

Summary of the U.S. Supreme Court's Decision Regarding Festo v. SMC

The Supreme Court issued its long awaited decision on May 28, 2002. In a unanimous decision by Justice Kennedy, the Court vacated the test for the doctrine of equivalents established by the Federal Circuit and set forth a new test to be applied in future cases. This new test was suggested by the Government in its amicus brief. Festo vigorously opposed the Government's new test at oral argument. The Court concluded its decision with the comment that SMC "may well prevail" under this new test. As you may know, Oblon, Spivak represented SMC before the Supreme Court and in prior proceedings before the Federal Circuit and the Boston district court.

In short, the Court declined to adopt the Federal Circuit's "absolute bar" but, instead, adopted the Government's suggested "presumption of an absolute bar." As held by the Court (at 15), "we hold here that the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question. This is the approach advocated by the United States, see Brief for United States as Amicus Curiae 22-28, and we regard it to be sound."

The Court held that the burden is on the patentee if he desires protection under the doctrine of equivalents for an amended element to show that for some reason he could not have drafted a claim which would have been broad enough to literally cover the accused equivalent. As held by the Court (at 16), "[t]he patentee must show that at the time of the amendment 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 further held in this regard that, if the original claim literally covered the accused device, the patentee cannot argue that he could not draft a claim to cover the accused device. As held by the Court (at 9), "[w]here the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question."

The Court concluded its decision with the comment that SMC "may well prevail" under this new test. As held by the Court (at 17) - "While estoppel does not effect a complete bar, the question remains whether petitioner can demonstrate that the narrowing amendments did not surrender the particular equivalents at issue. On these questions, respondents may well prevail, for the sealing rings and the composition of the sleeve both were noted expressly in the prosecution history."

Please contact us if you have questions.

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