Doctrine of Equivalents III:
Prosecution History Estoppel
Prosecution History Estoppel

Patent disclosure is of a lighting system, using colored bulbs; blue color is given as the primary example (preferred embodiment / best mode).

Prior art includes very similar systems, using red-colored bulbs.

Scenario 1

Claim 1 / Original

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

Claim 1 / Amended / Issued

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

Scenario 2

Claim 1 / Original

1. A lighting system comprising:
   
   ... 
   
   a blue light bulb 
   
   ...
Prosecution History Estoppel

The Tale of Two Claims

(Amended) 1. A lighting system comprising:  (Original) 1. A lighting system comprising:
   
   a blue light bulb  
   
   Systems with blue light bulbs
   Systems with red light bulbs
   Systems with green light bulbs
Prosecution History Estoppel

The Tale of Two Claims

(Amended)
1. A lighting system comprising:
   
   a blue light bulb

(Original)
1. A lighting system comprising:

   a blue light bulb

Prosecution history estoppel [PHE] (traditional view):

Prevents patentee from recapturing via the DOE, what was surrendered during prosecution.

*Key question: what does surrender mean?*

Thus:

1. *PHE is typically considered a critical limitation on DOE*
2. *PHE application is an issue of law (see Warner-Jenkinson, footnote 8)*
Prosecution History Estoppel

The Doctrine of Prosecution History Estoppel
(Pre-Festo)

When does estoppel apply?

Amendments to claim language. What kind?

Arguments? What kind?

Note Warner-Jenkinson:
1. Pointed to PHE as a crucial limitation on DOE
2. Established a “presumption” that unexplained amendments would trigger estoppel. (Didn’t say what information would overcome the presumption.)

What is the scope of estoppel?

“complete bar”: no doctrine of equivalents for amended claim elements. See Exhibit Supply, p. 400.

“flexible bar”: the estoppel was limited to what POSITA would consider to have been surrendered. Range from “great to small to zero” (determined by court). Hughes 14 / Litton Systems (1998): surrendered only the prior art.
# Prosecution History Estoppel

## The Doctrine of PHE: *Festo*

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<thead>
<tr>
<th>Question</th>
<th>Answer</th>
<th>Reasoning</th>
</tr>
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<tbody>
<tr>
<td>What type of amendments trigger estoppel?</td>
<td>“reasons related to patentability”</td>
<td></td>
</tr>
<tr>
<td>Do “voluntary” amendments trigger estoppel?</td>
<td>“yes”</td>
<td></td>
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<tr>
<td>What is the scope of equivalents, once estoppel is triggered?</td>
<td>“zero” (complete bar)</td>
<td></td>
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<tr>
<td>What is the scope of estoppel, under the <em>Warner-Jenkinson</em> presumption</td>
<td>“zero”</td>
<td></td>
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Prosecution History Estoppel

The Doctrine of PHE: *Festo*

Judge Michel:
1. “Upsets the balance”: too unfair to patentees
2. Possible conflicts with Supreme Court. (But see Exhibit Supply)
3. Change in the law will affect lots of pending/non-expired patents

Judge Linn
1. “Nature of Language”: very hard to draft precise and accurate claims; easy to reject them incorrectly.
2. “Early stage of development”: the law encourages early filing, which means all information is not known
3. “Imposing costs on patentee”: rational patentees will spend more on prosecution, claim more narrowly

Judge Rader
DOE is intended to allow infringement of after-arising technology, irrespective of claim amendments.

Judge Newman
Contrary to patent policy - which requires a broad conception of patents
Prosecution History Estoppel
Reconsidering Festo

1. Is *Festo* really all about the scope of patents? (Is that all that PHE is good for?)

   Consider: what is the scope of prosecution history estoppel after *Festo*? Has it changed? For which patents/patentees?

   Are there other uses for prosecution history information? Are there reasons to think prosecution history information is good?

2. If PHE is about something more than an outer limit on patent scope, then what?

   *Information:* PHE information is especially valuable

   *Incentives:* PHE imposes a “penalty default” rule -- encouraging certain behavior (information production) in the shadow of scope limitations.

   Prior art searches
   Appropriate scope/clarity of claiming (in light of prior art and disclosure)
   Keeping the PTO “honest”
Prosecution History Estoppel

A couple of other PHE wrinkles:

1. The uncertain status of estoppel by argument.
   Should arguments “related to patentability” also trigger the estoppel under Festo?
   Consider our original example:
   … a colored bulb…

   If I say in prosecution that “the bulb described in claim 1 is blue”, then to what effect? (Can I capture green lamps)

   If I say in prosecution that “the bulb described in claim 1 is not red”, then to what effect? (Can I capture green lamps)
Prosecution History Estoppel

A couple of other PHE wrinkles:

2. Estoppel by Specification?
   
   In *Vehicular Technologies*, the key claim element was a pair of concentric springs (one inside the other).
   
   The accused device used an outer spring and an inner solid plug.
   
   In the written description, the patentee stated that the inner spring performed a “backup” function.
   
   What effect did the statement about the “backup” function have on DOE? Is this the right rule?