>Drafting and Prosecuting Winning Patents – Workshop (Low-Profile, Common Denominator practice)</i> available from http://www.patentresources.com/wpw_desc.html .
MPF	Means-plus-function (<i>or</i> 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 <i>Wilson</i>	After <i>Wilson Sporting Goods v. David Geoffrey</i> (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.
<i>Vornado</i> "tornado"	After <i>Holmes v. Vornado</i> (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.