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# United States Supreme Court Reinvigorates Patent Law Doctrine of Equivalents

## *Festo v. Shoketsu Kinzoku Kohyo Kabushiki Co.*

A recent decision by the United States Supreme Court may significantly impact the scope of protection a court will accord to patent claims in an infringement lawsuit. In its much anticipated decision in *Festo v. Shoketsu Kinzoku Kohyo Kabushiki Co.*, __ U.S. __ (May 28, 2002), the Supreme Court held that amending claims in a patent application during prosecution does not preclude a patentee from later asserting that a competitor infringes its patent by making, using, selling or offering for sale a product or method that is equivalent to, but not identical to, the claimed invention. This decision vacates the earlier decision of the Court of Appeals for the Federal Circuit (CAFC) holding that any amendment to an element of a patent claim bars the patentee from later asserting infringement based upon the existence in the accused product or method of an equivalent, but not literally identical, element. The Supreme Court's decision does not, however, simply restore patent law to its pre-*Festo* state. Rather, the Supreme Court's decision places a significant new burden on patentees to justify why amendments made during prosecution do not preclude a range of equivalents that covers the accused product or method. A patentee seeking to assert infringement by equivalents must now show that "one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."

## The Court Decision

The Supreme Court identified two specific situations in which equivalents continue to be assertable. First, where "the equivalent may have been unforeseeable at the time of the application," and second where "the rationale underlying the amendment may have 'no more than a tangential relation' to the equivalent." The Supreme Court also left open the possibility that "there may have been some other reason suggesting that the patentee could not reasonably be expected to have described the equivalent."

## Implications for Patent Owners

This decision could impact the value of existing U.S. patents, may change the probability of success in litigation for existing U.S. patents, and will affect how patent applications are written and prosecuted before the U.S. Patent and Trademark Office in order to ensure the broadest scope of protection for the subject invention. In view of this significant change in the law, Wiggin & Dana's Patent Practice Group is available to review our

**Patent Portfolio Review**

client's patent portfolios, as well as the patent portfolios of our client's competitors, and to provide advice as to the likely impact of this Supreme Court decision. For additional information or to schedule a patent portfolio review, please contact Gregory S. Rosenblatt in our New Haven office at grosenblatt@wiggin.com or 203-498-4566; or William J. Speranza in our Stamford office at wsperanza@wiggin.com or 203-363-7637.

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