

BOSTON
WASHINGTON
RESTON
NEW YORK
NEW HAVEN

www.mintz.com

*One Financial Center
Boston, Massachusetts 02111
617 542 6000
617 542 2241 fax*

*666 Third Avenue
New York, New York 10017
212 935 3000
212 983 3115 fax*

*701 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202 434 7300
202 434 7400 fax*

*11911 Freedom Drive
Reston, Virginia 20190
703 464 4800
703 464 4895 fax*

*157 Church Street
New Haven, Connecticut 06510
203 777 8200
203 777 7111 fax*

Client Alert

June 2001 (No. 2)

INTELLECTUAL PROPERTY

On Monday, June 18, 2001, the United States Supreme Court granted *certiorari* in the matter of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. (Festo)*, one of the most important recent patent rulings issued by the United States Court of Appeals for the Federal Circuit (Federal Circuit). The Federal Circuit ruled in *Festo* that a patent holder is not entitled to rely on the Doctrine of Equivalents if a claim amendment was made during prosecution to narrow the scope of a claim for reasons of patentability.

The Doctrine of Equivalents expands a patent holder's rights beyond the literal language of the patent claims so that a competitor cannot circumvent the patent by making insignificant changes to the claimed invention. *Festo* is significant because it likely will determine whether patents will be entitled to relatively broad or relatively narrow interpretation. This ruling may impact the value of patents in the future. Not surprisingly, the *Festo* decision has spawned two camps with strongly divergent views. Parties seeking to enforce patents generally oppose *Festo*, while those in favor of limiting patent rights support *Festo*.

Opponents of *Festo* assert that because many patent claims are amended during prosecution, the Federal Circuit's decision will unfairly limit the scope and value of patents by permitting parties to avoid patent claims by making insignificant changes to patented products or processes.

Advocates of *Festo*, however, argue that a patentee should be entitled to protection only to the extent that an invention is specifically claimed. They argue that a patentee desiring protection for equivalent features of an invention should claim each of the equivalents to provide adequate notice to the public of the scope of the patent.

Whether the Supreme Court will uphold *Festo*, overturn it, or choose a middle ground remains in question. There is little doubt, however, that businesses should pay careful attention to the outcome of this case.

Please contact James G. Gatto, David A. Temeles, Jr. or the Mintz Levin attorney who regularly handles your legal affairs if you would like additional information on how the *Festo* decision and other recent intellectual property developments may affect your business. Additionally, you may e-mail the firm at IP@mintz.com to register to receive periodic updates, alerts and in-depth analyses of important intellectual property issues such as the *Festo* decision.

James G. Gatto
703 464 8182
jggatto@mintz.com

David A. Temeles, Jr.
703 464 8151
datemeles@mintz.com