ESSAY

Festering Questions After *Festo*

Harold C. Wegner*

OVERVIEW

Festo! The more than ten year old patent law nightmare continued on February 6, 2003, where a thirteen member en banc Federal Circuit Court heard yet another argument, this time in the wake of the Supreme Court reversal of the court.[1] The

* Former Director of the Intellectual Property Law Program and Professor of Law, George Washington University Law School; Partner, Foley & Lardner (Washington, D.C.). The views expressed herein are strictly those of the author. Email: halwegner@hotmail.com.

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[1] Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 304 F.3d 1289 (Fed. Cir. 2002) (en banc), *vacated by* 535 U.S. 722 (2002). The *Festo* saga dates back to 1992, when the holder of two patents relating to magnetic rodless cylinders sued a competitor for infringement. *See* 535 U.S. at 728 (discussing the suit's basis). Following a finding by Special Master Herbert F. Schwartz, the U.S. District Court for the District of Massachusetts in 1994 found in Festo's favor. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 88-CV-1814, 1994 WL 1743984 (D. Mass. Feb. 3, 1994), *aff'd*, 72 F.3d 857 (Fed. Cir. 1995), *vacated by* 520 U.S. 1111 (1997). The Federal Circuit affirmed. 72 F.3d at 857. However, in light of *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997), the Supreme Court vacated and remanded. 520 U.S. at 1111. A Federal Circuit panel then issued an order asking for further briefing confined to the issues raised by *Warner-Jenkinson*, 117 F.3d 1385, 1386 (Fed. Cir. 1997), which was followed by a panel opinion on the merits. 172 F.3d 1361 (Fed. Cir. 1999). This second panel opinion on the merits was then vacated by an en banc order for briefing several

disagreement among members of the Federal Circuit over the issue of equivalents[2] may provide a new form of what Justice Stevens referred to as the "occasional conflict," that "identif[ies] questions that merit th[e] Court's attention"[3] for further review.

After a major Supreme Court pronouncement like *Festo*, the Courts of Appeal normally allow a wide variety of factual patterns and decisions to percolate up from the trial level. The appeals courts also typically remand cases that were decided in the time between the trial court judgment and the Supreme Court opinion. Indeed, the Court of Appeals for the Federal Circuit initially took this approach in the aftermath of the Supreme Court's *Festo* opinion.[4] Yet, in what is only the latest in a series of unexpected events from Madison Place, the Federal Circuit Court of Appeals ordered *further* consideration by the court, again en banc, of a set of questions, some general.[5] The answers to these questions apparently will provide guidance to the patent community beyond the circumstances of the case and possibly will be "holdings" in the same sense as the en banc dicta most notoriously spawned in

questions. 187 F.3d 1381 (Fed. Cir. 1999). This led to the Federal Circuit's notorious 2000 opinion, 234 F.3d 558 (2000) (en banc), which in turn paved the way for the 2002 Supreme Court opinion. *See* 522 U.S. at 726–28 (chronicling the case's procedural history).

[2] In patent law, the doctrine of equivalents refers to a "judicial created theory for finding patent infringement when the accused process or product falls outside the literal scope of the patent claims. The doctrine evolved to prevent parties from evading liability for patent infringement by making trivial changes to avoid the literal language of the patent claims." BLACK'S LAW DICTIONARY 496 (7th ed. 1999).

[3] Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 839 (2002) (Stevens, J., concurring) ("An occasional conflict in decisions may be useful in identifying questions that merit this Court's attention.").

[4] *See, e.g.*, Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1350 (Fed. Cir. 2002). In *Allen Engineering,* the first precedential opinion squarely confronting the court with *Festo*-based questions, the Federal Circuit followed the practice that would be the norm for any other appeals court: it remanded the case for an initial determination by the trial court. *Id.* at 1342. The Federal Circuit instructed the trial court to consider whether any of the amendments and arguments gave rise to prosecution history estoppel, limiting resort to the doctrine of equivalents. *Id.* at 1350. In its instruction, *Allen Engineering* cited *Festo*'s holding that "a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel." *Id.* at 1350 (quoting *Festo*, 535 U.S. at 736). *See also id.* at 1349–50 (providing additional guidance on this issue).

[5] *Festo*, 304 F.3d 1289 (Fed. Cir. 2002) (en banc) (order).

the *Kingsdown* case.[6] This is conceivable considering this particular Court of Appeals' unique view that general guiding statements, extending beyond the facts needed to resolve a case, should be broadly used as more than mere dicta.[7] This en banc dictum approach was squarely criticized by Judge Michel, a senior member of the Court of Appeals, and has clearly led the Federal Circuit down a unique path.[8] Ultimately, the Federal Circuit of the 1990s became a court of extreme judicial activism, culminating in the 2000 *Festo* opinion.

This paper addresses unresolved conflicts surrounding the issue of equivalents. Part I discusses the Supreme Court's 2002 *Festo* opinion, surveying what is left for future consideration. Part II examines perhaps the most significant patent law issue never formally considered by the Supreme Court—whether a judge or

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[6] Kingsdown Med. Consultants, Ltd. v. Hollister Inc., 863 F.2d 867 (Fed. Cir. 1988) (en banc in part). *See infra* Part IV for a more detailed discussion of this case.

[7] *See generally* Colloquium, *Panel Discussion on Intra-Circuit Conflicts*, 11 FED. CIR. B.J. 623 (2001). Judge Michel counseled caution in identifying the holding of a case:

> [I]t's always a mistake to read a single case and try to discern from that case what a given rule of law is. Almost always there are multiple cases dealing with the same rule of law. You might compare them to a constellation of stars. You have to look at the whole pattern, the whole constellation to discern the outer bounds and the real content of the rule.

Id. at 630. Judge Gajarsa also suggested "a working partial definition of the word 'holding'": *Id.* at 631. He advised the following:

> It has to include what the court actually decided. Very often what's cited as a conflict turns out to be a statement of a rule of law that's given in the background portion of the opinion before the panel decision even discusses what the contentions were between which its deciding. Seems to me that if it wasn't something that was presented to us for a decision, a choice among alternatives, it can't be part of the holding. Even though it's stated in black and white somewhere in the opinion. So to me that's not a holding and therefore can't be the subject of a true conflict.

Id. at 631–32.

[8] *See id.* at 645

> [W]e're bound by case law and by the Federal Rules of Appellate Procedure to use the en banc process to choose between the holdings of truly conflicting cases and declare which will be the law. But it is not an appropriate use of the en banc process to just give guidance or to 'clarify.' It's a conflict resolution mechanism, period. So it's asking too much of the en banc process to buff and refine every little part of the law. The panels can do that and they should do that.

Id. (statement of Judge Michel).

jury should determine the overall application of the doctrine of equivalents. Part III questions the propriety of creating en banc dicta to cover a variety of situations, the decision-making mode unique to the Federal Circuit. Part IV focuses on an extreme example of the Federal Circuit's approach—the notorious en banc *Kingsdown* footnote. Lastly, Part V discusses how the criticism the 2000 *Festo* opinion received, both in the Supreme Court and in interested industry circles, may serve as a partial antidote to the Federal Circuit's trend of extreme judicial activism and lead the Court of Appeals back into its more traditional roles.

I. ENTRAILS OF THE SUPREME COURT *FESTO* DECISION

The Supreme Court's 2002 *Festo opinion* clearly and sharply rebuked the majority's earlier departure from precedent on the doctrine of equivalents.[9] The practical impact on daily case management, however, was extremely minor because few cases could fit within the narrow exceptions of the disputable presumptions it created.[10] This is, however, the way incremental changes are created through the certiorari process—by presenting narrowly defined questions coupled with minimal options available to the Court.

Festo's remnant principles are no substitute for the finely tuned equitable doctrine so meticulously crafted by Joseph Story and his successors in the more than 180 year period before this case.[11] What remains is a clear resolution for most cases that never should have applied the doctrine of equivalents under any tests, pre- or post-*Festo*. Now the door is closed, as it would have been under the Story line of case law and should have been if trial cases were handled rigorously by judges with a keen patent law background. Yet, as in the days of Story and the subsequent 180-plus years,

[9] *See Festo*, 535 U.S. at 739 ("The Court of Appeals ignored the guidance of *Warner-Jenkinson*, which instructed that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community.") (citing Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 28 (1997)).

[10] *See id.*

[11] *See* Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1516–18 (Fed. Cir. 1995) (chronicling the development of the doctrine of equivalents), *rev'd*, 520 U.S. at 17.

there are egregious cases of copying inventions where equity demands a finding of infringement. The doctrine of equivalents was crafted for these exceptional cases.

The majority opinion in *Festo* undoubtedly fails to represent a fair solution to the long-term problem of patent infringement. First and foremost, second-language foreign applicants are immediately subject to discrimination. Anyone with knowledge of a second language knows there is rarely, if ever, a perfect correspondence between words in different languages that describe the same thing. Yet, if French, Chinese, German, or Japanese applicants take advantage of the Paris Convention, by first filing in their home country and native language,[12] there surely will be *some* differences in the English translations that become the ultimate text of U.S. patent claims.

It was already suggested that an estoppel might arise if a claim's scope is narrowed due to a simple translation error that is later corrected.[13] A typical high technological application may not even have established dictionary meanings and may contain over 200 words susceptible to varying interpretations. Surely one or more application will have an English term that provides a narrower meaning than the French, Chinese, German, or Japanese text. Whether this provides a basis for prosecution history estoppel must be determined. Further issues arise regarding whether such estoppel should only occur when the translated term is introduced

[12] The Paris Convention permits an applicant to file an application in foreign countries within a specified period from its home country's filing date and still obtain the benefits of the domestic filing date for priority purposes and for prior art purposes. Convention of Paris for the Protection of Industrial Property, Mar. 20, 1883 (as revised July 14, 1967), 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

[13] The Supreme Court's 2002 *Festo* opinion raised this possibility when it held that a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel. *See* Festo, 535 U.S. at 736. According to the Court:

> Estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope. If a [35 U.S.C.] § 112 amendment is truly cosmetic, then it would not narrow the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope—even if only for the purpose of better description—estoppel may apply.

Id. at 736–37.

after filing in the U.S.,[14] or whether it may also apply when the English term is simply narrower than the original French, Chinese, German, or Japanese text from the parent application.[15] It is essential to clarify whether *Festo* therefore implicates that such foreign language applicants face a blanket bar to use of the doctrine of equivalents based solely on their sin of filing first in their native language.

II. REOPENING THE EQUITY DOOR

It was not for ordinary cases that the doctrine of equivalents was first crafted by Joseph Story over 180 years ago. Rather, it exists for exceptional cases of unscrupulous takings of an invention through word games. Brilliant patent jurists of Justice Story's caliber would see the need for equivalents only in such situations.[16]

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[14] *See Festo*, 535 U.S. at 736 ("The PTO might require the applicant . . . to improve the translation of a foreign word . . . In th[is] case[ ] the applicant has no intention of surrendering subject matter and should not be estopped from challenging equivalent devices. While this may be true in some cases, petitioner's argument conflates the patentee's reason for making the amendment with the impact the amendment has on the subject matter.").

[15] *See* Masco Corp. v. United States, 303 F.3d 1316, 1324 (Fed. Cir. 2002) ("The prosecution history of a parent application may be considered in construing claim terms." (citing Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 980 (Fed. Cir. 1999))). *See also id.* ("When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation." (quoting *Elkay*, 192 F.3d at 980)); Mark I Mktg. Corp. v. R.R. Donnelley & Sons Co., 66 F.3d 285, 291 (Fed. Cir. 1995) (holding that, for estoppel purposes, the relevant prosecution history included not only the application upon which the patent issued but also the parent and grandparent applications); Jonsson v. The Stanley Works, 903 F.2d 812, 818 (Fed. Cir. 1990). The holding in each of these cases dealt with use of a parent American prosecution history and not a foreign prosecution history in the case of a Paris Convention priority reliance.

[16] Like the modern day generalist judges from Wilmington and the Alexandria division of the Eastern District of Virginia, the best patent trial judges are those from courts of general jurisdiction who only hear a minority of cases involving patents, but a sufficient number to develop an experience base of true experts in the field. Story's major contributions to patent law were not achieved by sitting on occasion in Washington, D.C., with the odd patent appeal, but rather by his more usual position as a trial judge as circuit justice for the numerous patent cases heard in Boston. *See Biographical Notice of Mr.*

The *Festo* majority's mechanistic test, however, leaves no room for a Story or modern judge to reach a finding of equivalents where it is essential for an equitable solution.[17] The failure of the majority view is immediately implied from the en banc order of September 20, 2002[18] that reopened *Festo* to yet *another* en banc hearing on two additional questions. Its first question reexamines whether the doctrine of equivalents is an *equitable* doctrine that a judge, without a jury, can and should decide.[19]

The determination of equivalents, notwithstanding prosecution history estoppel, should be decided in a consistent manner with equivalents in general. In dictum from en banc in *Hilton Davis*,[20] a case from nearly a decade ago that spawned the current *Festo* controversy, the instant Court of Appeals had already issued a "holding" on "the issue of infringement under the doctrine of equivalents [as] an equitable remedy to be decided by the court,

Justice Story, 3 AM. WHIG REV. 68 (1846), http://cdl.library.cornell.edu/cgi-bin/moa/sgml/moa-idx?notisid=ABL5306-0003-10.

[17] The Federal Circuit's en banc order states that the "Court differed with this court on the scope of equivalents available following a narrowing amendment. Whereas we had held that any narrowing amendment made for reasons related to patentability effects a complete bar to the doctrine of equivalents for the amended claim element, the Court held that a narrowing amendment instead raises a rebuttable presumption that the complete bar applies . . . ." *Festo*, 304 F.3d at 1290 (citation omitted) (explaining the Supreme Court's position that under certain circumstances "the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence" if the patentee can 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," such as when the equivalent was unforeseeable at the time of application, when the rationale underlying the amendment bears "no more than a tangential relation to the equivalent in question," or when there is "some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question" (quoting Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 735 U.S. 722, 740 (2002))).

[18] *Festo*, 304 F.3d at 1289.

[19] The first question posed by the Federal Circuit for review by its new en banc order was "[w]hether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption." *Id.* at 1290. See *infra* Part III for discussion of the second question raised.

[20] Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1516 (Fed. Cir. 1995) (en banc) (per curiam), *rev'd*, 520 U.S. 17 (1997).

or . . . issue of fact to be submitted to the jury in a jury case."[21] The approach advanced nearly a decade ago by the Court of Appeals' leading academic scholar who specialized in equity, S. Jay Plager, was rejected.[22] When leading bar organizations addressed the issue as amici curiae a decade ago in *Hilton Davis*, several could not reach a consensus and refrained from stating a position.[23] One said that determining whether equivalents should be determined as a matter of law or equity

> can be reliably understood in the context of a policy choice involving substantive justice and notice. In the end, which resolution is appropriate will flow from the relative values that the Court places on each. In addition, whether the Court is willing to adopt a highly individualized rule regarding equivalents will depend, in large part, on how the Court sees the need to provide legal rules that are definite.[24]

The American Bar Association noted that the Court has considered equivalents determination in the context of equity.[25] Nonetheless, it became "deeply divided" on what it said was "a close question."[26] Divided, the Bar's blue ribbon team opined that "there are a number of policy reasons favoring district court judges, not juries, exercising their judicial discretion in

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[21] *Hilton Davis Chem.*, 62 F.3d at 1516.

[22] *Id.* at 1536–45 (Plager, J., dissenting). Judge Plager makes the most compelling case for equity as the answer in the third section of his dissent. *See id.*, 62 F.3d at 1539–45 (Plager, J., dissenting).

[23] *See* Brief of Amicus Curiae Federal Circuit Bar Association, *Hilton Davis Chem.*, 62 F.3d at 1512, *reprinted in* 3 FED. CIR. B.J. 345, 356 (1993); Brief of Amicus Curiae American Bar Association, *Hilton Davis Chem.*, 62 F.3d at 1512, *reprinted in* 3 FED. CIR. B.J. 375, 375 (1993).

[24] Brief of Amicus Curiae Federal Circuit Bar Association, *supra* note 23, at 356.

[25] Brief of Amicus Curiae American Bar Association, *supra* note 23, at 383–84 (citing Sanitary Refrigerator Co. v. Winters, 280 U.S. 30 (1929)). *But cf.* Burr v. Duryee, 68 U.S. 531, 573 (1863) (explaining the contrary nineteenth century approach which employed a narrow definition of "equivalent," rejecting the notion that "every combination of devices in a machine which is used to produce the same effect, is necessarily an equivalent for any other combination used for the same purpose," and stressing that the machines must have "the same combination of mechanical devices, or substantially the same" to be considered equivalent).

[26] Brief of Amicus Curiae American Bar Association, *supra* note 23, at 375.

determining infringement under the doctrine of equivalents. On the other hand the right to jury trial is important as well."[27]

To the extent the Court of Appeals seeks a final resolution of the issue of law versus equity, any decision on the matter would pave the way for such a determination by the Supreme Court.[28] The occasional conflict amongst panels and within an en banc court is healthy as it may help identify issues that merit the Court's attention.[29]

III. CLOUDING THE FUTURE WITH EN BANC DICTUM

The second question raised by the Court of Appeals for en banc briefing was again found in the series of general questions designed to provide guidance for cases not in controversy: "What factors are encompassed by the criteria set forth by the Supreme Court?"[30]

If a case like this were before any other Court of Appeals or before the Supreme Court, such a question that aims to provide broad guidance to solve future cases not in controversy would never be asked. A question as complex as this one, that falls under the doctrine of equivalents, can only be properly determined on a case by case basis as an equitable matter and is therefore not susceptible to iron-clad formulaic rules. Sufficient Supreme Court jurisprudence exists to apply to particular controversies and develop appropriate rulings on a case by case basis.[31] The

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[27] *Id.*

[28] *See, e.g.*, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558, 595 (Fed. Cir. 2000) (en banc), *vacated*, 535 U.S. 722 (2002); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 304 F.3d 1289 (Fed. Cir. 2002) (Plager, J., concurring) ("Today, the Court might well conclude that, since the so-called 'objective' approach has proven unworkable, a return to the equitable analysis approach would be the 'better view.' *Particularly would this be so if [the Federal Circuit] court led the way* . . . .") (emphasis added).

[29] *See, e.g.*, Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc., 535 U.S. 826, 839 (2002) (Stevens, J., concurring) ("An occasional conflict in decisions may be useful in identifying questions that merit this Court's attention.").

[30] *Festo*, 304 F.3d at 1290.

[31] *See generally* Conrad J. DeWitte, Jr., *Festo Change-O? No Way! Why the Supreme Court Should Reverse the Federal Circuit's Attack on the Doctrine of Equivalents*, 51

incremental determination of *holdings* necessary to resolve particular factual situations follows the time-honored manner for the evolution of case law.[32]

It is a staple principle of hornbook law that advisory opinions are outside the scope of authority of the courts of appeal.[33] Accordingly, the leading Wright & Miller treatise simply states that "[t]he oldest and most consistent thread in the federal law of justiciability is that federal courts will not give advisory opinions."[34] This has been honored by the Federal Circuit in areas outside patent law.[35] Why then should patent law be treated differently?

Making law through dictum is part of the larger puzzle of the "inconsistent application of the patent laws,"[36] and recalls the criticisms of Tramposch.[37] To craft new law that disregards

CATH. U. L. REV. 1323 (2002) (discussing Supreme Court jurisprudence related to patent infringement claims).

[32] *See supra* notes 7–8 and accompanying text.

[33] 13 CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE § 3529.1 (2d ed. 1984) (citing Flast v. Cohen, 392 U.S. 83, 96 (1968) (stating that "the oldest and most consistent thread in the federal law of justiciability is that the federal courts will not give advisory opinions" (quoting CHARLES ALAN WRIGHT, FEDERAL COURTS 34 (1963))).

[34] *Id.*

[35] *See, e.g.*, Arctic Corner, Inc. v. United States, 845 F.2d 999, 1000 (Fed. Cir. 1988) (concerning a government contract dispute) ("An actual case or controversy is a prerequisite to justiciability of [the] appeal. A court may and should raise the question of its jurisdiction *sua sponte* at any time it appears in doubt. At the heart of the 'case or controversy' requirement is the prohibition against advisory opinions.") (citations omitted).

[36] Matthew F. Weil & William C. Rooklidge, *Stare Un-Decisis: The Sometimes Rough Treatment of Precedent in Federal Circuit Decision-Making*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 791, 793–94 (1998) ("[T]he [c]ourt's treatment of its own precedent has become unpredictable. This unpredictability . . . will lead to exactly the opposite result that Congress sought in creating the [c]ourt. Indeed, the inconsistent application of the patent laws resulting from inter-circuit conflicts will be replaced by inconsistent application of the patent laws resulting from intra-circuit conflicts, and the fate of litigants will begin to hinge more upon the make-up of the panel deciding the case than on the principles and rules announced in prior opinions.").

[37] Albert G. Tramposch, *The Dilemma of Conflicting Precedent: Three Options in the Federal Circuit*, 17 AM. INTELL. PROP. L. ASS'N Q. J. 323, 328–29 (1989) (criticizing the Federal Circuit's practice of allowing the en banc court to address important, unsettled issues as undercutting the requirement that judicial law consist of holdings rather than dicta, and observing that the power to issue statements of law outside actual cases or controversies is reserved to the legislature).

precedent results in a "piecemeal" approach that "create[s] a patent law that is so complex that it requires litigation to determine the outcome for a given issue."[38] The Federal Circuit's record of choosing en banc (or any other precedential) consideration of issues unnecessary to the resolution of the particular case manifests what two commentators, one a vice president of the American Intellectual Property Law Association, termed "judicial hyperactivity"[39] and "hyperactive judging."[40]

The Federal Circuit has taken it upon itself—alone amongst all the Courts of Appeal—to provide what amounts to en banc advisory guidance, detached from the realities of an actual case or controversy.[41] Merely because the court has taken such liberties in the past[42] does not make the practice any more justifiable or any less contrary to that of the other courts of appeal.

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[38] Ronald D. Hantman, *Why Not the Statute? Revisited*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 685, 714 (2001).

> [T]he Federal Circuit, by not following precedent, is creating the law piecemeal without regard to how the pieces fit together. Furthermore, their decisions often lack sufficient thought as to the long-term effects. Probably, worst of all, they have created a patent law that is so complex that it requires litigation to determine the outcome for a given issue.

Id.

[39] William C. Rooklidge & Matthew F. Weil, *Judicial Hyperactivity: The Federal Circuit's Discomfort with Its Appellate Role*, 15 BERKELEY TECH. L.J. 725, 726 (2000). (defining "judicial hyperactivity" as "a form of decision-making at odds with traditional notions of appellate review").

[40] *See id.* at 729–30

> The familiarity and expertise of the Federal Circuit judges with issues common to the court's specialized jurisdiction may lead them more readily to usurp the fact-finding role. Almost since its inception, the Federal Circuit has been dogged with criticism for straying from the path carefully delineated for appellate tribunals. Disappointed litigants and commentators alike have criticized the court for fact-finding and other forms of hyperactive judging. Increasingly, the bar is expressing concern over the court's decision-making procedures and its apparent willingness to take over the roles of patent examiner, advocate and trier of fact.

Id.

[41] *See* MediaCom Corp. v. Rates Tech., Inc., 4 F. Supp. 2d 17, 22 (D. Mass. 1998) (observing that construing patent claims without regard to what terms are actually disputed by the parties may run afoul of the "case or controversy" requirement).

[42] *See infra* Part III.

IV. THE NOTORIOUS EN BANC "*KINGSDOWN* FOOTNOTE"

The two questions raised in the most recent *Festo* order will not be the last open-ended questions under the doctrine of equivalents. It is possible, if the past is prologue, that some of these questions could well be answered sua sponte through the "*Kingsdown* footnote" practice that originated with the *Kingsdown* case.[43] The opinion starts in an entirely uncontroversial manner as a precedential opinion from a three judge panel.[44] At its conclusion, however, the case explodes into a series of brief statements of conflicting panel positions, each with a bright line resolution and a new statement of law.[45] This final section in *Kingsdown* is preceded by a heading, Resolution of Conflicting Precedent, and a notorious footnote: "Because precedent may not be changed by a panel, this section has been considered and decided by an *in banc* court formed of MARKEY, Chief Judge, RICH, SMITH, NIES, NEWMAN, BISSELL, ARCHER, MAYER, and MICHEL, Circuit Judges."[46]

In resolving important conflicts, such as whether inequitable conduct is a question of law or equity, one could imagine a lengthy piece containing citation and analysis of conflicting scholarly views. Yet the court's resolution of this particular issue—in what is clearly an advisory opinion that never should be part of an appellate decision—consists of a mere three sentences.[47] The first

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[43] Kingsdown Med. Consultants, Ltd. v. Hollister Inc., 863 F.2d 867 (Fed. Cir. 1988) (en banc in part). *See also* Tramposch, *supra* note 37, at 328–29, 332–34 (discussing the *Kingsdown* approach of settling a conflict of precedent in an en banc addendum to a panel decision).

[44] *See Kingsdown*, 863 F.2d at 869–76. The panel portion of *Kingsdown* concerned an issue that it described as one of first impression: whether a patent is unenforceable where an attorney incorrectly represented a claim in a continuation application as having been allowed in the parent. *See id.* at 869–72. The panel held that the circumstances of the case did not warrant a finding that the prosecuting attorney intended to deceive the Patent Office regarding the status of the claim in the parent application. *See id.* at 872–76.

[45] *See id.* at 876–77.

[46] *Id.* at 876 & n.16 (citing S. Corp. v. United States, 690 F.2d 1368, 1370 n.2 (Fed. Cir. 1982) (en banc)).

[47] *See id.* at 876 (falling under the section entitled Nature of Question).

two sentences identify the conflict,[48] and the remainder of the section is a single sentence of less than twenty-five words, devoid of any hint of why the decision was reached.[49]

The *Kingsdown* practice of tacking on an en banc addendum to an opinion to create a bright-line test in several areas of the law—all without the benefit of even a single citation to a practitioner's, scholar's, or anyone's comment[50]—has been followed by the court rather than condemned.[51] If anything, the court has been proud of its high rate of en banc decision-making.[52]

Glenn L. Archer, Jr., a member of the en banc *Kingsdown* court and later Chief Judge of the court, speaking in that capacity, cited *Kingsdown* as having "made an important contribution to decision-making in the inequitable conduct area."[53] Entirely forgotten was the fact that the case was heard and decided before a three judge panel and that the important points were only "en banc" by virtue

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[48] *Id.* ("Some of our opinions have indicated that whether inequitable conduct occurred is a question of law. In [another opinion], the court indicated that the inequitable conduct question is equitable in nature.") (citations omitted).

[49] *Id.* ("We adopt the latter view, i.e., that the ultimate question of whether inequitable conduct occurred is equitable in nature.").

[50] Like *Kingsdown* before it, there is not one single citation to a practitioner or scholar or any other source other than decisions of the various courts as basis for the en banc decision. *See id.* at 876–77; Tramposch, *supra* note 37.

[51] *See, e.g.*, Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 1068 n.5 (Fed. Cir. 1998) ("Because precedent may not be changed by a panel, the issue of 'choice of circuit' law . . . has been considered and decided unanimously by an *in banc* court consisting of MAYER, Chief Judge, RICH, NEWMAN, MICHEL, PLAGER, LOURIE, CLEVENGER, RADER, SCHALL, BRYSON, and GAJARSA, Circuit Judges.") (citations omitted); *see also* Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1359 n.* (Fed. Cir. 1999) (en banc in part) ("Because a panel of this court lacks the authority to overrule one of the court's precedents, we are acting en banc with respect to the resolution of the choice of law issue. Accordingly, Chief Judge Mayer, Circuit Judge Rich, Senior Circuit Judge Smith, and Circuit Judges Newman, Michel, Plager, Lourie, Clevenger, Rader, Schall, Bryson, and Gajarsa join in . . . this opinion, which resolves the choice of law issue.").

[52] Glenn L. Archer, Jr., *Conflicts and the Federal Circuit*, 29 J. MARSHALL L. REV. 835, 837 (1996) ("[S]ince its creation, the Federal Circuit has decided fifty-eight cases *in banc*. In the very recent past, we finished up with ten *in banc* cases, more than have been decided in any other similar period in the court's history. In spite of the extra burden on the court, *in banc* activity is extremely important to the development of the court's body of law—it usually adds clarity and predictability to the law.").

[53] *Id.*

of the *Kingsdown* footnote.[54] Despite the obvious *lack* of clarity that is provided with a simple, one paragraph standard of law declaration (there is no careful recitation of any pros and cons or citation of competing authority as in *Kingsdown*[55]), the court has shown complete disregard for this obvious shortcoming in its self-evaluation of *Kingsdown*.[56]

Kingsdown was a classic example from the early years of the Court of Appeals during which it sought to break down complex issues into black and white rules and "the court tried to lay out some bright line tests."[57] Fourteen years after *Kingsdown*, the Court of Appeals has yet to come up with a uniform method of citing to a case where part of the opinion is en banc and part of it is not. Sometimes, cases are referred to *without* reference to the case having been decided en banc, presumably referring to precedential portions of the opinion prior to the *Kingsdown* footnote.[58] The more typical way to cite the en banc portion of the opinion is to simply refer to the opinion as being "en banc" (or, in earlier cases,

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[54] *Id.* at 837 n.8 (citing *Kingsdown* only as "863 F.2d 867 (Fed. Cir. 1988) (in banc)"). No reference is made to indicate that only a portion of the opinion is en banc. *See id.*

[55] *Kingsdown*, 863 F.2d at 876 (citing conflicting case law on the issue of whether or not a finding of gross negligence compels a finding of intent to deceive and then simply adopting one view as the standard of law).

[56] Archer, *supra* note 52. ("[I]n banc activity is extremely important to the development of the court's body of law—it usually adds clarity and predictability to the law. Obviously, this was true in cases such as *Kingsdown Medical Consultants v. Hollister, Inc.* . . . .").

[57] Vito DiPietro, *The Tenth Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, 146 F.R.D. 205, 370 (1992) ("Beginning with the *Kingsdown* case . . . there's a section of that opinion entitled 'Resolution of Conflicting Precedent' which was decided by the court sitting *en banc* and in that section, the court tried to lay out some bright line tests. For example, it discarded the idea that a finding of gross negligence itself satisfied the intent threshold. It held that the ultimate issue of whether inequitable conduct occurred, is equitable in nature. Inequitable conduct is committed to the discretion of the trial judge and is reviewed by the Federal Circuit under an abuse of discretion standard. Lastly, when a court has determined that inequitable conduct occurred in relation to one or more claims during prosecution, the entire patent is rendered unenforceable.").

[58] *See, e.g.*, Abbott Labs. v. TorPharm, Inc., 300 F.3d 1367, 1379 (Fed. Cir. 2002) ("*See Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 872 (Fed. Cir.1988).") (parallel citation omitted); PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1247 (Fed. Cir. 2002) ("*See Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988)." (parallel citation omitted)). The pinpoint cites are to portions of the opinion prior to the *Kingsdown* footnote.

"in banc").[59] Judge Gajarsa introduced a better approach to citation of precedential case literature by referring to the opinion as being "en banc in relevant part."[60]

V. DEPARTURE FROM JUDICIAL ACTIVISM

Festo followed a period of judicial activism where a Federal Circuit panel often deliberately reshaped the law to fit the policy reasons it perceived important enough to override even statutes or years of case law.[61] This was sometimes achieved through pure dictum, totally unnecessary for the case.[62] In the year 2000, when

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[59] *See, e.g.*, Amgen Inc. v. Chugai Pharm. Co., 927 F.2d 1200, 1215 (Fed. Cir. 1991) ("[W]e review an ultimate conclusion of inequitable conduct under an abuse of discretion standard, *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 (Fed. Cir.1988) (in banc), *cert. denied,* 490 U.S. 1067, 109 S. Ct. 2068 (1989).") (parallel citations omitted).

[60] Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp., 267 F.3d 1370, 1379 (Fed. Cir. 2001) (defining the *Kingsdown* decision as being "en banc in relevant part") ("Inequitable conduct is an equitable issue committed to the discretion of the trial court and is, therefore, reviewed by this court under an abuse of discretion standard. *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 876 (Fed. Cir.1988) (en banc in relevant part).") (parallel citation omitted). There were several uses of this terminology in nonprecedential opinions, the first being in *Akron Polymer Container Corp. v. Exxel Container, Inc*., 69 F.3d 554 (Fed. Cir. 1995) (per curiam). Subsequent to *Brasseler*, this terminology was used in *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 744 (Fed. Cir. 2002). *See also* Allen Eng'g Corp. v. Bartell Industries, Inc., 299 F.3d 1336, 1344, 1351 (Fed. Cir. 2002).

[61] *See In re* Kathawala, 9 F.3d 942, 946 (Fed. Cir. 1993) (demonstrating that earlier cases included the reshaping of what is "prior art" for obviousness under what is now 35 U.S.C. § 103(a) (2000), where the court in panel opinions judicially expanded two clear novelty-only provisions into the state of the art). Most absurd was to change the *forfeiture* provision for late filing in the United States for an invention already *patented* by the same party in a foreign country into prior art via 35 U.S.C. § 102(d). *See Kathawala*, 9 F.3d at 946. Four years later, the originality requirement of 35 U.S.C. § 102(f) was transformed into prior art for obviousness. *See* OddzOn Prods., Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed. Cir. 1997).

[62] Most striking is the extension of 35 U.S.C. § 102(d) to the *state of the art* for *obviousness* under what is now 35 U.S.C. § 103(a). The court in *Kathawala* had already found the claims in question unpatentable because the *same invention* was claimed in an earlier granted Greek counterpart patent, thereby rendering moot and unnecessary a decision on the issue of whether a Spanish counterpart claiming a *different* invention rendered the invention unpatentable. *See Kathawala*, 9 F.3d at 945. Even though it was therefore unnecessary for the court to consider the additional foreign counterpart patents, the court went out of its way to do so and through dictum expanded the scope of *prior art*

Festo was decided by the Federal Circuit,[63] a well intentioned majority must have thought that, once and for all, its latest act of judicial activism would create a bright-line test that would clear the cobwebs from the patent infringement scene, effectively abolishing the doctrine of equivalents. The words of the late Giles Sutherland Rich go unheeded: "If the law as it has been written by Congress creates anomalous situations, then it is for Congress to decide whether to change the law."[64] Undoubtedly, there continues to be a narrow band of judicial activism that injects policy goals to change the law, including the controversial tinkering with the "written description" requirement[65] and the Hatch-Waxman Act.[66] Yet, the cold shower of the Supreme Court's back-to-back opinions in *Festo* and *Vornado* may have started to shift the equation on Madison Place to a more balanced role of this Court of Appeals as an interpreter and not creator of the law.

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for *obviousness*. *See id.* at 946. The extension of the law was based upon policy grounds. *See id.* at 947 ("It would be *contrary to the policy of the statute* to permit an applicant to file a foreign application on an invention that may be claimed by four related types of claims, obtain a grant of whatever patent rights were available in the foreign country, and then file an application in the United States, after the foreign patent has issued and more than one year after the foreign filing date on the same invention, with claims directed to those aspects of the invention which were unpatentable in the foreign country.") (emphasis added).

[63] Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000) (en banc), *vacated by* 535 U.S. 722 (2002).

[64] Studiengesellschaft Köhle mbH v. N. Petrochemical Co., 784 F.2d 351, 357 (Fed. Cir. 1986) (per curiam) (quoting Judge Giles from *In re* Hilmer, 424 F.2d 1108, 1113–14 n.6 (C.C.P.A. 1970)).

[65] *See* Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998) (reading into § 112 a requirement that a "written description" not be present for a generic claim that eliminates an original claim limitation); Regents of the Univ. of Cal. v. Eli Lilly & Co., 119 F.3d 1559 (Fed. Cir. 1997) (injecting a possession requirement into the "written description" requirement of 35 U.S.C. § 112). *See also* Harold C. Wegner, *When a Written Description Is Not a "Written Description": When* Enzo *Says It's Not*, 12 FED. CIR. BAR J. 271 (2002).

[66] *See* Allergan, Inc. v. Alcon Labs., Inc., No. 02-CV-1449, 2003 U.S. App. LEXIS 6003, at *72 (Fed. Cir. Mar. 28, 2003) (per curiam) (Linn, J., concurring) (criticizing Warner-Lambert Co. v. Apotex Corp., 316 F.3d 1348 (Fed. Cir. 2003), by stating that "[h]owever compelling [the *Warner-Lambert* policy] arguments may be, it is the function of Congress, not the courts, to shape legislation in accordance with policy goals"). Judge Schall, joined by Judge Clevenger, also issued a concurrence in *Allergan* critical of *Warner-Lambert*. *See id* at *36–*68 (Schall, J., concurring).

CONCLUSION

No matter what the Federal Circuit may do in the latest round of the *Festo* case, the damage created to the fabric of infringement law cannot be readily undone. At some point there must be a return to treating the doctrine of equivalents as a measure that is used only if demanded by the interests of equity and if carefully administered by a judge, not a jury. Necessary reforms may include legislation to achieve this goal[67] or reforming the reissue statute.[68]

[67] In the Pacific Patent Facilitation Act of 2003, discussion draft, version 3.1 (Mar. 28, 2003), a proposed 35 U.S.C. § 271(k) provision would provide that "[a] claim shall be infringed only if an accused embodiment is within the literal limits thereof, with the proviso that a court where the interests of equity demand may find an equivalent embodiment to be an infringement" (on file with author).

[68] Another section proposes consolidating reissue and reexamination into a single proceeding where broadened claims would be permitted at any time but subject to strict intervening rights. *See id.*