

## Phillips v. AWH, Corp., A Doctrine of Equivalents Case?

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Case?***

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## INTRODUCTION

As noted by several U.S. courts, the doctrine of equivalents has been “unworkable” for a number of years.<sup>1</sup> However, as American courts move toward a more holistic approach to claim interpretation, the doctrine of equivalents will become unnecessary as a means of expanding patent scope.<sup>2</sup> The holistic approach to claim interpretation involves a contextual reading of the patent claims that takes into account the definitions used throughout the patent document, including the specification and prosecution history.<sup>3</sup> It places less emphasis on extrinsic sources, like dictionary definitions and treatises, and more emphasis on the patentee’s intent when he drafted his claims. In this way, the holistic approach protects the intent of the patentee, while avoiding over-broad claim interpretation.<sup>4</sup>

U.S. courts have adopted the standard used by the House of Lords in the landmark claim interpretation case, *Kirin-Amgen v. Hoechst*, whereby the House of Lords defines claim language as would a person reasonably “skilled in the art.”<sup>5</sup> This standard for claim interpretation is consistent with the holistic approach recently favored by the Federal Circuit in *Phillips v. AWH, Corp.*, and will push U.S. patent law further toward abolishing the doctrine of equivalents as a means of expanding claim scope.<sup>6</sup>

Claims delimit a patentee’s intellectual property rights and notify the public of what information a patentee owns, so the claims and the way in which they are interpreted are very important in patent litigation. Some U.S. courts focus heavily on abstract dictionary definitions and other extrinsic sources in order to objectively interpret claim meaning.<sup>7</sup>

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1. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 595 (Fed. Cir. 2000) (stating that the current approach to doctrine of equivalents law “has proven unworkable”). *See also*, *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). “We . . . share the concern . . . that the doctrine of equivalents . . . has taken on a life of its own, unbounded by the patent claims.” *Id.* at 28-29.

2. *See* *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323 (Fed. Cir. 2007) (where the court did not use the doctrine of equivalents analysis, but instead used a more holistic approach to interpretation); *see also* *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

3. *See* David Potashnik, Note, *Phillips v. AWH: Changing the Name of the Game*, 39 AKRON L. REV. 863, 876-878 (2006).

4. *See id.* at 893.

5. *Kirin-Amgen, Inc. v. Hoechst Marion Roussel, Ltd.*, [2004] UKHL 46, [2005] 1 All ER 667 (U.K.) (quoting § 72(1)(c) of the Patent Act of 1977).

6. *See Phillips*, 415 F.3d at 1303. *See also* Potashnik, *supra* note 3, at 876, regarding the holistic approach to claim interpretation.

7. *Phillips*, 415 F.3d at 1319; *see e.g.*, *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d

Such abstract methods of claim interpretation lead to over-broad patent rights in some cases, and they also fail to account for the patentee's intentions when he wrote the claims.<sup>8</sup> The courts' reliance on abstract extrinsic definitions in claim interpretation has meant that patentees did not always receive the protection they expected when they drafted their patent claims; this interpretive method has also made it difficult for third parties to determine what information falls within the claims' scope.<sup>9</sup> In short, abstract claim interpretation provides very little predictability for concerned parties who are seeking to predict their rights or to avoid infringement.

Although abstract claim interpretation leads to unpredictable results, the results seem to be more objective, at least at first glance.<sup>10</sup> Dictionary definitions, treatises, and similar resources provide uniform definitions that are easy for most people to understand. However, patentees often draft claims using terminology that has special meaning to them and to other members of their professions. Dictionary definitions do not always adequately express what a patentee intended to convey, and this Comment will explore a new standard adopted by the Federal Circuit in *Phillips v. AWH, Corp.* that addresses this very issue. This Comment will also discuss the similarities between the standard adopted in *Phillips* with the standard adopted by the House of Lords in the United Kingdom case, *Kirin-Amgen v. Hoechst*, and its implications for U.S. doctrine of equivalents law.

While extrinsic sources remain an important part of claim interpretation in the United States, the context of the claims (including intrinsic evidence of meaning, contained in the specification and prosecution history, and the inventor's intent) should carry more weight in deciding the claims' meanings. Rather than relying too heavily on abstract, extrinsic sources, like dictionaries, U.S. courts are moving toward a standard similar to the one adopted by the House of Lords in

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1193 (Fed. Cir. 2002).

8. *Phillips*, 415 F.3d at 1321 (“[I]f the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification . . . limits that definition, the error will systematically cause the construction of the claim to be unduly expansive.”).

9. *See id.* at 1319. “[T]here may be a disconnect between the patentee’s responsibility to describe and claim his invention, and the dictionary editors’ objective of aggregating all possible definitions for particular words.” *Id.* at 1321.

10. “Dictionaries, encyclopedias and treatises’ . . . are ‘objective resources that serve as reliable sources of information . . . .’” *Phillips*, 415 F.3d at 1319 (quoting *Texas Digital Sys., Inc.*, 308 F.3d at 1202).

*Kirin-Amgen*.<sup>11</sup> If courts continue to move away from abstract extrinsic patent claim interpretation, the doctrine of equivalents will become less necessary to ensure the rights of patentees, and will eventually become obsolete.

Adopting a “person reasonably skilled in the art,” or “person having ordinary skill in the art” approach to claim interpretation and eliminating the doctrine of equivalents in patent infringement cases would benefit patent law in several ways: (1) when courts interpret patent claims from the perspective of a person reasonably skilled in the art, patentees would be better able to predict and control the scope of their intellectual property rights during patent prosecution;<sup>12</sup> (2) when courts eliminate the doctrine of equivalents in conjunction with the reasonableness standard, patents would better fulfill their notice function, and others skilled in the art will be better able to determine the scope of prior patents;<sup>13</sup> (3) when courts eliminate the doctrine of equivalents, competition would also improve because patentees will no longer receive protection for after-arising technologies, and other inventors will be better able to assess risk of infringement before they enter the market.<sup>14</sup>

## I. IMPORTANT LEGAL DOCTRINES IN *KIRIN-AMGEN* AND *PHILLIPS*

### A. *History of Claim Interpretation in the United States*

In the earliest days of patent litigation in the United States, patent claims did not even receive mention in the statute—patent attorneys began including claim-type language in patent specifications prior to the

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11. *Kirin-Amgen, Inc.*, [2004] UKHL 46.

12. See Joshua D. Sarnoff, *Abolishing the Doctrine of Equivalents and Claiming the Future After Festo*, 19 *BERKELEY TECH. L.J.* 1157, 1224-25 (2004); Roy Collins III, *The Doctrine of Equivalents: Rethinking the Balance Between Equity and Predictability*, 22 *GOLDEN GATE U. L. REV.* 285, 285 (1992); Cecil D. Quillen, Jr., *Essay, Innovation and the U.S. Patent System*, 1 *VA. L. & BUS. REV.* 207, 234 (2006) (suggesting that the process of obtaining and protecting a patent might be less uncertain if the doctrine of equivalents were abolished).

13. See Sarnoff, *supra* note 12, at 1195 (“[The doctrine of equivalents] reverses course from the Court’s earlier history of assuring both notice to and fairness for the public.”); John Richards et al., Symposium, *Panel I: The End of Equivalents? Examining the Fallout from Festo*, 13 *FORDHAM INTELL. PROP. MEDIA & ENT. L. J.* 727, 763 n.135 (2003) (“the greater the level of discretion left to the courts to look beyond the claim language . . . , the less the claims perform their public notice function . . . ,” citing the Supreme Court of Canada in the case *Free World Trust v. Electro Santé, Inc.*, [2002] 2 S.C.R. 1024 (Can.)).

14. But see Michael J. Meurer & Craig Allen Nard, *Invention, Refinement and Patent Claim Scope: A New Perspective on the Doctrine of Equivalents*, 93 *GEO. L.J.* 1947 (2005).

Patent Act of 1836 to more clearly define their clients' inventions for the United States Patent and Trademark Office (USPTO).<sup>15</sup> A line of cases following enactment of the 1836 Act, beginning with *Merrill v. Yeomans*, establishes the claims of the patent as the most important interpretive tool.<sup>16</sup> "[T]he claims are 'of primary importance, in the effort to ascertain precisely what it is that is patented.'"<sup>17</sup> In order to provide the public with notice of what was protected in a given patent, claim interpretation based on the "plain meaning" of the words used, became the norm. "[I]t is 'unjust to the public, as well as an evasion of the law, to construe [the claim] in a manner different from the plain import of its terms.'"<sup>18</sup> Earlier cases focused on the use of extrinsic evidence like dictionaries, treatises, and encyclopedias to find the literal, objective meanings of claim terms; but use of sources unconnected and unrelated to the patent led to abstract, and sometimes absurd, claim interpretations.<sup>19</sup> Extrinsic interpretive tools are meant to provide consistency and objectivity in the process of claim interpretation, but they make it more difficult for those skilled in the art to determine how the court would interpret the patentee's specialized language.<sup>20</sup> Rather than relying on their own knowledge of such language, third parties have to attempt to predict which extrinsic sources courts will use, and then to determine which of the definitions held in those sources will be chosen. This system makes it very difficult to determine how patent claims will be interpreted, and how to avoid infringing those claims.

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15. *Id.* at 1961. "Claims were not mentioned in the Patent Act of 1793; they first appear in the 1836 Act. Prior to the 1836 Act, however, patent attorneys . . . began to include claim-type language in the patent specification." Potashnik, *supra* note 3, at 869 (quoting R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA.L.REV. 1105, 1120 (2004)). "Patent claims, as we currently understand them, 'did not exist until the early 1800s, did not receive formal legal recognition until 1836, and were not required of all patentees until 1870.'" *Id.*

16. *Merrill v. Yeomans*, 94 U.S. 568 (1876).

17. *Phillips*, 415 F.3d at 1312 (quoting *Merrill*, 94 U.S. at 570).

18. *Phillips*, 415 F.3d at 1312 (quoting *White v. Dunbar*, 119 U.S. 47, 52 (1886)).

19. *See Phillips*, 415 F.3d at 1322 ("Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.") (quoting *Liebscher v. Boothroyd*, 258 F.2d 948, 951 (C.C.P.A. 1958)). *See also Vanderlande Indus. Nederland BV v. Int'l Trade Comm'n*, 366 F.3d 1311, 1321 (2004) ("a general-usage dictionary cannot overcome credible art-specific evidence of the meaning or lack of meaning of a claim term").

20. Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 HARV. J. L. & TECH. 179, 201 (2007) ("The difficulty is that the parties usually do not know in advance which words the court will eventually construe narrowly.") (citing *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1347-48 (Fed. Cir. 2001), in which "[t]he result . . . was a patent interpreted far more broadly than what the patentee actually described."). *Id.* at 202.

In most recent claim interpretation cases, courts have looked instead to intrinsic information first, including the specification and prosecution history, which have been resurrected from the “secondary role” in which they were placed after *Graver Tank*.<sup>21</sup> Using intrinsic interpretive tools leads to less abstract, and often narrower, claim interpretation.<sup>22</sup> Narrower claim interpretations work to the detriment of patentees in the sense that they will not receive such broad protection against infringement, but this intrinsic approach provides everyone involved with a higher level of predictability as to what information is encompassed by a particular claim.<sup>23</sup> This should aid patentees in drafting claims and should also help third parties to better avoid infringement.

*Phillips v. AWH, Corp.* suggests that U.S. courts should use a “person of ordinary skill in the art” standard, in which the court will interpret claims, in light of intrinsic evidence, from the perspective of a reasonable person skilled in the relevant art.<sup>24</sup> This modern standard is practically identical to the standard adopted by the House of Lords in

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21. Meurer & Nard, *supra* note 14, at 1966-67 (“The role of the patent claim . . . had become increasingly important by the time *Graver Tank* was decided. . . . The specification remained an important interpretive guide, but it was relegated to a secondary role . . .”). See also *Graver Tank & Mfg. Co., v. Linde Air Prod. Co.*, 339 U.S. 605, 613-14 (1950) (“We have held . . . that th[e] statute precludes invoking the specifications to alter a claim . . . , since ‘it is the claim which measures the grant to the patentee’”). For an example of a recent case in which the court returns to the specification as an interpretive tool, see *Phillips*, 415 F.3d at 1313 (the Federal Circuit stated that “the court starts the decision making process by reviewing the . . . patent specification and the prosecution history,” indicating the specification’s gain in importance) (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998)).

22. Potashnik, *supra* note 3, at 882 (“If courts focus on the . . . language of the specification, the patent claims . . . will be construed narrowly . . .”).

23. See Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigms*, 47 WM. & MARY L. REV. 49, 55-56 (2005) (describing the way in which narrow claim interpretation results in narrower patent scope, which decreases the likelihood of a finding of infringement). See also *Phillips*, 415 F.3d at 1323 (stating that patent scope will be more predictable when the terms contained in the patent are interpreted not using extrinsic sources like dictionaries, but rather using a reasonable person skilled in the art test). But see R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. PA. L. REV. 1105, 1142 (2004) (“Notwithstanding the fact that the procedural/holistic dichotomy does not map precisely onto a broad/narrow distinction, . . . the choice of a procedural methodological approach will, over the long run, yield . . . more predictable (and perhaps broader) claim constructions. . . .”). Wagner and Petherbridge argue that the use of extrinsic sources can lead to greater predictability in the long term.

24. *Phillips*, 415 F.3d at 1313 (“The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.”).

*Kirin-Amgen*, except that in *Kirin-Amgen*, the House of Lords treated the person reasonably skilled in the art standard as a substitute for any doctrine of equivalents or similar claim-broadening device.<sup>25</sup>

Prior to *Phillips*, in which the court attempts to clarify the importance of intrinsic versus extrinsic interpretive tools, conflict existed between the two methods of claim interpretation described above, and *Phillips* attempts to resolve this conflict.<sup>26</sup> The two conflicting canons of claim construction were as follows: “(a) that claims are to be interpreted in light of the specification or prosecution history, and (b) that claims may not be modified beyond their actual language by reference to the specification or prosecution history.”<sup>27</sup> The two methods were polarized, and there was little certainty or consistency with respect to which standard the court would choose in a particular case.<sup>28</sup> This inconsistency hindered the notice function of patent claims and was a source of confusion for inventors trying to draft patent claims that would best protect their work. Under the standards used in either *Kirin-Amgen* or *Phillips*, the first canon receives precedence over the second, thus eliminating any tension between them. This canon of construction is consistent with the holistic approach to claim interpretation, and is also consistent with interpreting patent claims from the perspective of a person having ordinary skill in the art, as it looks to the language used in the patent itself in order to interpret the claims.

The two canons of claim construction described above have become associated with two parallel approaches to claim interpretation.<sup>29</sup> The

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25. *Kirin-Amgen*, [2004] UKHL at ¶ 43 (“The solution . . . [is] to adopt a principle of construction which actually g[ives] effect to what the person skilled in the art would have understood the patentee to be claiming.”).

26. See *Phillips*, 415 F.3d 1303. See also, Potashnik, *supra* note 3, at 872-73 (“After *Markman*, a number of canons largely governed claim construction. . . . However, . . . many . . . of these canons are contradictory . . .”).

27. Potashnik, *supra* note 3, at 876.

28. See Wagner & Petherbridge, *supra* note 23, at 1161-62 (graphically depicting the lack of predictability among Federal Circuit judges with respect to the chosen methodology for interpreting patent claims). See also Cotropia, *supra* note 23, at 93 (calling for more consistency with respect to the methodology used by courts in interpreting patent claims); Potashnik, *supra* note 3, at 872 (“Practitioners have complained that these contradictions make ‘it difficult to provide your client clear guidance in terms of what their patent claims actually mean.’”) (quoting Christine Hines, *A Defining Moment for Patent Law: Court Mulls the Best Way to Interpret Patent Claims*, LEGAL TIMES, Aug. 9, 2004.)

29. See Potashnik, *supra* note 3, at 876-77. “[R]esolution of these canons ultimately resulted in two distinct claim construction approaches: the ‘holistic’ approach and the ‘procedural’ approach.” *Id.* at 876. See also Kristen Osenga, *Linguistics and Patent Claim Construction*, 38 RUTGERS L. J. 61, 105-06 (2006). “Many of the canons of claim construction



two approaches have come to be known as (1) the holistic approach, in which “claim terms must be read in view of the patent specification of which they are a part,”<sup>30</sup> and (2) the procedural approach, in which the “ordinarily understood meaning of the claim language” is “ascertained from dictionaries and encyclopedias.”<sup>31</sup> The holistic approach “moves away from the abstract “ordinary meaning” of a term in favor of . . . ” a narrower reading of the patent’s scope.<sup>32</sup> Conversely, the procedural approach results in a much broader interpretation of claims, less tailored to the four corners of the patent.<sup>33</sup> While patentees may favor the procedural approach when it gives them broader rights, the approach is less than ideal for third parties and results in less predictability for all parties, including the patentee seeking patent rights and protection.<sup>34</sup> For other inventors skilled in the art who wish to determine whether they will infringe a patent under the procedural interpretation method, they must read the patent claims in light of their “ordinary meaning” as found in a dictionary.<sup>35</sup> This means they must determine what the claims mean by researching dictionary definitions, treatises, encyclopedias, and the like, rather than simply drawing on their own expertise. Add to this the complication of guessing which method or extrinsic source a particular court will use in a given case and the situation can become frustrating, particularly for third parties trying not to infringe.<sup>36</sup>

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not only can be used in conjunction with the linguistic-based methodology”—analogous to the procedural approach referred to in this Note—“but in fact, some of them even bolster the validity of the process.” *Id.* at 105. One of the canons Osenga refers to as bolstering her approach to claim construction is that of interpreting the claims as narrowly as possible in conjunction with the “ordinary and customary meaning” of the word. *Id.* at 107.

30. Potashnik, *supra* note 3, at 876.

31. *Id.* at 876-77 (quoting David J.F. Gross & Theodore M. Budd, “We Have a Split Decision”: Analyzing the Internal Conflicts Within the Federal Circuit on the Issue of Claim Construction, 804 PRACTISING L. INST./PAT. LITIG. 55, 62 (2004)).

32. Potashnik, *supra* note 3, at 876 (quoting Gross & Budd, *supra* note 31, at 61).

33. *See id.*

34. *But see* Wagner & Petherbridge, *supra* note 23, at 1142.

35. *See, e.g.*, Brown v. 3M, 265 F.3d 1349, 1352 (Fed. Cir. 2001) (in which the court states that a dictionary is sufficient to determine the ordinary meaning of claim terms that are not terms of art); One World Techs., Ltd. v. Rexon Indus. Corp., 2006 WL 1155951, \*4 (N.D. Ill. 2006). “[T]he claim terms must be construed in light of their ordinary meaning, with the dictionary serving as one tool ‘that can assist the court in determining the meaning of particular terminology to those of skill in the art . . . .’” *Id.* at n.6 (citing *Phillips*, 415 F.3d 1303). Although, the court also points out that extrinsic sources should only be used after appraisal of information intrinsic to the patent specification). *Id.* at \*4. *See also* Osenga, *supra* note 29.

36. *Id.* *See also*, *Phillips*, 415 F.3d at 1321-22 (quoting *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880)).

When courts use the holistic approach, third parties skilled in the relevant art receive better notice of what material is protected by the patent claims because they can simply read and interpret the patent based on their own knowledge of the art and based on materials available to themselves and the patentee. While the holistic approach generally leads to narrower claim interpretations, and is thus favorable to third parties and other inventors in the sense that they will still have access to the information excluded from the patentee's bundle of IP rights, it does provide some protection to the patentee as well. Just as others skilled in the art may read the patent claims according to their knowledge and expertise, patentees may *draft* the claims according to their knowledge and expertise, eliminating difficulties that may arise for them when they try to draft their claims in a way that is more consistent with extrinsic sources of information. Claim drafting is arguably more difficult when courts take this approach to interpreting claims because there is no objective way of determining how the court will interpret the claims, but this approach allows courts to interpret claims in a way that is less rigid and potentially more consistent with the way another skilled in the relevant art might interpret them.<sup>37</sup> The holistic approach is meant to give effect to the true intent of the patentee at the time the patent was drafted and also allows the courts some flexibility in their interpretations of patent claims.<sup>38</sup>

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[I]t is inevitable that the multiple dictionary definitions for a term will extend beyond the "construction of the patent [that] is confirmed by the avowed understanding of the patentee . . . when his application for the original patent was pending." . . . Thus, the use of the dictionary may extend patent protection beyond what should properly be afforded . . . .

*Id.*

37. *But see* Crissa A. Seymour Cook, Comment, *Constructive Criticism: Phillips v. AWH Corp. and the Continuing Ambiguity of Patent Claim Construction Principles*, 55 U. KAN. L. REV. 225, 261 (2006).

[T]he 'holistic approach' . . . promotes neither innovation nor certainty. With no set standard, inventors and patent attorneys . . . will spend considerable time drafting patent documents in anticipation of the different judges they may encounter . . . . They must attempt to draft documents in such a way that everyone imaginable clearly understands what is being claimed.

*Id.* See also Ruoyu Roy Wang, *Texas Digital Systems v. Telegenix, Inc: Toward a More Formalistic Patent Claim Construction Model*, 19 BERKELEY TECH. L. J. 153, 170 (2004). Formalism—as in the procedural approach—"promotes patentees' ability to plan and . . . to gravitate toward a more uniform dictionary-oriented set of draft language." *Id.* "The hallmark of formalism is its predictability . . . , which also opens it to the criticism of being wooden and mechanical." *Id.*

38. See Wagner & Petherbridge, *supra* note 23, at 1142 ("[T]he holistic approach, by offering substantially greater flexibility, allows more opportunities for judges to tailor claim construction analyses according to other critical issues in the case, such as infringement or

The conflict between the two approaches to claim interpretation bears on the doctrine of equivalents because the doctrine of equivalents extends patent rights where claims are written or construed too narrowly to provide literal protection to the patentee. Where dictionary definitions used in the procedural approach to claim interpretation prove inadequate to describe the patentee's intentions, or where the holistic approach falls short because the patentee did not draft his claims broadly enough, patentees turn to the doctrine of equivalents to protect against infringement retroactively. For reasons discussed below, the doctrine of equivalents leads to more and different problems, particularly for those who wish to compete with the patented device.<sup>39</sup> Where the doctrine of equivalents has become an "unworkable" system due to its tendency to create over-broad patent rights and unpredictable results,<sup>40</sup> the holistic approach to claims interpretation as described in *Phillips* offers a workable system, in which patentees receive the patent rights they intended to claim, competitors have a clearer idea of what is protected under the patent, and the doctrine of equivalents is not necessary.

*B. The Development of Problems with the Doctrine of Equivalents*

The doctrine of equivalents arose from a desire to treat patentees fairly when the literal language of their claims failed to adequately capture the scope of their inventions.<sup>41</sup> Unfortunately, introduction of the doctrine of equivalents created the same ambiguity in claim interpretation that courts tried to avoid in espousing abstract claim

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validity." See also *Phillips*, 415 F.3d at 1312-15.

39. See *Festo*, 234 F.3d at 576 ("[T]he doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.") (citing *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997)). See generally Allan G. Altera, *Expanding the Reissue Procedure: A Better Way to Do Business*, 1 J. INTELL. PROP. L. 185, 186 (1993), Quillen, *supra* note 12, at 234, and Sarnoff, *supra* note 12, at 1157 (describing the problems associated with the doctrine of equivalents).

40. See *supra* note 39.

41. See Erin Conway, *The Aftermath of Festo v. SMC: Is There "Some Other Reason" for Justifying the Third Festo Rebuttal Criterion?*, 82 CHI. KENT L. REV. 1655, 1677 (2007) ("[T]he foundation of the doctrine of equivalents lies in the idea that limiting a patent claim's scope to its literal interpretation offers little protection to the patentee.") (citing Brief for the United States as Amicus Curiae, *Festo VIII*, 535 U.S. 722 (No. 00-1543), 2001 WL 1025650). See also *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 693 (2d Cir. 1948) ("[A] boundary cannot be drawn with precision; and the draftsman of claims is always in something of a dilemma . . . which has led to the . . . 'doctrine of equivalents' . . .").

interpretation (the procedural approach discussed above).<sup>42</sup> The doctrine of equivalents allows broader patent scope to patentees, but it has “taken on a life of its own,”<sup>43</sup> depriving the public of the notice function claims were originally intended to serve and making it almost impossible to predict exactly what will infringe existing patents.<sup>44</sup> Additionally, the doctrine of equivalents hinders competition by granting rights to patentees in after-arising technologies and other intellectual property that could not possibly have been included in the original claim language.<sup>45</sup> In such cases, new technology arises that is similar to, or in some cases based on, existing technology that has already been patented. The existing patent-holder may then claim that the new technology is so similar to his already-patented product that it effectively infringes his patent. In this way, the doctrine of equivalents suppresses new technology, and competitors are dissuaded from entering the market for fear that their inventions will infringe existing patents under the doctrine of equivalents.<sup>46</sup>

In order to remedy the murky situation surrounding the modern doctrine of equivalents, many have suggested eliminating, or at least overhauling, the doctrine and starting from scratch.<sup>47</sup> In the United Kingdom, the House of Lords has determined that the costs of the doctrine of equivalents (and similar interpretive tools) outweigh the benefits.<sup>48</sup> In *Kirin-Amgen*, the House of Lords determined that in order to avoid the situation U.S. courts face with the doctrine of

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42. See *Warner-Jenkinson*, 520 U.S. at 21 (“[T]he doctrine [of equivalents] is not free from confusion.”). See generally Collins, *supra* note 12, at 294, 300 (describing the lack of predictability and consistency in application of the doctrine).

43. *Warner-Jenkinson*, 520 U.S. at 28-29 (“[T]he doctrine of equivalents, as it has come to be applied since *Graver Tank*, has taken on a life of its own, unbounded by the patent claims.”).

44. *Id.*

45. See Sarnoff, *supra* note 12, at 1194-95. “[T]he expanded and uncertain scope of patent protection results in reduced levels of competition, which results in higher prices . . . and fewer beneficial alternatives . . .” *Id.* at 1198. But see Meurer & Nard, *supra* note 14 at 1954-55 (“Although critics of the [doctrine of equivalents] contend that the doctrine unduly inhibits competition, surprisingly, we show that often the degree of competition is unaffected by the presence or absence of the [doctrine of equivalents].”).

46. See Altera, *supra* note 39, at 197 (explaining why the patent reissue procedure is a better way to “promote the useful arts”); Quillen, *supra* note 12, at 234-35, n.84 (describing some of the difficulties to innovators who must defend against doctrine of equivalents claims); Sarnoff, *supra* note 12, at 1157 (“The modern doctrine of equivalents lacks theoretical justification, imposes high costs on society, and likely impedes innovation.”).

47. See *Warner-Jenkinson*, 520 U.S. at 21 (“Petitioner . . . invites us to speak the death of [the doctrine of equivalents] . . .”). See also *supra* note 46.

48. See *Kirin-Amgen, Inc.*, [2004] UKHL 46.

equivalents it would devise a new approach to claim interpretation.<sup>49</sup> The justices reasoned that the doctrine of equivalents is only necessary where courts use literal claim interpretation to define patent scope (akin to our procedural approach),<sup>50</sup> so they devised a reasonableness standard to replace literal claim interpretation, which is very similar to the holistic approach adopted by the Federal Circuit in *Phillips*.<sup>51</sup> Their “reasonable person” is defined as a “reasonable person *skilled in the art*” (emphasis added) (analogous to the “person of ordinary skill in the art” in *Phillips*),<sup>52</sup> and each claim is to be interpreted in the context of the entire patent document, defined in the way a reasonable person skilled in the art would define the claim.<sup>53</sup> This approach parallels the first canon of construction described above,<sup>54</sup> which is the focus of the holistic approach to claim interpretation, whereby the court must look to the language used in the patent itself (e.g., the specification and prosecution history) to fully and accurately interpret the claims.<sup>55</sup> The House of Lords intended for the new standard both to provide patentees with some predictability as to what the scope of their patents

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49. *Id.* at ¶¶ 41, 43.

It seems . . . that both the doctrine of equivalents in the United States and the pith and marrow doctrine in the United Kingdom were born of despair. . . . The solution . . . [is] to adopt a principle of construction which actually g[ives] effect to what the person skilled in the art would have understood the patentee to be claiming.

*Id.*

50. *Id.* at ¶ 42.

If literalism stands in the way of construing patent claims so as to give fair protection to the patentee, there are two things that you can do. One is to adhere to literalism in construing the claims and evolve a doctrine which supplements the claims by extending protection to equivalents. That is what the Americans have done. The other is to abandon literalism.

*Id.*

51. *Id.* at ¶¶ 41-43.

52. *Phillips*, 415 F.3d at 1313; *Kirin-Amgen, Inc.*, [2004] UKHL at ¶ 48.

53. *Kirin-Amgen, Inc.*, [2004] UKHL at ¶ 47.

What principle of interpretation would give fair protection to the patentee? Surely, a principle which would give him the full extent of the monopoly which the person skilled in the art would think he was intending to claim. And what principle would provide a reasonable degree of protection for third parties? Surely again, a principle which would not give the patentee more than the full extent of the monopoly which the person skilled in the art would think that he was intending to claim.

*Id.*

54. See *supra* Part I.A. for a description of this canon of construction.

55. See generally Wagner & Petherbridge, *supra* note 23 (describing at length the holistic and procedural approaches to claim interpretation); Potashnik, *supra* note 3, at 876-78 (defining the holistic approach).

will be and to provide the public and others skilled in the relevant art with notice of what information the patent actually protects.<sup>56</sup>

The doctrine of equivalents arose out of a desire to treat patentees fairly.<sup>57</sup> Courts believed that “inventor[s] deserve[d] a property right in [their] invention[s]” and that infringers should not benefit from overly narrow claim interpretation.<sup>58</sup> U.S. courts created the doctrine of equivalents when they decided the case *Winans v. Denmead*.<sup>59</sup> In *Winans*, “the majority was . . . concerned with the fair treatment of the inventor and punishing the putative unscrupulous behavior of the infringer.”<sup>60</sup> However, the dissent in *Winans* expressed concern that the social costs of the broad patent scope created by the doctrine of equivalents would outweigh any benefits.<sup>61</sup> Nearly a century later, in *Graver Tank*, the debate continued, as the Court delivered another split opinion upholding the doctrine of equivalents, but in which the dissent cited its social costs.<sup>62</sup>

In more recent U.S. cases, courts used the doctrine of equivalents to protect patentees’ intellectual property rights in the event of drafting errors,<sup>63</sup> in the event language proved inadequate to capture their

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56. *Id.* See also *Kirin-Amgen, Inc.*, [2004] UKHL at ¶¶ 71-72 (stating that a procedural approach to claim interpretation provides no more certainty than does the “reasonable person skilled in the art” standard outlined in this case).

57. See Meurer & Nard, *supra* note 14, at 1959 (In describing the first significant U.S. doctrine of equivalents case, *Winans v. Denmead*, the authors state that “the majority was . . . concerned with the fair treatment of the inventor . . .”). See also *supra* notes 41 and 53.

58. Meurer & Nard, *supra* note 14, at 1956.

59. *Id.* at 1959.

60. *Id.* See also *Winans v. Denmead*, 56 U.S. 329, 342-43 (1853) (where the Court describes its rationale for protecting patents under the doctrine of equivalents).

61. *Winans*, 56 U.S. at 347 (Campbell, J., dissenting) (“Nothing, in the administration of this law, will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of [the] . . . requisitions of the act of Congress [by espousing a doctrine of equivalents].”). See also Meurer & Nard, *supra* note 14, at 1959 (“[T]he dissent in *Winans* was uneasy about the social costs of broad patent scope . . .”).

62. *Graver Tank & Mfg. Co.*, 339 U.S. at 614 (Black, J. and Douglas, J., dissenting) (“[I]t is unjust to the public, as well as an evasion of the law, to construe [the claim] in a manner different from the plain import of its terms.”) (citing *White v. Dunbar*, 119 U.S. 47, 52 (1886)); Meurer & Nard, *supra* note 14, at 1967 (describing the significance of *Graver Tank* in the development of doctrine of equivalents jurisprudence).

63. See, e.g., *In re Wilder*, 736 F.2d 1516, 1519 (Fed. Cir. 1984) (where a patent attorney is called upon during an infringement action to explain why certain information was left out of the claims during the drafting process). See also Meurer & Nard, *supra* note 14, at 1968-69 n.107 (describing the friction theory justification for the doctrine of equivalents, whereby the doctrine protects the scope of a patentee’s rights despite difficulties that arose during the drafting stage, among other stages, of the process of writing the patent) (citing Martin J.

ideas,<sup>64</sup> or in the event that they were simply unable to foresee an after-arising equivalent.<sup>65</sup>

On the other hand, recent United Kingdom cases have moved away from any doctrine of equivalents or similar interpretive tool, instead espousing a new approach to claim interpretation that renders the doctrine of equivalents unnecessary.<sup>66</sup> Rather than focus on the literal meaning of the words in the claims, the House of Lords, in cases like *Kirin-Amgen*, chose to focus instead on the meaning of the words to a person reasonably skilled in the art.<sup>67</sup> In conjunction with this new interpretation standard, U.K. courts have ceased using the doctrine of equivalents to supplement claim interpretation in order to avoid the unpredictability and other social costs associated with broader claim interpretation.<sup>68</sup> They argue that their new interpretive standard eliminates the need for a claim-broadening device like the doctrine of equivalents because it puts the focus on the patentee's intent when he drafted the patent claims.<sup>69</sup> This should enable the patentee to draft

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Adelman & Gary L. Francione, *The Doctrine of Equivalents in Patent Law: Questions that Pennwalt Did Not Answer*, 137 U. PA. L. REV. 673, 711 (1989) (“Most frequently, patent holders use the doctrine of equivalents to rectify . . . a ‘mistake’ in the process of drafting . . . the application . . . . The patent holder argues that the failure to include something in the claim was an oversight.”).

64. See, e.g., *Festo*, 234 F.3d at 622 (“In addition to the inexact fit caused by the inherent limitations of language, the language itself may not be adequately developed at the early stages when patent applications . . . are filed . . . .”); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967) (“Often the invention is novel and words do not exist to describe it.”); see also *Meurer & Nard*, *supra* note 14, at 1969-70 (citing both of the above cases and describing the “Limitations of Language” justification for the doctrine of equivalents).

65. See e.g., *Festo*, 234 F.3d at 619 (“[T]he doctrine of equivalents accommodates [an] unforeseeable dilemma for claim drafters.”); *Warner-Jenkinson*, 520 U.S. at 37 (where the Court recognizes the validity of application of the doctrine of equivalents to include after-arising technologies in a patent claim); see also *Meurer & Nard*, *supra* note 14, at 1970 (“[P]atent prosecutors are not expected to claim unforeseeable equivalents.”). But see *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) (“[I]t is the patentee who must bear the cost of its failure to seek protection for [a] foreseeable alteration of [the] claimed structure.”).

66. See, e.g., *Kirin-Amgen, Inc.*, [2004] UKHL at ¶¶ 37-42 (stating that it is better to find a new way of interpreting claims than to continue to broaden them using the doctrine of equivalents).

67. *Id.* at ¶ 41.

68. *Id.* at ¶ 39 (“[O]nce the monopoly ha[s] been allowed to escape from the terms of the claims, it is not easy to know where its limits should be drawn.”). See *LB Europe Ltd. v. Smurfit Bag in Box SA*, [2007] EWHC 510, ¶¶ 51-52, for an example of a recent UK case in which the principles of claim construction laid out in *Kirin-Amgen* were followed.

69. See *Kirin-Amgen, Inc.*, [2004] UKHL at ¶ 30.

[T]he author of a . . . patent specification is using language to make a

better claims, and it should also enable all concerned parties to better predict what the scope of the claims will be before they even reach a court. With U.S. cases like *Phillips* that address claim interpretation by adopting the same “reasonable person skilled in the art” standard created by the House of Lords in *Kirin-Amgen*, U.S. courts have taken a step toward abolishing the doctrine of equivalents.<sup>70</sup>

## II. THE CASES

### A. *Phillips v. AWH, Corp.*

In *Phillips v. AWH, Corp.*, Edward Phillips, inventor of a security wall design used in prisons, accused AWH, Corp., along with several other defendant companies, of using his patented design after their license agreement had expired.<sup>71</sup> Phillips’s invention was a fire-resistant and bulletproof wall to be used mainly in prisons, but also in other facilities where such security measures might be necessary.<sup>72</sup> AWH, Corp.—which had contracted with Phillips to use his wall design for a number of years—continued to use a wall with interior baffles, much like the one Phillips developed, after their license agreement expired.<sup>73</sup> The question of whether AWH’s design infringed Phillips’s patent centered on the angle of the baffles within the walls.<sup>74</sup> AWH used walls with ninety-degree baffles, while Phillips’s patent claims only described baffles at angles other than ninety degrees.<sup>75</sup>

In the process of interpreting Phillips’s patent claims, the court analyzed the merits of using extrinsic, as opposed to intrinsic, sources in order to define the terms of the claims.<sup>76</sup> The court concluded that intrinsic sources (i.e., the specification and prosecution history) take precedence over extrinsic sources, contradicting some prior case law that relied more heavily on things like dictionary definitions.<sup>77</sup> By

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communication for a practical purpose and that a rule of construction which gives his language a meaning different from the way it would have been understood by the people to whom it was actually addressed is liable to defeat his intentions.

*Id.*

70. *See, Phillips*, 415 F.3d at 1318.

71. *Phillips*, 415 F.3d at 1309.

72. *Id.*

73. *Id.*

74. *Id.* at 1310.

75. *Id.*

76. *Phillips*, 415 F.3d at 1317-23.

77. *Id.* at 1320-24 (specifically, the court addresses the assertion of the court in *Texas Digital Systems* that there should be a presumption in favor of interpreting a word according



placing such a high level of importance on intrinsic over extrinsic sources, the court effectively adopted the holistic approach to claim interpretation (and the first canon of claim construction listed above) as the preferred interpretive method for the Federal Circuit. The court in *Phillips* insisted that the specification and prosecution history offered the best explanations of the claim terms in light of the patentee's intentions, and in light of the way in which "a person of ordinary skill in the art" would interpret them.<sup>78</sup>

The court not only emphasized the importance of intrinsic sources of information as interpretive tools, but also developed a standard by which courts should interpret the words of the patent.<sup>79</sup> According to *Phillips*, courts should interpret claim language as would a person of ordinary skill in the art.<sup>80</sup> By defining this as the standard for claim interpretation, the court did two things: (1) it created a standard objective enough that it can be applied consistently and provide notice to other inventors, thus encouraging and fostering competition; and (2) it provided a fair interpretation standard for patentees that will allow them to draft patent claims using familiar language.<sup>81</sup>

Although the doctrine of equivalents was not at issue in this case, and was not directly addressed by the court, the court made clear that it wishes to prevent the kind of over-broad claim interpretation that often results when the doctrine of equivalents comes into play.<sup>82</sup> While some fear that emphasis on intrinsic materials in claim interpretation will generally lead to narrower patent rights, the focus on intrinsic

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to its dictionary definition and that extrinsic sources are the primary tool of claim interpretation, supplemented by intrinsic sources like the specification).

78. *Id.* at 1313.

79. *Id.*

80. *Id.* (quoting *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004)) ("‘customary meaning’ refers to the ‘customary meaning in [the] art field’"). "[P]atents are addressed to and intended to be read by others of skill in the pertinent art." *Id.*

81. *Id.* "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *Id.* *But see* Cotropia, *supra* note 23, at 118-20 (describing the ways in which use of intrinsic sources lead to more competition, but narrower patent rights); Wagner & Petherbridge, *supra* note 23, at 1112-13 (stating that the procedural approach to claim interpretation is more predictable than the holistic approach).

82. *Phillips*, 415 F.3d at 1321 ("The risk of systematic overbreadth is greatly reduced if the court instead focuses at the outset on how the patentee used the claim term in the claims, specification, and prosecution history, rather than starting with a broad definition . . .").

information in this case lead to a finding of infringement on the part of AWH, Corp.<sup>83</sup>

*B. Kirin-Amgen, Inc. v. Hoechst, Inc.*

In *Kirin-Amgen*, the House of Lords directly addressed the issue of whether there should be a doctrine of equivalents in U.K. patent law.<sup>84</sup> The case centered around two different methods of producing the protein erythropoietin (EPO) using recombinant DNA technologies.<sup>85</sup> Amgen produced the protein using exogenous genetic material, or material from outside the host cell, while Hoechst used endogenous genetic material with an exogenous promoter sequence.<sup>86</sup> This means that the promoter sequence used by Hoechst consisted of material from outside the cell and was meant to induce the cell to use *its own* EPO gene sequence to produce more of the desired protein. The House of Lords ultimately concluded that there was no infringement because the patent was invalid (due to over breadth and lack of novelty), but in drawing this conclusion, the justices analyzed the role of the doctrine of equivalents in interpreting patent claims.<sup>87</sup>

Hoechst's technology did not literally infringe the claims of Amgen's patent.<sup>88</sup> However, Amgen argued the House of Lords should find infringement anyway because a reasonable person skilled in the art would have understood their claims to include Hoechst's method.<sup>89</sup> While the House of Lords disagreed with the conclusion of infringement, they embraced the "reasonable person skilled in the art standard."<sup>90</sup> The House of Lords ruled that the claims should be interpreted with their audience in mind.<sup>91</sup> The audience to whom the claims are addressed is part of the context of the claims, and the claims should be interpreted as this audience would likely interpret them, based on its knowledge of the particular field involved. The justices suggested that this standard would eliminate the need for a doctrine of

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83. *Id.* at 1328. See Cotropia, *supra* note 23, at 119 (describing the way in which use of intrinsic sources to interpret patent claims fosters competition at the same time that it leads to narrow interpretation of claims); Wagner & Petherbridge, *supra* note 23, at 1113 ("[E]vidence suggests that the procedural approach is inherently more consistent than holistic analyses.").

84. *Kirin-Amgen, Inc.*, [2004] UKHL at ¶ 36.

85. *Id.* at ¶¶ 8-11.

86. *Id.* at ¶ 11.

87. *Id.* at ¶¶ 36, 132.

88. *Id.*

89. *Kirin-Amgen, Inc.*, [2004] UKHL 46 at ¶ 17.

90. See *id.* at ¶¶ 41-42.

91. *Id.* at ¶ 41.

equivalents because the knowledge and experience of those skilled in the art should encompass any equivalent technologies already in existence.<sup>92</sup> This means the standard would not encompass after-arising technologies.

In creating such a standard and finding no doctrine of equivalents, this opinion, like *Phillips*, does two things: (1) provides an objective standard that will give the patentee and other inventors notice and some degree of predictability with respect to result; and (2) allows patentees to draft claims using common sense and language with which they are familiar.<sup>93</sup> The court's standard accomplishes these goals by providing a rule that is specially catered to those who will be reading the claims. Under this standard, persons skilled in the relevant art may rely on their knowledge in order to determine whether they will infringe existing patents, rather than attempting to understand complex rules of construction or dictionary definitions that might differ from their own understanding of the material. It will allow persons skilled in the relevant art to predict what materials the court will use to interpret existing patent claims (generally, materials intrinsic to the patent, such as the specification), and it will help them know the limits of a patent so they can avoid infringement.

By tailoring its interpretation toward those skilled in the art, the House of Lords' decision also protects patentees. Patentees are members of the category, "persons skilled in the relevant art." They may also use their knowledge of the art to more skillfully construct claims and to better understand the limits of their patents. While this standard will often lead to narrower claim interpretations than the doctrine of equivalents would allow, patentees and third parties alike should have a better idea of what material is protected by the claims, what material is still available for use by all, and how to better draft patent claims to encompass all relevant material.

### III. SIMILARITIES BETWEEN *PHILLIPS* AND *KIRIN-AMGEN* AND BENEFITS OF ELIMINATING THE DOCTRINE OF EQUIVALENTS

#### A. *Similarities between the Cases*

The standards used by the House of Lords in *Kirin-Amgen* and the Federal Circuit in *Phillips* are strikingly similar. Both rely on the

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92. *Id.* at ¶ 49.

93. *Id.* at ¶¶ 36-44.

perspective of “persons reasonably skilled in the art” (or the “person having ordinary skill in the art”) in order to create a more objective, reliable, and fair way of interpreting patent claims.<sup>94</sup> Although the cases occur on different continents, and although *Phillips* does not directly address the doctrine of equivalents, the concerns addressed by each case are also strikingly similar. Both seek to provide clarity for patentees and others skilled in the art by developing a standard by which patent claims may be interpreted—and they offer this clarity in almost the same way.<sup>95</sup>

In *Kirin-Amgen*, the “reasonable person skilled in the art” standard allowed the House of Lords to derive fair results when interpreting patent claims. For them, the standard struck a balance between the property rights of the patentee and the need to provide third parties with adequate notice.<sup>96</sup> The justices in *Kirin-Amgen* determined that this standard eliminated the need for a doctrine of equivalents because it adequately protected the patentee’s interests.<sup>97</sup> The court in *Phillips* did not go so far as to state that the “person having ordinary skill in the art” standard would eliminate the need for an American doctrine of equivalents, but, in effect, it does just that. By adopting essentially the same standard used by the House of Lords in *Kirin-Amgen* for claim interpretation, the court in *Phillips* created a way to balance the interests of patentees and third parties while ensuring that the patent rights granted would not be too broad.

### B. Benefits of Eliminating the Doctrine of Equivalents

Eliminating the doctrine of equivalents will benefit patent law in several ways: (1) it will enhance competition by creating greater predictability for inventors seeking to enter the market as to whether they will infringe prior art;<sup>98</sup> (2) it will provide better notice to the public

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94. *Phillips*, 415 F.3d at 1313; *Kirin-Amgen, Inc.*, [2004] UKHL at ¶ 43.

95. *Phillips*, 415 F.3d 1303; *Kirin-Amgen, Inc.*, [2004] UKHL 46.

96. *Kirin-Amgen, Inc.*, [2004] UKHL at ¶¶ 30, 33.

[A] rule of construction which gives [a patentee’s] language a meaning different from the way it would have been understood by the people to whom it was actually addressed is liable to defeat his intentions. . . . [Another inventor] reads the specification on the assumption that its purpose is both to describe and to demarcate an invention . . . and not to be a textbook . . .”

*Id.*

97. *Id.*

98. See generally Quillen, *supra* note 12, at 210 (describing the way in which narrower, more predictable patent claim interpretation will foster innovation); Sarnoff, *supra* note 12, at 1198 (“[T]he expanded and uncertain scope of patent protection results in reduced levels of

and to others skilled in the art of what information patents cover;<sup>99</sup> and (3) it will create more consistency in court opinions because courts will use a more reliable standard.<sup>100</sup>

The doctrine of equivalents allows courts to expand patent rights beyond the scope of the claim language where the infringing technology “performs substantially the same function in substantially the same way for the same purpose” as the original invention.<sup>101</sup> The doctrine is ambiguous in that there is no objective way of determining when something is similar enough to an existing invention to warrant expanded protection, and there is no way of determining exactly how far to extend a patentee’s rights. The ambiguity makes it almost impossible for competitors to predict when their inventions will infringe prior art as after-arising technologies. This uncertainty discourages innovation and makes it less likely that competing inventors will invest in improving or expanding existing products.<sup>102</sup> This disadvantage would be eliminated if courts abandoned the doctrine of equivalents for a more objective standard like the one articulated above in *Kirin-Amgen* and *Phillips*. The “person reasonably skilled in the art” standard allows third parties to better predict when they will infringe on prior art and encourages technological growth and innovation by reassuring competitors they will not be sued for infringement.

The clarity provided by using the new standard will also ensure that the public and others skilled in the art receive adequate notice of what is included in the prior art. Notice was meant to be one of the primary functions of patents, aside from protecting inventors’ intellectual property rights.<sup>103</sup> If third parties can better discern the boundaries of a patentee’s rights, they will also be on notice as to what information is off limits and what information is already protected and/or owned by

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competition . . .”).

99. See generally Sarnoff, *supra* note 12, at 1215 n.225 (“There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.”) (quoting *Warner-Jenkinson*, 520 U.S. at 29).

100. See Sarnoff, *supra* note 12, at 1212-13 (describing ways in which the doctrine of equivalents makes patent scope less predictable than a simple reading of the claims).

101. See *Graver Tank*, 339 U.S. at 608 (“a patentee may invoke [the doctrine of equivalents] . . . ‘if [the device] performs substantially the same function in substantially the same way to obtain the same result’”) (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

102. See *supra* note 99.

103. 35 U.S.C. § 112 (2006) (“The specification shall contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . .”). See also *supra* note 100.

another. This should avoid unnecessary infringement suits while promoting innovation, as inventors should be better able to determine the limits of prior art.

Finally, the clarity provided by the “person reasonably skilled in the art” standard will benefit everyone involved in the practice of patent law by creating greater consistency in court opinions. When courts follow a standard that is more reliable and easier to define, such as *Phillips’s* person of ordinary skill in the art standard, they can create a consistent body of law. Not only is it easier to follow a consistent body of law than an inconsistent one, but also it is easier for interested parties to predict the outcome of cases that come before the courts in the future.

### *C. Other Options Available to Patentees for Broadening Claims*

Abandonment of the doctrine of equivalents would not eliminate all options for those inventors whose claims were effectively infringed by a similar invention. Reissue proceedings could offer an alternative to doctrine of equivalents protection.<sup>104</sup> Under a reissue proceeding, the patentee may seek retroactive protection for certain aspects of his invention not claimed in the original patent.<sup>105</sup> Effectively, reissue proceedings can broaden a patent’s claims in a way similar to the doctrine of equivalents, except the proceeding is codified in statute and is statutorily restricted.<sup>106</sup> The reissue proceeding would not broaden a patent’s claims to the same extent as the doctrine of equivalents, and it would not allow for inclusion of after-arising technologies into the scope of the patent, thus eliminating some of the major issues with the doctrine of equivalents.<sup>107</sup> Perhaps if American courts abandon the

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104. 35 U.S.C. § 251 (2006). Meurer & Nard, *supra* note 14, at 1955 (“We begin by embracing the reissue proceeding as an alternative to the [doctrine of equivalents].”). Meurer & Nard favor the reissue proceeding and discuss its advantages at length, calling it “an under-utilized proceeding that has many of the advantages of the [doctrine of equivalents] with relatively few of its drawbacks.” *Id.* See also Richards et al., *supra* note 13, at 740-45 (discussing ways in which the reissue proceeding can be improved to make it a better alternative to prosecution history estoppel and the doctrine of equivalents).

105. 35 U.S.C. § 251.

106. *Id.*

107. *Id.* See also Meurer & Nard, *supra* note 14, at 1995 (“[R]eissue ‘adequately protects patentees from “fraud,” “piracy,” and “stealing,” [while] ‘also protect[ing] businessmen from retroactive infringement suits and judicial expansion of a monopoly sphere beyond that which a patent expressly authorizes.’”) (quoting *Graver Tank*, 339 U.S. at 615 (Black, J., dissenting)).

doctrine of equivalents, reissue proceedings will become more common and will offer further protection for patentees' rights.<sup>108</sup>

*D. Many Still Favor the Doctrine of Equivalents*

Many believe that by eliminating the doctrine of equivalents, courts will no longer provide adequate rights to patentees who receive narrower patent scope.<sup>109</sup> Perhaps though, patent claims should not receive the scope they do under doctrine of equivalents law. Perhaps by broadening the patentees' rights to such a large extent, courts have begun to infringe the rights of third parties who cannot predict when their own inventions will infringe prior art and who may therefore refrain from investing in innovation in the first place.

Some may also doubt whether this new standard will actually provide more objectivity in practice than when courts tried to apply the doctrine of equivalents.<sup>110</sup> When courts apply any standard, no matter how straightforward the standard may be, there is some variation as to how the standard will be interpreted and applied. Despite this unavoidable fact, the "person of ordinary skill in the art" standard will provide more predictability for both patentees and third parties because the patent claims would be read and interpreted from their perspective as experts in the field.<sup>111</sup> Inventors will no longer need to try to determine which source the courts will use in interpreting their claims, which canon of construction they will favor, or whether they will adopt the holistic approach or the procedural approach to claims interpretation. Instead, inventors may simply use language with which they are familiar, both in drafting their own patent claims and in interpreting the claims of others. Patentees can better predict that courts will interpret the claims in accordance with their intentions, and

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108. See Meurer & Nard, *supra* note 14, at 1955 ("Reissue . . . is an under-utilized proceeding that has many of the advantages of the [doctrine of equivalents] with relatively few of its drawbacks.").

109. See, e.g., Conway, *supra* note 41, at 1659 ("[R]estricting the patent to the subject matter literally contained within the claims can turn a patent into 'a hollow and useless thing.'" (quoting *Graver Tank*, 339 U.S. at 607). The courts have also repeatedly upheld the doctrine, despite the controversy that has surrounded it since its inception. R. CARL MOY, *MOY'S WALKER ON PATENTS*, § 13:33 (2007) (providing background and history surrounding the court's decision in *Festo*).

110. See, e.g., Wagner & Petherbridge, *supra* note 23, at 1112-13 (stating that the procedural approach to claim interpretation is more objective).

111. *Phillips*, 415 F.3d at 1313 ("The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation.").

competing inventors can better predict that courts will interpret the claims in the same way they would interpret them. In this way, the standard will provide more consistency in court opinions and better notice to interested parties.

Some have also argued there is a social benefit gained from the doctrine of equivalents because it lessens the cost associated with refining patent claims.<sup>112</sup> This benefit applies to all inventors who apply for patent protection, but it impacts inventors of “pioneer inventions” most heavily.<sup>113</sup> Pioneer inventions provide the foundation from which many other inventors build and expand on the original ideas embodied in them. Some claim that without the doctrine of equivalents, inventors of pioneer inventions would need to invest too much of their resources into refining patent claims in order to prevent equivalent products from effectively stripping them of their patent rights.<sup>114</sup> Without extensive refinement, it would be too easy for others to develop a product very similar to, but still slightly different from, the original invention. The slight improvements in the later technology could render the pioneer invention obsolete, and without patent protection, pioneer inventors would have no way of protecting themselves against such equivalent products.

The doctrine of equivalents may provide this benefit in the limited instances of pioneer inventions, but, as stated above, the “person of ordinary skill in the art” standard should make the process of drafting claims more straightforward for the patentee. Inventors could rely on their expertise in drafting claims and could be more certain that their intentions would be honored by the courts. In addition, as stated above, there may be recourse for pioneer inventors in reissue proceedings as they refine and develop their new technologies. Further, granting patent rights in after-arising technologies may actually discourage competitors from entering the market and improving on prior art in the first place.<sup>115</sup> In this way, competition would benefit if there were no doctrine of equivalents.<sup>116</sup>

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112. See Meurer & Nard, *supra* note 14, at 1955-56 (stating that the doctrine of equivalents is socially beneficial when applied to new technologies).

113. *Id.* at 1989 (“Pioneer inventions should enjoy a presumption in favor of applying the [doctrine of equivalents].”).

114. See *id.*

115. See *id.* See also *supra* notes 41, 53, and 57.

116. Sarnoff, *supra* note 12, at 1171.



There is also the fear that this rule could lead to an increase in the costs of patent prosecution.<sup>117</sup> This rule should actually make patent prosecution easier for patentees because it will ensure that claims are interpreted according to the inventor's intentions and using the definitions most familiar to those skilled in the art. This means inventors could more easily draft claims that adequately express their ideas and could rely on the courts to interpret the claim in the way they intended them to be interpreted.

#### CONCLUSION

The doctrine of equivalents arose out of a desire to treat patentees fairly when courts construed claim language literally and narrowly, or where extrinsic interpretive devices failed to capture adequately the patentee's intentions when he drafted the patent claims.<sup>118</sup> As U.S. courts move away from procedural claim interpretation using extrinsic sources and toward the holistic approach, which places greater emphasis on intrinsic sources, the doctrine of equivalents will become unnecessary. Holistic claim interpretation, in conjunction with an interpretive method that places emphasis on the knowledge and expertise of those persons reasonably skilled in the relevant art, will ensure that patentees receive property rights consistent with their intentions in drafting the claims, will provide adequate notice to third parties, and will provide better consistency in court opinions interpreting patent claims. The new standard eliminates many of the costs to society created by extending patent claims through the doctrine of equivalents, while at the same time remedying those costs and providing its own benefits to the area of patent law.

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117. See Meurer & Nard, *supra* note 14, at 1970 (stating that without the doctrine of equivalents, patent prosecutors will have to be able to foresee more after-arising technologies and that this will drive up the cost of patent prosecution).

118. See *id.* at 1969 (describing the "limits of language" in capturing an inventor's meaning). See also Sarnoff, *supra* note 12, at 1173-96 (describing several justifications for the doctrine of equivalents).

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