

**CLASS 14**

**DOCTRINE OF EQUIVALENTS II:**

**THE ALL ELEMENTS RULE & PROSECUTION HISTORY  
ESTOPPEL**

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**PATENT LAW & POLICY  
PROFESSOR WAGNER**



**Today's Agenda**

**The "All Elements Rule"**  
**Prosecution History Estoppel**

# 1

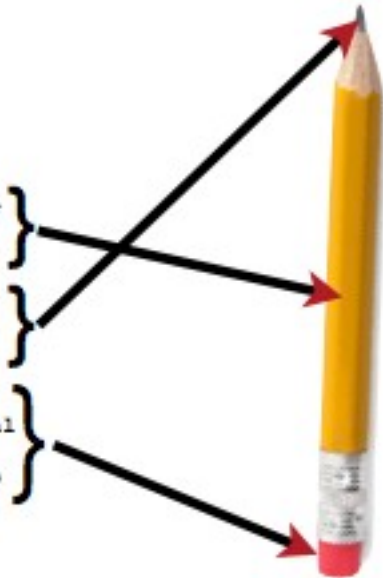
## The "All Elements Rule"

1. A writing implement comprising:

a wooden cylinder with a hollow core,

a cylinder of graphite in said hollow core,

a small cylinder of eraser material attached to one end of the wooden cylinder.





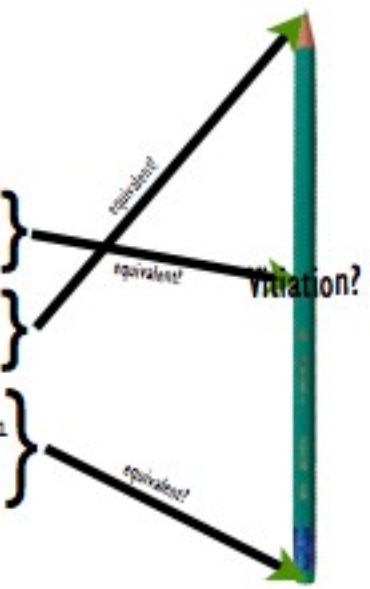


Footnote 8: With regard to the concern over unreviewability due to black-box jury verdicts, we offer only guidance, not a specific mandate.... [I]f a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve.... 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.



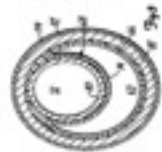
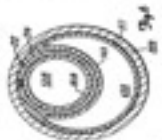
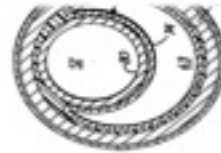
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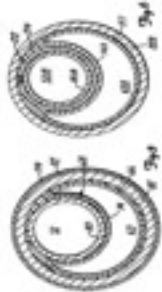


## Scimed Life Systems v. Advanced Cardiovascular Systems, Inc.



The court determines that the claim encompassed "coaxial" lumen catheters, not "dual-lumen" catheters.  
Why?

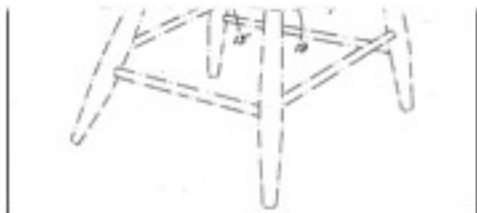
U.S. Patent 4,123,456

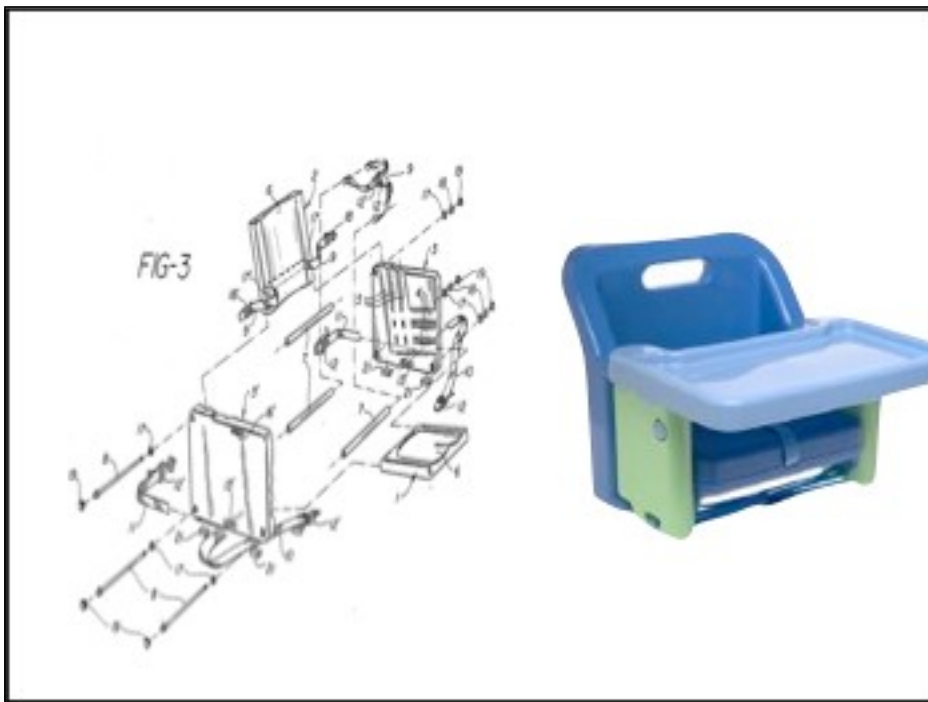


Each of the SciMed patents specifically recognized and disclaimed the dual lumen structure, making clear that the patentee regarded the dual lumen configuration as significantly inferior to the coaxial lumen configuration used in the invention. Where such an explicit disclaimer is present, the principles of those cases apply a fortiori, and the patentee cannot be allowed to recapture the excluded subject matter under the doctrine of equivalents without undermining the notice function of the patent.



**Dolly v. Spaulding & Evenflo (Fed. Cir. 1994)**





## The All-Elements Rule

- **Weiner v NEC Electronics (Fed. Cir. 1996) (Rader)**
  - Claim: required data in 'columns,' which was interpreted to require data on the chip to be stored in columns.
  - The accused device stored data in columns, but only on an external data register.
- **Sage Products (Fed. Cir. 1997) (Rader)**
  - The claim language required "an elongated slot at the top of the container body"
  - The accused device had a slot (if at all) within the body (not the top).
- What is the rule of Dolly/Weiner/Sage?

## The All-Elements Rule: Vitiation

### 1. A fastening system comprising

- A two-inch long bolt
- A corresponding nut with five sides
- Wherein the nut includes an insert of plastic material

### • Device A: same system, except bolt is 2.5 inches long.

### • Device B: same system, except the insert is cork

- Do the differences above "vitate" the element?
- Or are they "equivalent" to the element?



## The All-Elements Rule: Vitiation

1. A fastening system comprising:

a two-inch long bolt

a corresponding nut with five angled sides

**A**

1. A fastening system comprising:

a bolt,

said bolt being two inches long,

a nut,

said nut having five angled sides

**B**

# 2

## Prosecution History Estoppel

### Prosecution History Estoppel Illustration

Patent '123 discloses a lighting system,  
using colored bulbs; a blue color is given as an example

The prior art contains very similar systems, including those using red colored bulbs.

#### Scenario 1

Original claim:

1. A lighting system comprising:  
... a colored bulb ...

Amended claim:

1. A lighting system comprising:  
... a blue light bulb ...

#### Scenario 2

Original claim:

1. A lighting system comprising:  
... a blue light bulb ...

No amendments.

# Prosecution History Estoppel Illustration

## Scenario 1

Original claim:

1. A lighting system comprising:  
... a colored bulb ...

Amended claim:

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## Scenario 2

Original claim:

1. A lighting system comprising:  
... a blue light bulb ...

No amendments.

Which scenario covers:

Lighting systems with blue bulbs.

Lighting systems with red bulbs.

Lighting systems with green bulbs.



## Festo v. Shoketsu Kinzoku Kogyo Kabushiki (USSC 2002)

est, claiming that IMA's device is an obvious variation of Festo's patent under the doctrine of equivalents. The District Court ruled for Festo, rejecting IMA's argument that the prosecution history estoppel doctrine barred Festo from asserting the IMA's device is equivalent. A Federal Circuit panel initially affirmed, but the Court granted certiorari, reversed, and remanded in light of Warner-Jenkinson Co. v. Watson-Chase Chemical Co., 399 U.S. 87, 29, which had acknowledged that estoppel may rely on the prosecution history to deny the patentee from recapturing subject matter surrendered by amendment as a condition of obtaining the patent. On remand, the en banc Federal Circuit reversed, holding that prosecution history estoppel applied. The court ruled that estoppel arose from any amendment that narrows a claim in compliance with the Patent Act, not only from amendments made to avoid the prior art, as the District Court had held. The Federal Circuit also held that, when estoppel applies, it bars any claim of equivalence for the element that was amended. The court acknowledged that, under its prior cases, prosecution history estoppel

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).

The Federal Circuit also held that, when amended claims, it has no claim of equivalence for the element that was amended. The court acknowledged, under its prior case, prosecution history estoppel.

Unfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application. The inventor who chooses to patent an invention and disclose it to the public, rather than exploit it in secret, bears the risk that others will devote their efforts toward exploiting the limits of the patent's language.

*Pfeiffer Patent Corporation v. American Telephone & Telegraph Co.*, 189 F.2d 1001, 1008 (9th Cir. 1951).

By amending the application, the inventor is deemed to concede that the patent does not extend as far as the original claim. It does not follow, however, that the amended claim becomes so perfect in its description that no one could devise an equivalent. After amendment, as before, language remains an imperfect fit for invention. The narrowing amendment may demonstrate what the claim is not; but it may still fail to capture precisely what the claim is.

