

## **Post-*Festo* Patent Bar Prepares for Prosecution Gridlock**

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Patent prosecutors around the country are still buzzing about the impact of the recent *Festo* decision<sup>1</sup> on practice before the United States Patent and Trademark Office (PTO). While litigators rewrite their briefs to reflect what is left of the doctrine of equivalents, prosecutors are strategizing about best practices for avoiding the “absolute bar” mandated by the *Festo* decision when prosecution history estoppel applies. It is becoming clear that prosecution in the wake of *Festo* will require increased care and vigilance, as well as fortitude by prosecutors and examiner alike.

The *Festo* decision broadens the scope of prosecution history estoppel to include any amendment made for reasons relating to the statutory requirements for patentability, and places an absolute bar against application of the doctrine of equivalents when prosecution history estoppel exists. There is no requirement that an amendment bear on a prior art issue for prosecution history estoppel to apply. Rather, amendments made in relation to clarity or enablement under § 112 now will create prosecution history estoppel. Once prosecution history estoppel is invoked, there is no range of equivalents available to the patentee.

In general, the job of the patent prosecutor is to arm the litigator or licensing attorney with as many options as possible. The prosecutor serves that goal by preserving as much claim scope as possible, and avoiding remarks or amendments that may limit that scope. In other words, the end objective is a clean record that is free from estoppel, and a set of broad claims supported by the record. At the same time, the patent prosecutor must balance cost, time, and progress toward patent issuance. *Festo* seems to make amendments, however, a prosecutorial sin. The resulting fear of amendments seems likely to drive up cost, prolong pendency, and discourage cooperation between prosecutors and examiners.

### **PTO Gridlock?**

In the past, prosecutors generally were free to amend the claims for improved clarity without the fear of prosecution history estoppel. It was widely perceived that amendments entered merely for better readability or understanding did not substantially relate to any prior art issue, and therefore did not give rise to prosecution history estoppel. If an examiner issued a rejection for lack of clarity or indefiniteness under § 112, ¶2, many prosecutors might have chosen to appease him so long as meaningful claim scope was not sacrificed.

In the wake of *Festo*, however, the prosecutor no longer has the luxury of indulging the examiner’s quest for clarity. Instead, to avoid the prosecution history estoppel that comes

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<sup>1</sup> *Festo Corp. v. Shoketsu KinzokyuKogyo Kabushiki Co. Ltd.*, No. 95-1066 (Fed. Cir. Nov. 29, 2000) (en banc). For a detailed account of the *Festo* decision, see [Federal Circuit Adopts ‘Absolute Bar’ in Festo Case](#),” Sandonato and Barons Bauerle.

with any amendment relating to a statutory requirement for patentability, it seems that the prosecutor must fight the examiner on the point of clarity. Of course, this also means that prosecutors must take greater care to ensure that the claims, as originally drafted and filed, will not raise clarity concerns under § 112, ¶2. Although many examiners will understand the new pressures exerted by *Festo*, prosecutor-examiner interaction could become more adversarial, even on seemingly minor issues.

Prosecutors will be even less inclined to side with the examiner's view of the prior art or claim interpretation. As observed by Judge Michel in his *Festo* concurrence, patent prosecution is an iterative process. Unfortunately, prosecution now may involve more iterations and less progress in each exchange between the prosecutor and the examiner. Now, for every true "Amendment," a prosecutor may file two "Requests for Reconsideration" and a Request for Continued Examination, slowing progress toward allowance to a crawl. Prosecutors simply will be very reluctant to give any ground in the form of an amendment.

This surge in prosecution maneuvering could be a real drain on efficiency for prosecutors, and make the examiners' lives miserable, too. The Supervisory Patent Examiners (SPE's), in particular, should expect to be called upon more often to resolve prosecutor-examiner stand-offs. Moreover, the impact of the *Festo* decision comes at a time when the appeal process is already shockingly protracted, with a decision sometimes requiring more than five years from the filing of the prosecutor's appeal brief. Without a viable appeal process to resolve disputes, prosecutor-examiner interaction could become more heated.

## **New Tactics**

So, what can prosecutors do to preserve the value of their clients' inventions, while preventing them from withering on the vine at the PTO? In other words, what practice tips have emerged for obtaining prompt patent protection without suffering the bite of *Festo*, and without unduly antagonizing the examiner? The following is a laundry list of proposed anti-*Festo* tactics heard over lunch or via email from a variety of sources, with brief commentary on pros and cons. They range from the conservative to the wacky, and certainly carry no guarantee of success, but they demonstrate the lengths to which some prosecutors may go to avoid amendment.

### **Narrow Claims**

One proposal for avoiding prosecution history estoppel is to mitigate against the necessity of claim amendments in the first place by filing more narrowly focused claims with the original application. Rather than "claiming the world" in a generic claim, some prosecutors now suggest targeting a number of alternative embodiments with relatively narrow independent claims. The advantage of this approach is that the examiner may be less likely to formulate a rejection against the narrower claims, permitting the prosecutor to obtain allowable claims without the need for amendment. Even if some of the claims are rejected, the prosecutor may take the other claims and run, free of estoppel.

Unfortunately, this strategy overlooks the fact that most examiners are programmed to reject claims, and that first-action allowances are very rare. Even if the examiner's rejection is off-base, he usually is not inclined to withdraw it unless there is some concession (usually an amendment) by the prosecutor. As a result, the real chance of emerging unscathed with commercially meaningful coverage is not that great.

### **Hierarchy of Independent Claims**

This tactic also involves the filing of a number of different independent claims. The independent claims may vary from broad to narrow, however, and may include a generic claim. In theory, the Examiner will allow some claims and reject others, permitting the prosecutor to either argue against the rejections or eventually cancel the rejected claims. In this manner, the Examiner may allow some of the independent claims without the need for amendment. Also, this approach avoids the need to rewrite dependent claims in independent form. Instead, they would be drafted as independent claims from the beginning.

The problem with this approach is the unknown impact of *Festo* when claims are canceled. In particular, if the prosecutor gives up claim scope by canceling broader, independent claims, it is unclear whether an estoppel would be raised against the remaining claims to the extent they merely define incremental limitations over the canceled claims. The question is whether a court will see through the mechanics of this approach, and find an estoppel based on what was given up in the canceled claims. Many prosecutors have used this approach to a limited degree prior to *Festo*, and are likely to experiment with it.

### **Multiple Parallel Applications**

In simultaneously filing multiple applications for common subject matter, some prosecutors may seek to prevent the spread of prosecution history estoppel. If one application initially claims the invention very broadly, for example, but requires amendments to obtain allowance, the theory is that the resulting estoppel will not be visited upon the other applications. This assumes that the applications are not legally linked to one another by a claim of priority. If this approach works, the expense of another filing may pay dividends in preserving the availability of the doctrine equivalents.

This strategy is an effort to "seal off" applications claiming the invention narrowly from applications claiming the invention more broadly. The hope is that the narrower claims may require no amendments and emerge from the PTO with a viable range of equivalents. As a practical matter, challengers will argue that the claims stemming from each application should be treated similarly under the doctrine of equivalents. Also, double patenting issues may arise. Legally, however, it seems that this approach may avoid a direct blow from the *Festo* doctrine.

### **Characterizing Remarks**

Some prosecutors are beginning to advocate a practice contrary to their instincts—distinguish the claim limitations in the record. Most prosecutors have been trained to say as little as possible, and point only to the verbatim terminology set forth in the claims for differentiation over the prior art. The reward is a clean file wrapper with claims that “speak for themselves.” Now, in the wake of *Festo*, claims that speak for themselves can be a liability if amended, triggering the absolute bar to the doctrine of equivalents.

This counter-intuitive tactic would involve characterizing claim limitations to define differences over the prior art, without actually amending the limitations to indicate those differences. When presented with remarks that limit or qualify claim terms, most examiners will require that the prosecutor add the limitations and qualifications to the claim in the form of an amendment. Another problem with this approach is that the prosecutor will clearly create argument-based prosecution history estoppel, which can be just as detrimental as amendment-based prosecution history estoppel.

It is not entirely clear, however, whether argument-based prosecution history estoppel is subject to the absolute bar or the “flexible bar,” which would involve consideration of the subject matter actually given up by the applicant in the remarks. Still, based on the *Festo* opinion, it seems that the Federal Circuit, at its first opportunity, will make the absolute bar a universal standard for both amendment- and argument-based estoppel. In the meantime, the argument-based brand of estoppel could be less lethal.

### **Ensure Clarity**

*Festo* makes clear that any amendment relating to a statutory requirement for patentability, including clarity under § 112, ¶2, triggers the absolute bar. The standard for issuance of clarity/definiteness arguments under § 112, ¶2, varies widely among PTO examiners. Therefore, to avoid a rejection, it may pay to draft your claims according to the lowest common denominator of clarity. Painfully, this may require drafting claims to include all of the “connecting” language emphasized in your PTO bar review course. If those inter-relational limitations can be added without unduly limiting the claim, however, it may be easier to avoid prosecution history estoppel based on amendments.

### **New Claim Sets**

Another attempt at avoiding prosecution history estoppel is the submission of new claims instead of amendments. This approach may strike some as a form-over-substance exercise. Technically, however, the new claim is not an amended claim. One situation in which this technique may apply is when the examiner deems a dependent claim to be allowable. The prosecutor could amend the dependent claim to include the limitations of the independent claim, and any intervening claims, or amend the independent claim to include the features of the allowed claim.

Unfortunately, in each case, the prosecutor would still be entering an amendment that creates the risk of prosecution history estoppel and the absolute bar. In the opinion of

many prosecutors, a dependent claim that is merely rewritten in independent claim should not be treated as an amendment giving rise to prosecution history estoppel. However, the application of *Festo* to this situation is unclear. By submitting a new claim that includes the identical features, rather than amending existing claims, some prosecutors believe there is a possibility of avoiding *Festo*. Until the Federal Circuit has more to say, this approach may be worthwhile, but perhaps desperate.

### **Know the Prior Art**

The key to avoiding amendments is avoiding rejections. With better knowledge of the prior art, the prosecutor stands a better chance of drafting claims around it. In this way, the prosecutor may reduce the chances of a rejection, albeit minimally. Indeed, as mentioned above, examiners rarely let an application pass to issue without a rejection, no matter how carefully the claims were drafted over the prior art. In order to draft narrower claims as mentioned above, a better knowledge of the prior art is necessary. Knowledge of the prior art is good practice anyway, making it advisable for prosecutors and clients to become more familiar with the prior art before filing.

### **Varied Terminology**

Some prosecutors advocate the use of different terms in a single case to mean the same thing. They believe that these weasel words may be treated differently by the examiner, creating more latitude in a later enforcement action. If one of the terms is subject to prosecution history estoppel, then perhaps another will survive intact. This approach seems misguided. It creates greater headaches for the prosecutor, the examiner, the litigators, and the courts and could create the kind of resentment expressed in *Festo* by Judge Plager (concurring) in condemning the “vague, sometimes almost incomprehensible, manner in which claims have been drafted.” Litigators and judges are usually sharp enough to see through a ruse like this one, but not always.

### **Examiner Interviews**

Interviews between the prosecutor and the examiner have long been important in making headway toward allowance. Through interviews, the prosecutor can make a point without necessarily seeing that point show up in the file wrapper later. Interviews may become more useful than ever, as a means to avoid amendments and extensive arguments that give rise to prosecution history estoppel. Also, they could become vital in cutting through the gridlock that *Festo* is likely to bring upon the PTO, and obtaining issuance before the client’s technology becomes obsolete.

### **Declarations**

With the absolute bar arising from amendments, some prosecutors may consider the filing of declarations. Rather than enter an amendment, prosecutors may choose to file Rule 132 declarations for issues ranging from secondary considerations to enablement and definiteness. Even though declarations are likely to support argument-based

estoppel, there is a possibility that they could avoid the absolute bar and preserve some range of equivalents.

## **Conclusion**

The *Festo* case awaits a decision on review by the Supreme Court, which may promulgate further refinements to the doctrine of equivalents standards. In the meantime, prosecutors must consider a new mode of practice in which amendments, even the most trivial, are a last resort. Whether post-*Festo* practice should involve any of the tactics above remains to be seen, but the impact of *Festo* will certainly be felt at the PTO in new applications and responses filed in the coming months.

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