



**Robinson Intellectual  
Property Law Office**

PMB 955  
21010 Southbank Street  
Potomac Falls, Virginia 20165

Voice: 571-434-6789  
Fax: 571-434-9499  
G4 Fax: 571-434-2916  
Email: [info@riplo.com](mailto:info@riplo.com)  
[www.riplo.com](http://www.riplo.com)

*Patent  
Prosecution  
Developments*

October 2003

**Festo Revisited - The Court  
of Appeals for the Federal  
Circuit Decides Festo on  
Remand from the Supreme  
Court**

**Festo Corporation v. Shoketsu Kinzoku  
Kogyo Kabushiki Co., Ltd.,  
(CAFC, decided September 26, 2003)**

On September 26, 2003, the Court of Appeals for the Federal Circuit decided Festo on remand from the U.S. Supreme Court. In substantively holding that Festo cannot rely on the Doctrine of Equivalents and remanding to the District Court for further proceedings, the Federal Circuit summarized its understanding of the current state of the Doctrine of Equivalents in light of the Supreme Court's holding. The CAFC stated:

Before addressing the four issues briefed by the parties, we first take this opportunity to tie up the loose ends concerning our now-vacated holdings on the subject of prosecution history estoppel. Although, as a technical matter, our earlier en banc decision was vacated and we are free to revisit our prior conclusions, we reinstate those holdings of Festo VI that were not disturbed by the Supreme Court. To begin with, we recognize that the Court expressly endorsed our holding that a narrowing amendment made to comply with any provision of the Patent Act, including § 112, may invoke an estoppel.

We next reinstate our holding that a "voluntary" amendment may give rise to prosecution history estoppel. That separate holding was not considered, and certainly was not rejected, by the Supreme Court. Moreover, it is consistent with the Court's remand, and its reinstatement confirms what we have already determined by an overwhelming 11-1 majority.

In addition, we clarify that the Supreme Court's Warner-Jenkinson presumption, which treats a narrowing amendment as having been made for a "substantial reason related to patentability" when the record does not reveal the reason for the amendment, remains intact after the Court's Festo decision, although the consequences of failing to overcome that presumption have been altered. In Festo VI, we held that such an "unexplained" amendment completely estops a patentee from relying on the doctrine of equivalents for the narrowed claim limitation. Although the Supreme Court rejected that "complete bar" approach, it confirmed that a patentee's failure to overcome the Warner-Jenkinson presumption gives rise to the new Festo presumption of surrender. A patentee is now entitled to rebut the presumption that an "unexplained" narrowing amendment surrendered the entire territory between the original and the amended claim limitations.