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¶1 In June of 2004, the Court of Appeals for the Federal Circuit (“CAFC”) held in *Honeywell v. Hamilton Sundstrand*¹ that the rewriting of a dependent claim in independent form, coupled with the cancellation of the original independent claim, was a narrowing amendment under the Supreme Court’s prior decision in *Festo Corp. v. Shoketsu Kinoku Kogyo Kabushiki Co.*² Under *Honeywell*, a patentee is presumptively barred from using the doctrine of equivalents for the additional element found in the original dependent claim.³ As rewriting dependent claims into independent form is currently a common practice,⁴ many patent practitioners will be upset by this decision. To the dismay of these practitioners, *Honeywell* was a correct interpretation of *Festo*. Unhappy practitioners who do not support the outcome of this case likely disagree with the *Festo* doctrine itself rather than the CAFC’s interpretation of it.⁵

¶2 Part I of this note, explains the doctrine of equivalents, prosecution history estoppel, and a couple of important cases in this area of the law. Part II, dissects and explains the *Honeywell* opinion. Part III, analyzes the majority and dissenting opinions. Finally, Part IV, considers the consequences of the *Honeywell* decision.

I. BACKGROUND

¶3 This section provides a brief history of the purposes and functions of the doctrine of equivalents and prosecution history estoppel, followed by a discussion of significant cases concerning the doctrine of equivalents.

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¹ *Honeywell Int’l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131 (Fed. Cir. 2004).

² *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) [hereinafter *Festo*].

³ *Honeywell*, 370 F.3d at 1134.

⁴ *Id.* at 1153.

⁵ Of course I do not claim that I can read minds. I only predict that many of these “unhappy practitioners” may realize by the end of this article that their animosity toward the *Honeywell* decision is misplaced.

A. Doctrine of Equivalents and Prosecution History Estoppel

¶4 A patent can be infringed either directly or by the doctrine of equivalents.⁶ The doctrine of equivalents exists to cover those insubstantial and unimportant changes individuals may make to try to design around a patent.⁷ The doctrine of equivalents also exists because it is widely accepted that language sometimes cannot fully express a claimed invention with complete precision.⁸ There is a trade-off for a patent system that includes a doctrine of equivalents, namely uncertainty when trying to design around a patent.⁹

¶5 The patent prosecution process creates a prosecution history, or “file-wrapper.”¹⁰ The prosecution history is a collection of documents stored at the U.S. Patent & Trademark Office (“USPTO”) including the patent application and communications by the patentee and the USPTO with respect to the application.¹¹ During patent litigation, the court uses this prosecution history to determine if any claims should be limited more than their natural language meaning suggests. One reason for this analysis is to prevent a patentee from arguing that a claim means one thing during prosecution, and then argue something completely different during litigation.¹² It appears unfair to allow a patent to issue based on limitations described by the patentee, and then allow the patent to be enforceable to its fullest extent as if those limitations were never needed for patenting.

¶6 The doctrine of prosecution history estoppel mandates that, when a claim is narrowed during prosecution, the patentee is barred from utilizing the doctrine of equivalents to expand a claim’s scope during litigation regarding the element that was narrowed during prosecution.¹³ This narrowing can be made in a number of ways, including by argument to the examiner during prosecution and by adding language to the claim that narrows its scope.¹⁴ One of the main purposes of prosecution history estoppel is to combat the uncertainty that exists in a patent system that includes a doctrine of equivalents.¹⁵

B. Significant Cases Before *Honeywell*

¶7 The two most significant prosecution history estoppel cases decided prior to *Honeywell* were *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.* and *Festo Corp. v. Shoketsu Kinoku Kogyo Kabushiki Co.* These cases set out the tests courts should use to

⁶ DONALD S. CHISUM, 5A-18 CHISUM ON PATENTS 18.04 (2004).

⁷ See *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950).

⁸ *Festo*, 535 U.S. at 731-32.

⁹ See *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997).

¹⁰ 5A-18 CHISUM, *supra* note 5, at 18.02[3].

¹¹ Arnold B. Silverman & George K. Stacey, *Understanding “Patentese”—A Patent Glossary*, 48 JOM 77, available at <http://www.tms.org/pubs/journals/JOM/matters/matters-9609.html> (last visited November 16, 2005).

¹² See *Festo*, 535 U.S. at 734.

¹³ See *generally* 5A-18 CHISUM, *supra* note 5, at 18.02[3]. For example, a patentee adds a limitation during prosecution that an element of a claim must be the color “red.” The patentee would be barred from later arguing that a similar device with the same element colored “blue” is equivalent to his or her patented device.

¹⁴ See CHISUM, *supra* note 5, at 18.02[3].

¹⁵ *Festo*, 535 U.S. at 722.

determine whether a patentee is presumptively barred from asserting equivalents to specific claims.

1. Warner-Jenkinson Co. v. Hilton Davis Chemical Co.

¶8 *Warner-Jenkinson* involved a patent describing an ultrafiltration process for purifying dyes.¹⁶ During patent prosecution, the defendant added a phrase to a claim, restricting its pH level to “approximately 6.0 to 9.0” in order to avoid the prior art.¹⁷ The plaintiff subsequently developed an ultrafiltration process that used a pH level of 5.0.¹⁸

¶9 The Supreme Court held in this case that the doctrine of equivalents was alive and well, and was not contrary to the 1952 revision of the Patent Act.¹⁹ The Court further held that, if an amendment is made during prosecution, the patentee bears the burden of showing that the amendment was made for a purpose other than patentability.²⁰ If the patentee is unable to show that the amendment was made for a purpose other than patentability, the court should presume that prosecution history estoppel applies to the narrowing amendment.²¹

¶10 The Court determined that adding language limiting the pH level of a process was a narrowing amendment. The Court then concluded that the patentee was barred from asserting equivalents of the pH level because the patentee did not provide a reason for limiting the pH level to the 6.0 to 9.0 range.²²

2. Festo Corp. v. Shoketsu Kinoku Kogyo Kabushiki Co.

¶11 *Festo* involved patents regarding magnetically coupled rodless cylinders.²³ During prosecution, Festo amended its application by adding a limitation requiring that the sleeve of the device be made of a magnetizable material.²⁴ During a reexamination of one of the patents, Festo also amended a patent claim to include a pair of sealing rings on a piston.²⁵ The patent examiner allowed each of these claims after they were amended.²⁶ The defendant subsequently developed a similar device; however, the defendant’s device used a non-magnetizable alloy for the sleeve and used a three-ring combination on the piston.²⁷

¶12 In the first CAFC opinion, the court held that, when prosecution history estoppel applied, the patentee was completely barred from asserting any equivalents of the

¹⁶ *Warner-Jenkinson*, 520 U.S. at 22.

¹⁷ *Id.*

¹⁸ *Id.* at 23.

¹⁹ *Id.* at 21. One party raised an argument to the Supreme Court in this case that the existence of the doctrine of equivalents itself violates the 1952 Patent Act.

²⁰ *Id.* at 33.

²¹ *Id.*

²² *Warner-Jenkinson*, 520 U.S. at 40-41.

²³ 535 U.S. at 728.

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.* at 729.

element at issue.²⁸ On appeal from the CAFC, the Supreme Court first held that estoppel arises after an inventor amends the claims of his invention for a substantial reason related to patentability.²⁹ The Court then stated that creating a narrowing amendment is a substantial reason relating to patentability.³⁰ However, the Court rejected the CAFC's complete bar approach to equivalents, stating that language itself still creates challenges of describing a patent after amendment.³¹

¶13 The Supreme Court then gave a patentee three ways to rebut the presumption of prosecution history estoppel and the surrender of equivalents:³²

The patentee may show that the equivalent was unforeseeable at the time of the application;³³

The patentee may show that the amendment bears no more than a tangential relation to the equivalent in question;³⁴ or

The patentee may show that there was some other reason why the patentee could not reasonably have been expected to have described the change in question.³⁵

II. STATEMENT OF THE *HONEYWELL* CASE

¶14 This section first provides a brief background of the case. The second portion of this section explains the reasoning of the majority and minority opinions in this case.

A. *Background of the Case*

¶15 Honeywell, a manufacturer of aerospace equipment, held two patents related to an aircraft auxiliary power unit.³⁶ All of the asserted claims³⁷ of the patents were originally dependent on other claims in Honeywell's applications.³⁸ These claims were originally rejected by the examiner as obvious in light of prior art.³⁹ The examiner indicated that the claims would be allowable if rewritten into independent form.⁴⁰ In response to the examiner's request, Honeywell cancelled its rejected independent claims and rewrote the appropriate dependent claims into independent claims expressly incorporating the

²⁸ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 574-75 (Fed. Cir. 2000).

²⁹ *Festo*, 535 U.S. at 735 (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997)).

³⁰ *Festo*, 535 U.S. at 739-40.

³¹ *Id.* at 737-38.

³² *Id.* at 740-41.

³³ *Id.*

³⁴ *Id.*

³⁵ *Id.* at 741.

³⁶ *Honeywell*, 370 F.3d at 1134. An auxiliary power unit is a small gas turbine engine most commonly used in the tail section of an airplane.

³⁷ By "asserted claims" I mean the claims later asserted by Honeywell in its suit against Hamilton-Sundstrand.

³⁸ *Honeywell*, 370 F.3d at 1137.

³⁹ *Id.*

⁴⁰ *Id.*

limitations of the rejected independent claims.⁴¹ The amended claims were allowed by the examiner and the patents issued.⁴² After Honeywell's patents were granted, Hamilton Sundstrand ("Hamilton") began manufacturing its own auxiliary power unit.⁴³ Hamilton's device differed from Honeywell's asserted patent claims with respect to one element common to the claims.⁴⁴ This common element was an inlet guide vane limitation.⁴⁵

¶16 Honeywell filed suit against Hamilton in the District of Delaware claiming patent infringement both literally and under the doctrine of equivalents.⁴⁶ Honeywell eventually conceded that Hamilton's device did not literally meet the inlet guide vane limitation.⁴⁷ Hamilton then moved for summary judgment, arguing that the asserted claims were narrowed by amendment during prosecution and therefore prosecution history estoppel barred all equivalents for the inlet guide vane limitation under *Festo*.⁴⁸

¶17 The district court, while noting that Hamilton's argument had "superficial appeal,"⁴⁹ rejected its motion for summary judgment.⁵⁰ The district court held that, because the claims were merely rewritten into independent form, the "elements at issue were not amended"⁵¹ and "Honeywell did not give up an embodiment of the invention with the inlet guide vane" limitation.⁵²

¶18 The jury eventually found that Hamilton did not literally infringe Honeywell's patents, but it did infringe the patents under the doctrine of equivalents.⁵³ The court denied Hamilton's motions for judgment as a matter of law and a new trial.⁵⁴ The court also denied Honeywell's motion for judgment as a matter of law on literal infringement and motion for enhanced damages, attorneys' fees, and costs, including expert witness costs.⁵⁵

¶19 Honeywell appealed the district court's decision limiting actual damages,⁵⁶ but it did not appeal the finding of no literal infringement.⁵⁷ Hamilton cross-appealed,

⁴¹ *Id.* As has been mentioned, the practice of rewriting dependent claims into independent claims in response to a rejection was a common practice. This practice will be discussed more in Part III, *infra*.

⁴² *Id.*

⁴³ *Id.* at 1136.

⁴⁴ *Honeywell*, 370 F.3d at 1136.

⁴⁵ *Id.* The reader need not understand what an "inlet guide vane limitation" is in order to continue reading.

⁴⁶ *Id.* at 1137.

⁴⁷ *Id.* at 1136.

⁴⁸ *Id.* at 1138.

⁴⁹ *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, No. 99-309 GMS, 2001 U.S. Dist. LEXIS 2155, at *18 (D. Del. Jan. 8, 2001).

⁵⁰ *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1138 (Fed. Cir. 2004) (citing *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, No. 99-309 GMS, 2001 U.S. Dist. LEXIS 2155, at *10 (D. Del. Jan. 8, 2001)).

⁵¹ *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, No. 99-309 GMS, 2001 U.S. Dist. LEXIS 2155, at *10-11 (D. Del. Jan. 8, 2001).

⁵² *Honeywell*, 370 F.3d 1138.

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.*

challenging the district court’s determinations of infringement under the doctrine of equivalents and the decision rejecting its claims of invalidity.⁵⁸

B. *The CAFC Decision*

1. The Majority–Patent Scope, Not Claim Scope

¶20 On appeal, the CAFC first considered whether a narrowing amendment to a patent claim that adds an additional claim limitation creates a presumptive surrender of equivalents under the Supreme Court’s decisions in *Warner-Jenkinson* and *Festo*.⁵⁹ The court noted that prosecution history estoppel may bar the patentee from asserting equivalents if the scope of the claims has been narrowed by amendment during prosecution.⁶⁰ It also recognized that estoppel arises when an amendment is made to secure the patent and that amendment narrows the patent’s scope.⁶¹ After reviewing these two propositions, the court looked to the language the Supreme Court used in *Warner-Jenkinson* and *Festo* regarding claim amendments.⁶²

¶21 After reviewing the facts of *Warner-Jenkinson*, the CAFC concluded that amending to “introduce a new element” may give rise to a presumption of surrender.⁶³ *Festo* indicated that amending to “add[] a new limitation” may also give rise to a presumption of surrender.⁶⁴ Molding these two holdings together, the CAFC held that an amendment adding a new claim limitation constitutes a narrowing amendment that may give rise to an estoppel.⁶⁵

¶22 The court next addressed whether rewriting a dependent claim into independent form, coupled with the cancellation of the original independent claim, constitutes a narrowing amendment. The court considered this question in light of when the dependent claim includes an additional claim limitation not found in the cancelled independent claim or circumscribes a limitation found in the cancelled independent claim.⁶⁶ Honeywell argued that prosecution history estoppel cannot apply where a dependent claim is merely rewritten into an independent claim.⁶⁷ Although the patentee surrendered its broader independent claim, there is no presumption of surrender because the scope of the rewritten claims themselves have not been narrowed.⁶⁸ However, *Festo* mandates that the proper focus is whether the amendment narrows the overall scope of the claimed subject matter.⁶⁹ The court pointed to language in *Festo* demonstrating that rewriting a

⁵⁸ *Honeywell*, 370 F.3d 1139.

⁵⁹ *Id.*

⁶⁰ *Id.* (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34 (2002)).

⁶¹ *Honeywell*, 370 F.3d at 1139 (citing *Festo*, 535 U.S. at 736).

⁶² *Id.* at 1140.

⁶³ *Id.* (citing *Warner-Jenkinson Co.*, 520 U.S. at 33).

⁶⁴ *Id.* (citing *Festo*, 535 U.S. at 728).

⁶⁵ *Id.* at 1141.

⁶⁶ *Honeywell*, 370 F.3d at 1139.

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.* (citing *Festo*, 535 U.S. 736-37).

dependent claim into independent form creates a presumptive surrender if the amendment is “made to secure the patent.”⁷⁰

¶23 The CAFC decreed that it will not preclude the application of prosecution history estoppel by considering whether the scope of the rewritten claims have remained unchanged.⁷¹ By canceling the original independent claim and rewriting a dependent claim into independent form, the scope of the subject matter claimed in the independent claim has been narrowed to secure the patent.⁷² The court then observed the consistent application of this rule in post-*Festo* decisions.⁷³

¶24 Looking to its decision in *Deering Precision Instruments v. Vector Distribution Systems*,⁷⁴ the court explained it had already held that canceling a broader independent claim and replacing it with a dependent claim rewritten into independent form was a “clear surrender of the broader subject matter.”⁷⁵ This surrender of the broader subject matter presumptively barred application of the doctrine of equivalents.⁷⁶ The court also looked to its decision in *Ranbaxy Pharmaceuticals v. Apotex*,⁷⁷ restating its holding that the rewriting of three dependent claims into one independent claim “surrendered subject matter that was originally claimed for reasons related to patentability.”⁷⁸ The court therefore held in *Ranbaxy* that there was a presumption of estoppel.⁷⁹

¶25 In the court’s view, the approaches taken in *Ranbaxy*, *Deering*, and now *Honeywell* are each consistent with both *Festo*’s language and theory.⁸⁰ In other words, a patentee’s decision to narrow claims through amendment may presumptively result in a general disclaimer of the territory between the original claim and the amended claim.⁸¹ Further, when the scope of the patent claim is narrowed to secure the patent, the court must regard the patentee as having conceded an inability to claim the broader subject matter.⁸² Thus, the court held that by rewriting a dependent claim into independent form and canceling the original independent claim, prosecution history estoppel applies and the patentee is presumptively barred from using the doctrine of equivalents.⁸³

2. The Dissent – Each Claim is its Own Invention

¶26 Judge Newman wrote a dissenting opinion in *Honeywell*.⁸⁴ She first noted that under paragraph four of 35 U.S.C. § 112,⁸⁵ a dependent claim incorporates by reference

⁷⁰ *Id.* at 1142 (citing *Festo*, 535 U.S. at 736).

⁷¹ *Honeywell*, 370 F.3d at 1142.

⁷² *Id.*

⁷³ *Id.* at 1143.

⁷⁴ *Deering Precision Instruments, L.L.C. v. Vector Distribution Sys., Inc.*, 347 F.3d 1314 (Fed. Cir. 2003).

⁷⁵ *Honeywell*, 370 F.3d. at 1143 (quoting *Deering*, 347 F.3d at 1325).

⁷⁶ *Id.*

⁷⁷ *Ranbaxy Pharms., Inc. v. Apotex, Inc.*, 350 F.3d 1235 (Fed. Cir. 2003).

⁷⁸ *Id.* at 1237 (quoting *Deering*, 347 F.3d at 1325).

⁷⁹ *Id.* at 1240-41.

⁸⁰ *Honeywell*, 370 F.3d at 1143.

⁸¹ *Id.* (citing *Festo*, 535 U.S. 740).

⁸² *Id.* at 1143-44 (citing *Festo*, 535 U.S. at 737).

⁸³ *Id.* at 1144.

⁸⁴ *Id.* at 1146 (Newman, J., dissenting).

all the limitations of the claim to which it refers.⁸⁶ Judge Newman then argued that, by writing a dependent claim into independent form, neither the scope nor the content of the claim itself has been changed.⁸⁷

¶27 Referring to *Festo II*,⁸⁸ Judge Newman stated that the majority had ignored its previous decision.⁸⁹ She noted that, on remand, the CAFC stated that the first question in a prosecution history estoppel inquiry is whether an amendment has narrowed the literal scope of the claim in question.⁹⁰ Next, she contended that if the amendment was not narrowing, prosecution history estoppel should not apply.⁹¹ She then argued that, because restating a claim in independent form does not narrow the literal scope of the claim, prosecution history estoppel should not apply in this case based on the language of the court in *Festo II*.⁹²

¶28 After finishing her discussion of *Festo II*, Judge Newman went on to discuss why dependent claims are used in the patenting process.⁹³ Among the reasons given is that dependent claims are charged substantially lower fees compared to independent claims.⁹⁴ She then quoted from 35 U.S.C. § 282⁹⁵ and stated that a dependent claim is independently valid and is not narrowed by the cancellation of an independent claim.⁹⁶

¶29 Judge Newman then concluded that rewriting a claim in accordance with paragraph four of 35 U.S.C. § 112 can never be a narrowing amendment. Under her interpretation of the statute, rewriting a dependent claim into an independent claim does not narrow the claim's scope.⁹⁷ In her view it made a difference that the dependent claims at issue were not rejected by the examiner; instead the examiner simply objected to them.⁹⁸ Since the dependent claims were always allowable, just objected to as to their form, their transformation from dependent to independent form is not a narrowing amendment.⁹⁹

¶30 Finally, Judge Newman discussed the differences between the *Honeywell* case and the holdings of *Ranbaxy*¹⁰⁰ and *Deering*.¹⁰¹ She agreed with the holdings of *Ranbaxy* and

⁸⁵ 35 U.S.C. § 112, ¶ 4 (2000) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

⁸⁶ *Honeywell*, 370 F.3d at 1146 (Newman, J., dissenting).

⁸⁷ *Id.* at 1147 (citing *Bloom Eng'g Co. v. N. Am. Mfg. Co.*, 129 F.3d 1247, 1250 (Fed. Cir. 1997); *Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1553 (Fed. Cir. 1989); *Hartness Int'l Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987)).

⁸⁸ *Festo II* refers to the last remand of the case to the CAFC. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003).

⁸⁹ *Honeywell*, 370 F.3d at 1148 (Newman, J., dissenting).

⁹⁰ *Id.* (citing *Festo*, 344 F.3d at 1366-67).

⁹¹ *Id.* (citing *Festo*, 344 F.3d at 1366-67).

⁹² *Id.*

⁹³ *Id.* at 1148-49.

⁹⁴ *Honeywell*, 370 F.3d at 1148.

⁹⁵ 35 U.S.C. § 282 (2000) (“Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of the other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim.”).

⁹⁶ *Honeywell*, 370 F.3d at 1148 (Newman, J., dissenting).

⁹⁷ *Id.* at 1150.

⁹⁸ *Id.* at 1151.

⁹⁹ *Id.*

¹⁰⁰ *Ranbaxy Pharms., Inc. v. Apotex, Inc.*, 350 F.3d 1235 (Fed. Cir. 2003).

¹⁰¹ *Deering Precision Instruments, L.L.C. v. Vector Distribution Sys., Inc.*, 347 F.3d 1314 (Fed. Cir.

Deering because the dependent claims at issue in those cases limited the scope of an element in each of their respective independent claims.¹⁰² Arguing that *Honeywell* is different because the dependent claims at issue added new elements that were not amended or narrowed, she concluded that there was no surrendered territory of the new elements at issue, and thus prosecution history estoppel should not apply.¹⁰³

III. ANALYSIS

A. *The Majority Opinion – A Reasoned Decision?*

¶31 The majority opinion is lacking in two main areas. First, the majority fails to consider whether the act of rewriting a dependent claim as an independent claim inherently satisfies the “some other reason”¹⁰⁴ exception to the presumption of surrender. Second, the majority does not discuss why the cancellation of an independent claim affects a dependent claim even though, under the patent statute, each claim is a separate invention.

¶32 Under *Festo*, a patentee may rebut the presumption of surrender by demonstrating there was “some other reason” the patentee could not reasonably have been expected to describe the alleged equivalent.¹⁰⁵ The CAFC briefly described this concept in its *Festo II* decision, stating that the category itself is “vague” and “narrow” and “may be satisfied when there was some reason, such as the shortcomings of language, why the patentee was prevented from describing the alleged equivalent when it narrowed the claim.”¹⁰⁶ However, the CAFC has never found, under this category, that the presumption of surrender has been rebutted by a patentee.¹⁰⁷ Further, since the court’s largely unhelpful dicta in *Festo II*, the CAFC has not provided additional guidance as to the meaning of “some other reason.”

¶33 If there was some other reason that a patentee would not have been expected to describe alleged equivalents, following a simple instruction from the USPTO would appear to suffice. As noted in Judge Newman’s dissent, rejection of independent claims is “common practice,”¹⁰⁸ and patent examiners often suggest to patentees that certain dependent claims would be allowable if rewritten into independent form. Since these suggestions are so commonly issued by patent examiners, patentees were not placed on notice (at least prior to *Honeywell*) that rewriting a dependent claim into independent form would presumptively bar the patentee from asserting equivalents to certain elements.

¶34 The other significant problem with the majority’s opinion is that it demonstrates the inconsistency between the application of prosecution history estoppel and the doctrine of

2003).

¹⁰² *Honeywell*, 370 F.3d at 1152 (Newman, J., dissenting).

¹⁰³ *Id.*

¹⁰⁴ *Festo*, 535 U.S. at 741.

¹⁰⁵ *Id.*

¹⁰⁶ *Festo*, 344 F.3d at 1370.

¹⁰⁷ See Steven J. Rizzi, *Proving Infringement – Recent Developments in the Federal Circuit’s Methodology for Construing Patent Claims, and Prosecution History Estoppel Post-Festo*, 804 PLI/Pat 345, 374 (2004).

¹⁰⁸ *Honeywell*, 370 F.3d at 1153 (Newman, J., dissenting).

equivalents itself to claims. The doctrine of equivalents is applied by looking at each element of each claim individually.¹⁰⁹ Therefore, it is illogical to apply prosecution history estoppel, a theory that works hand-in-hand with the doctrine of equivalents, on a broader scale than a claim-by-claim analysis. Allowing the cancellation of a claim to directly affect other claims in these instances is obviously not the intent of the USPTO. If the USPTO desired that claims should be allowed to affect one another in this way during prosecution, it would not have a practice of simply objecting to allowable dependent claims when their respective independent claims were rejected on some basis. The USPTO maintains this practice because claims should be considered independently from one another.¹¹⁰

¶35 Further, during an infringement proceeding, a patentee is not required to show that an infringer infringed every claim of a patent; rather, infringement of at least one claim is required for liability to attach.¹¹¹ If there is such a desire that claims affect one another as suggested by the CAFC holding, courts would instead require patentees to show that alleged infringers infringe at least one independent claim of the patent in order to successfully prove infringement. The reason courts do not engage in this practice is because all claims, independent and dependent alike, are treated as separate inventions under 35 U.S.C. § 112. Section 112 undercuts the majority's argument that dependent claims, each of which define a separate and distinct invention,¹¹² may be limited by the mere cancellation of their respective independent claims, which also define their own inventions.¹¹³

¶36 To be sure, the majority could have presented its overall argument in a clearer and more direct manner, but the argument at its core is correct. The Supreme Court did hold in *Festo* that, when an amendment is made to secure the patent and that amendment narrows the patent's scope, that amendment creates a presumptive surrender of equivalents.¹¹⁴ If an independent claim is cancelled and replaced with a narrower dependent claim, such an amendment obviously narrows the patent's scope and is made to secure the patent. Such an action is equivalent to simply amending the original independent claim by adding a limitation or element present in a dependent claim and then canceling that dependent claim. Further, the mere act of canceling a claim narrows the patent's scope.¹¹⁵ The above argument is the essence of the CAFC's holding in *Honeywell*. Logically, it is a correct one under the Supreme Court's holding in *Festo*.

B. *The Dissent – Newman Does Not Respond to the Majority*

¶37 Judge Newman's dissent is lacking in three areas. First, she mentions, but does not comment on, the language in *Festo* discussing narrowing the scope of the patent.¹¹⁶

¹⁰⁹ *Warner-Jenkinson Co.*, 520 U.S. at 40.

¹¹⁰ *See generally* 35 U.S.C. § 112 (2000).

¹¹¹ *See generally* CHISUM, *supra* note 6, at 8.01; *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1274 (Fed. Cir. 1992).

¹¹² *See* 35 U.S.C. § 112 (2000).

¹¹³ *Id.*

¹¹⁴ *Festo*, 535 U.S. at 733-34.

¹¹⁵ Assuming that the claim is not replaced with a broader claim.

¹¹⁶ *Honeywell*, 370 F.3d at 1149 (Newman, J., dissenting).

Next, she unsuccessfully attempts to differentiate the facts of this case from those in *Ranbaxy* and *Deering*.¹¹⁷ Finally, she misconstrues the implications of the majority's holding by postulating that patentees will be encouraged to write only independent claims after this decision.¹¹⁸

¶38 In her dissent, Judge Newman addresses the specific language of *Festo*, stating that “[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent’s scope.”¹¹⁹ However, she goes on to argue only that the rewriting of a dependent claim into independent form does not narrow the scope of the claim. She does not respond to the majority’s reliance on the words “narrows the patent’s scope” from *Festo*.¹²⁰ Obviously, the majority and Judge Newman construe the holding of *Festo* differently. Unfortunately, no one can discern why Judge Newman disagrees with the majority hanging its hat on whether the amendment narrows the patent’s scope. It is impossible to identify why Judge Newman disagrees with the majority’s reasoning because she never comments on the majority’s reliance on that specific language taken out of *Festo*.

¶39 The next problem with Judge Newman’s dissent is her attempt to distinguish the facts of *Honeywell* from those in *Ranbaxy*¹²¹ and *Deering*.¹²² She explains that both *Ranbaxy* and *Deering* dealt with dependent claims that limited an element of the original independent claims.¹²³ She agrees with the majority that both *Ranbaxy* and *Deering* were correctly decided under *Warner-Jenkinson* and *Festo*.¹²⁴ However, she then argues that *Honeywell*’s dependent claims added new features not present in the original independent claims and therefore, the *Honeywell* situation is different from those in *Ranbaxy* and *Deering*.¹²⁵ The major problem with this argument is that the amendment made in *Festo* added a new feature not present in the original independent claim, namely a pair of resilient sealing rings.¹²⁶ It is contradictory to argue that the actual amendments¹²⁷ made in *Honeywell* and *Festo* are in fact different types of amendments; both added new features not originally present in the independent claim. Under this analysis, one must accept *Ranbaxy*, *Deering*, and *Honeywell* as a collective whole or concede that all three of these cases are decided incorrectly. Therefore, this portion of Judge Newman’s opinion is not consistent with case law.

¶40 Finally, Judge Newman incorrectly argues that the majority’s decision will encourage patentees to use only independent claims.¹²⁸ Her argument is flawed because she has misconstrued the actual holding of the majority of the court. To be sure, the stated holding of the majority is that there is a presumption of surrender when a patentee

¹¹⁷ *Id.* at 1152.

¹¹⁸ *Id.* at 1153.

¹¹⁹ *Id.* at 1149 (citing *Festo*, 535 U.S. at 737).

¹²⁰ *Festo*, 535 U.S. at 736.

¹²¹ *Ranbaxy Pharms.*, 350 F.3d at 1235.

¹²² *Deering*, 347 F.3d at 1314.

¹²³ *Honeywell*, 370 F.3d at 1152 (Newman, J., dissenting).

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ *Festo*, 535 U.S. at 728.

¹²⁷ Regardless of whether or not the amendments came from dependent claims.

¹²⁸ *Honeywell*, 370 F.3d at 1153 (Newman, J., dissenting).

cancels an independent claim and replaces it with a dependent claim.¹²⁹ However, the theory behind the holding makes it broader than what is actually stated. The majority effectively held that *any* amendment made to a patent that narrows the patent's scope will presumptively surrender equivalents of some applicable limitations or elements in other claims. In other words, the cancellation of any claim will presumptively surrender equivalents to any limitation or element that would have further narrowed the canceled claim.

¶41 Many who have written thus far about the consequences of *Honeywell* agree with Judge Newman that the decision will draw patentees away from utilizing dependent claims.¹³⁰ In contrast, one scholar has simply stated that Judge Newman's advice to patentees is "unsupported."¹³¹ However, one article has correctly waded through *Honeywell* to conclude that the court intended to imply a broader holding.¹³² A broader holding of *Honeywell* makes practical sense in light of *Festo* because, if the CAFC held otherwise, patentees could effectively bypass prosecution history estoppel altogether through clever prosecution.

¶42 An example of how clever prosecution could bypass prosecution history estoppel if the CAFC did not hold that mere cancellation of a claim triggers prosecution history estoppel follows. Consider these two scenarios:

Scenario I

A patentee writes an application with two claims, the first being an independent claim and the second being a dependent claim. The application consists of the following claims:

Claim 1) Element A;

Claim 2) Claim 1 further including element B.

The examiner rejects Claim 1 as obvious but only objects to Claim 2, stating that it would be allowable if rewritten into independent form including all limitations of its respective independent claim. The patentee then cancels Claim 1 and Claim 2 and instead writes independent Claim 3:

Claim 3) Element A and element B.

The examiner deems Claim 3 allowable and the patent issues.

Scenario II

¹²⁹ *Id.* at 1134.

¹³⁰ See Robert C. Faber, *The Winning Mechanical Claim*, 809 PLI/Pat 163, 244 (2004) (stating that because of *Honeywell* there may be some risk in using dependent claims); Kelly D. Talcott, *Federal Circuit Takes Another Swipe at Doctrine of Equivalents*, NEW YORK LAW JOURNAL, June 15, 2004, at 5 (explaining that as a result of *Honeywell* there is a disincentive to include dependent claims in patent applications); Lewis R. Clayton, *Doctrine of Equivalents, Drug Name Confusion, Privilege*, NEW YORK LAW JOURNAL, June 21, 2004, at 1 (predicting that future patentees will react to *Honeywell* by avoiding dependent claims).

¹³¹ Stephen B. Maebius & Harold C. Wegner, *The Honeywell Nail in the Festo Coffin: A Narrowing Amendment Does Create a Presumption of Prosecution History Estoppel*, 23 BIOTECHNOLOGY L. REP. 417, 418 (2004).

¹³² William M. Atkinson, Kirk T. Bradley & S. Benjamin Pleune, *Losing Ground The Extension of Festo In Honeywell v. Hamilton Sundstrand*, INTELLECTUAL PROP. LAW COMM. NEWSLETTER, Spring, 2005, at 10.

A patentee writes an application with two independent claims. The application consists of the following claims:

Claim 1) Element C;

Claim 2) Element C and element D.

The examiner rejects Claim 1 as obvious and allows Claim 2. The patentee cancels Claim 1. The examiner allows the patent to issue.

¶43 If *Honeywell* does not hold that mere cancellation of a claim triggers prosecution history estoppel, the patentee in Scenario I will be able to assert equivalents while the patentee in Scenario II will be presumptively barred from asserting equivalents. The patentee in Scenario I will be presumptively barred from asserting equivalents of element B, but the patentee in Scenario II will be allowed to assert equivalents of element D. As this example shows, clever claim drafting would allow the patentee in Scenario II to completely bypass the *Honeywell* ruling. Such a result would “exalt form over substance,” which the CAFC does not support.¹³³

¶44 It should be noted that if *Honeywell* is construed in this way, Judge Newman correctly postulates that patentees will be driven to only use independent claims. Accepting Judge Newman’s argument will enable patentees to easily work around *Honeywell* if they pay more money to the USPTO for independent claims. Under this scenario, *Honeywell* would become an empty decision with the only consequence being a greater cost to inventors to secure their patent rights. It is logical to assume that the CAFC would be unhappy with this outcome and would find a way to close this loophole. This potential loophole is closed if the holding is instead read to mean that the mere cancellation of a claim triggers prosecution history estoppel. Construing the holding in this way provides that the patentees in both Scenarios I and II will be presumptively barred from utilizing equivalents of elements B and D of their claims, respectively. This result seems logical given that the patentees in Scenarios I and II reached the same claim in substantially the same way.

¶45 Although Judge Newman’s dissent has a number of problems, it does articulate one important point. Judge Newman discusses one of the major interpretation problems between prosecution history estoppel and the patent statute. 35 U.S.C. § 282 states that each claim of a patent shall be presumed valid independently of the validity of other claims.¹³⁴ In Judge Newman’s words, “[e]ach claim defines a separate invention whether or not written in independent form; and its validity stands or falls separately.”¹³⁵ However, the idea that prosecution history estoppel allows claims to affect each other seems to contradict Section 282. This dichotomy can be confusing.

¶46 It may make sense that by assuming two claims are treated as separate inventions, if one claimed invention is rejected, this rejection should not affect the other claimed invention. Following this logic, if an “independently claimed” invention is rejected, this rejection should not affect a related “dependently claimed” invention. Further, if two inventions are instead written as independent claims, even with many similar elements, the rejection of one claimed invention should not have an effect on the other.

¹³³ *Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 260 (Fed. Cir. 1985).

¹³⁴ 35 U.S.C. § 282 (2000).

¹³⁵ *Honeywell*, 370 F.3d at 1148 (Newman, J., dissenting).

¶47 Although Judge Newman does bring up this important point, her dissent would have made much more sense if she had discussed three things. First, she should have responded to the majority’s reliance on specific language in *Festo*. Next, she should have further clarified why *Honeywell* should be treated differently than *Deering* or *Ranbaxy* (or should have simply stated that *Deering* and *Ranbaxy* were wrongly decided). Finally, she should have discussed how patentees could easily bypass the holding of the majority.

C. Can’t We All Just Get Along?

¶48 The major difference between the philosophies of the majority and Judge Newman is the interpretation of the Supreme Court’s holding in *Festo*. The majority focuses on the language stating that “[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent’s scope.”¹³⁶ However, Judge Newman focuses on the fact that each claim is a separate invention and simply rewriting a dependent claim into independent form does not narrow the claim’s scope, and is therefore not a narrowing amendment.¹³⁷

¶49 If Judge Newman is correct, then rewriting a dependent claim into independent form, coupled with the cancellation of the original independent claim, will not trigger prosecution history estoppel as long as the original dependent claim adds a “new feature” not present in the original independent claim and does not further limit an element of the original independent claim.¹³⁸ Such a result would produce an irreconcilable dichotomy between the holdings of *Deering* and *Ranbaxy* and the holding of *Honeywell*. Further, such a holding would open the door for patentees to bypass *Festo*. Before the *Honeywell* decision, if a patentee amended a rejected independent claim by introducing a new feature into it, the patentee would be presumptively barred from asserting equivalents of the new feature under *Festo*.¹³⁹ Under Judge Newman’s approach, patentees could get around *Festo* by first introducing new dependent claims into applications during prosecution that add new features to rejected independent claims. Patentees would then cancel rejected independent claims and replace them with the dependent claims that add new features. By drafting claims in this way, patentees would be able to reach the same result as they would before *Honeywell* but this time they would be able to use the doctrine of equivalents for the new feature originally described in a dependent claim. The fact that patentees could bypass this portion of the *Festo* doctrine is not a desirable result.

¶50 Let us assume that one accepts the premise that in *Festo* the Supreme Court’s focus was on whether the scope of the patent itself had been narrowed. It then follows that any amendment narrowing the scope of a patent (and being made to secure the patent) triggers prosecution history estoppel in some way. What would such an amendment look like? The simplest amendment to consider for such a question would be the cancellation of a claim. When a claim is cancelled, assuming that it is not replaced with a broader claim, the scope of the subject matter covered by the patent has in fact been narrowed. Following this logic, such an amendment would trigger prosecution history estoppel.

¹³⁶ *Festo*, 535 U.S. at 736.

¹³⁷ *Honeywell*, 370 F.3d at 1149 (Newman, J., dissenting).

¹³⁸ *Id.* at 1152.

¹³⁹ *Festo*, 533 U.S. at 741.

¶51 Through its decision, the CAFC is telling patentees that it equates the action of amending a rejected independent claim by adding a new element to the action of canceling a rejected independent claim and replacing it with a dependent claim that adds a new element. There is no practical difference between these two methods of amendment and, therefore, it makes sense to treat them the same way. The only difference is that in one, the new element is not disclosed in the claims immediately but is still supported by the specification, whereas in the other, the element is disclosed in a claim right away and is also supported by the specification. The overall scope of the patents created by these two methods of amendment is exactly the same, and therefore they should be treated equally. Until practitioners and judges recognize that the focus of *Festo* is on the overall scope of the patent itself, the debate over when a patentee is presumptively barred from asserting equivalents will continue.

IV. CONSEQUENCES

¶52 This section describes two types of consequences of the CAFC decision. The first section discusses consequences to patentees, and the second section explains the effect of the CAFC decision on the USPTO and district court judges.

A. Possible Consequences to Patentees

¶53 The next logical question asked is what effect the CAFC's holding in *Honeywell* will have on patent prosecution and litigation. A number of scenarios are possible, but it is impossible to predict the future of patent practice with precision. However, it is clear that clever claim drafting will be required to navigate through the swamp of presumptive estoppel rules.

¶54 In one possible view of the future, we could accept Judge Newman's postulation that patentees will be driven to use only independent claims.¹⁴⁰ To those who believe that the CAFC's holding only encompasses rewriting a dependent claim in independent form coupled with canceling the original independent claim, Judge Newman's idea makes sense. However, as explained above, *Honeywell* should instead be interpreted to hold that mere cancellation of a claim can trigger prosecution history estoppel. For patentees who use this track, taking the route of only using independent claims will not solve the problem. Regardless, there will be an uncertainty as to the scope of the *Honeywell* holding that can only be dissolved if the CAFC further refines its *Honeywell* holding in a future case or if the Supreme Court decides to clarify the situation.¹⁴¹

¶55 Since Judge Newman's approach leaves much to be desired, patentees may simply stick to drafting narrower claims than they would otherwise attempt to patent. This approach would secure use of the doctrine of equivalents but has the drawback of a smaller world of literal infringement. In using this approach, patentees will need to take even more time researching prior art and drafting claims in order to be assured that their original submitted claims will not be rejected. At the very least patentees will want to be

¹⁴⁰ *Honeywell*, 370 F.3d at 1153 (Newman, J., dissenting).

¹⁴¹ The Supreme Court decided in June of 2005 not to hear an appeal of the CAFC *Honeywell* decision. *Honeywell Int'l Inc. v. Hamilton Sundstrand Corp.*, 125 S. Ct. 2928 (2005).

able to write allowable claims without having to make a narrowing amendment to the claims. It is unclear whether patentees will prefer this alternative.

¶56 Patentees may decide to give up on trying to secure claims that may utilize the doctrine of equivalents. By following this approach, patentees may try to secure the broadest possible claims, hoping that fear of literal infringement of broad patent claims will keep infringers away. However, these patentees may find themselves in a more precarious position than before *Honeywell*; namely their broad claims may be rejected and they will be forced into narrow claims that have no doctrine of equivalents protection due to narrowing amendments.

¶57 As described in an article in the Intellectual Property Newsletter of Summer 2004, patentees may increasingly turn to means-plus-function and step-plus-function claim drafting pursuant to paragraph 6 of 35 U.S.C. § 112.¹⁴² Such an approach, which will statutorily protect certain equivalents, may help some patentees. However, for the claims that cannot be written in that language, this approach will be of no help.

¶58 Regardless of which approach practitioners use, they will likely amend claims less and argue admissibility of claims more, while making sure not to trigger prosecution history estoppel through argument. Such an approach will be necessary in order to protect not only the original independent claim, but also the use of doctrine of equivalents on all of the independent claim's dependent claims. This practice will require more time than was needed in the past because of the greater use of argument during prosecution. This in turn will increase the cost of prosecuting a patent.

B. Consequences to the USPTO and District Court Judges

¶59 Another possibility is that the USPTO and its examiners may reconsider how they treat objections to dependent claims that would otherwise be allowable if rewritten into independent form. As Judge Newman notes, “the writing of broader claims and their cancellation during prosecution is, or was, the *common practice*.”¹⁴³ However, since the CAFC has taken its position (albeit the correct one under *Festo*) regarding the rewriting of dependent claims, USPTO examiners may not want to continue the practice of simply “objecting” to dependent claims when it would otherwise be appropriate. Unfortunately, there is not much the USPTO can do to protect practitioners from prosecution history estoppel. Further, the role of the USPTO is not to give advice to practitioners concerning the ramifications of their actions.

¶60 *Honeywell* will have a grave effect on district court judges attempting to determine the meaning of claims during *Markman* hearings.¹⁴⁴ It will be difficult, or nearly impossible, to determine what elements in which claims would be affected by a

¹⁴² William M. Atkinson, Kirk T. Bradley & S. Benjamin Pleune, *Losing Ground The Extension of Festo In Honeywell v. Hamilton Sundstrand*, INTELLECTUAL PROP. LAW COMM. NEWSLETTER, Spring, 2005, at 10. Section 112 paragraph 6 allows patentees to express an element in a combination claim as a means or step for performing a function without reciting structure, material, or acts. Section 112 paragraph 6 claims are construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. 35 U.S.C. § 112 (2000).

¹⁴³ *Honeywell*, 370 F.3d at 1153 (Newman, J., dissenting) (emphasis added).

¹⁴⁴ See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Judges construe patent claims before the formal start of the proceeding during what have been named “*Markman*” hearings.

cancellation of a claim.¹⁴⁵ Since whether a patentee is presumptively estopped from asserting equivalents is a question of law that is reviewed without deference,¹⁴⁶ the reversal rate of district courts in making such a determination will likely increase. Further, since claim construction is a question of law that is reviewed *de novo*,¹⁴⁷ the reversal rate of district court claim construction will also go up due to the increasing confusion surrounding how claims must be interpreted.

¶61 At least one thing is clear, soon a case will be appealed to the CAFC where a patentee writes all of its claims as independent claims, expecting to get around *Honeywell* by doing so. This patentee will have one of its broader independent claims cancelled due to a rejection by the examiner and will then try to argue that the simple cancellation of an independent claim has no bearing as to the scope of another independent claim. If and when this case finds its way to the CAFC, the court will hold that the mere cancellation of an independent claim is a narrowing amendment under *Festo*, and therefore certain elements of the remaining independent claim may be presumptively barred from using the doctrine of equivalents.

V. CONCLUSION

¶62 The debate over whether *Honeywell* was correctly decided comes down to a fundamental disagreement as to the holding of *Festo*. If someone believes that the correct focus under *Festo* is whether the scope of the patent has been narrowed, that person will agree with the *Honeywell* decision. That person may also go so far as to agree that the mere cancellation of a claim triggers prosecution history estoppel. However, if one believes that the correct focus under *Festo* is whether the scope of a claim has been narrowed, that person will likely disagree with the *Honeywell* decision.

¶63 This paper has argued that *Honeywell* is in line with *Festo*. Considering the plain, unambiguous language given to us by the Supreme Court, the mere cancellation of a claim triggers prosecution history estoppel. Unfortunately, at this point it is unclear whether the CAFC intended this result. In the future, either the CAFC or the Supreme Court will need to clarify the *Honeywell* holding and thereby greatly assist both practitioners and district court judges. Even though *Honeywell* is correctly decided, application of the decision poses many problems for both patent practitioners and judges.

¹⁴⁵ Especially a cancellation of a dependent claim.

¹⁴⁶ *Ranbaxy*, 350 F.3d at 1240.

¹⁴⁷ *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998).