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Caveat Sender, Part 2: Unintentional Disclosure In Electronic Documents

In the first part of this article, we examined the various metadata that might be found in a Microsoft Word™ document, a format that is widely used throughout business, law and other fields. One of the most potentially damaging types of metadata we examined that might be found in a Word™ document comes from the track changes feature, which can innocuously embed within the document the additions and deletions of text made by the document's various authors. A person subsequently receiving that Word™ document, for example another party with which the authors are negotiating the final language of a contract, might then be

able to discover all the textual variations that the authors considered and then abandoned in favor of the final version of the document.

How then does one ensure that a Word™ file is cleansed of this metadata before it is sent to others? One method is through a feature in Word™ itself. Recognizing the many problems with embedding metadata into its files, Microsoft™ has now released an update to Word™. This update, which is available for free download, installs a new "Remove Hidden

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The Intersection of Trade Secrets and Patent Law: The Prior User Rights Statute, 35 U.S.C. § 273, Part I

Trade secret law and patent law have a common purpose: encouraging innovation to promote the progress of the useful arts. See *Kewanee Oil Corp. v. Bicron Corp.*, 416 U.S. 470 (1974). While a trade secret holder has a natural right to practice his or her invention, patent law provides that such right is subject to a patent owner's exclusive right. See *Bauer & Cie v. O'Donnell*, 229 U.S. 1, 10 (1913) and 35 U.S.C. § 271. Where an inventor is the first to invent particular subject matter but chooses trade secret protection instead of patent protection, depriving the inventor of this natural right to use the trade secret by operation of a subsequent but statutorily superseding patent can be a harsh and inequitable result. Such deprivation may have crippling financial consequences on the prior user if the subject matter at issue is part of a significant business activity, and ultimately creates an undesired disincentive to innovate.

The concept of prior user rights arose to ameliorate such results and provide more balance between the two bodies of law. In general, prior user rights protect the expectations and investments of prior users by providing prior users with a limited license to continue use of the later-patented invention. Part I of this article examines several important questions regarding the scope of the current prior user rights statute as set forth in 35 U.S.C. § 273. Part II of the article, scheduled for publication in an upcoming snippets™ issue, discusses the sufficiency of the current section 273 and some potential alternatives thereto.

Important Questions Regarding the Scope of § 273

A reading of section 273 and a review of its legislative history makes clear that a number

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Caveat Sender, Part 2: Unintentional Disclosure In Electronic Documents

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Data" item in the Word™ file menu. Upon completing a document, the author can select this option to remove the hidden metadata in a Word™ document prior to sending it to another person. Unfortunately, this option does not operate to automatically cleanse metadata from a Word™ document. It must be manually invoked. Since users are, after all, only human and prone to at least occasional omissions, this feature might not provide the desired level of protection against inadvertently disclosing metadata.

Realizing that publicly releasing Word™ documents is riddled with the potential for inadvertently disclosing metadata, businesses and other entities are adopting rules regarding the electronic disclosure of documents. One commonly adopted rule is: do not release electronic documents in the Word™ format. Adopting such a rule is a mechanism to prevent the inadvertent release of a Word™ file that has not been properly cleansed of its metadata. Of course, this immediately begs the question: what format should be used when releasing electronic documents?

One alternative to the Word™ format is the rich text format ("RTF"). This format allows for retaining the various formatting attributes of a document (e.g., fonts, underlining, margins, etc...), while allegedly not storing the potentially vast array of metadata found in Word™ documents. As RTF does not support many of the advanced features found in Word™, it is therefore generally considered a simpler format than Word™, but RTF still offers a wide array of features that are not found in the traditional text ("TXT") format. This makes RTF a potential alternative to

Word™. However, one only has to run a simple test to see that authoring a document using Word™ and saving it in the RTF format rather than the default Word™ format does not remove some of the most potentially dangerous metadata – that of the track changes feature.

What other document formats might be used as alternatives to Word™ and RTF? The emerging frontrunner is the Portable Document Format ("PDF") used by Adobe Acrobat™ and Adobe Reader™. PDF documents may be produced from a variety of different sources, such as directly from Word™ documents or from scanned hardcopies of documents. That is, a Word™ document might be directly converted to a PDF document, or a collection of hardcopies might be imaged through a scanner and compiled into a PDF document. This versatility to create PDF documents from a variety of different sources makes PDF an attractive tool.

But, does PDF provide any greater level of protection against releasing metadata than Word™? The answer is yes. While this format allows a user to knowingly embed a potentially large amount of metadata (e.g., comments, captions, searchable keywords, digital signatures, etc.) within a PDF document, only a small amount of metadata is automatically embedded within a PDF file. This metadata that is automatically embedded includes: the document's author, the date and time document was created, the date and time the document was last modified, the document's location and a small amount of other information. This is similar to the information that might be discovered about a Word™ document by simply clicking on the properties tab in the file menu. Thus, PDF does provide additional protec-

snippets

The advent of electronic document exchange has prompted the federal courts to begin adopting procedures for electronically storing case files and for even allowing attorneys to file documents via the Internet....And, most of these courts also allow attorneys to file documents electronically. What format does the [electronic filing] system mandate for electronically filed documents? PDF.

tion against inadvertently releasing potentially damaging metadata.

However, PDF users should be aware that there are two primary ways to create PDF files. One method creates an image of the document along with the text behind the document. A user can then use Adobe Acrobat™ as a word processing program – to print the document, to revise the text of the document, to copy portions from the document, to paste new material into the document or to make other such changes. Sending a person a PDF document through this method allows them to edit the document as if you had sent them a Word™ document or an RTF document. For various reasons, however, an author might not want to allow somebody to edit the document in this manner, such as to ensure that the document remains unchanged from its original state.

Adobe™ provides some protection against these types of changes. One primary method is to password protect the

document. This prevents a user from editing a document, thereby ensuring that the document remains in its original state. However, some versions of Adobe™ only use 40-bit encryption keys. Encryption keys can be discovered using a brute force method of trying all possible combinations, and for 40-bit encryption keys this process might take only a few days. One interested in breaking an Adobe™ password can look to online vendors that offer this service, or alternatively might purchase various commercially available password recovery programs.

The second primary method of creating a PDF file forgoes these problems by simply creating an image of the document without the underlying text. This is similar to converting directly to a JPEG, GIF or TIFF file. Or, in terms of a more common business practice, it is similar to faxing a copy of a document. The user only gets an image of the document, whose text cannot be directly edited. In this case, it might not be necessary to

even password protect the PDF document. However, failing to use the password might still allow the user to print the document or even edit the document by placing other graphical layers on top of the original image. However, the user would not be able to edit the original text as if the document were in a word processing program.

The advent of electronic document exchange has prompted the federal courts to begin adopting procedures for electronically storing case files and for even allowing attorneys to file documents via the Internet. Approximately forty-two district courts and seventy-two bankruptcy courts already have implemented the Case Management/Electronic Case Files (“CM/ECF”) system. And, most of these courts also allow attorneys to file documents electronically. The system is targeted to be implemented in appellate courts starting in late 2004. What format does the CM/ECF system mandate for electronically filed documents? PDF.

Metadata That Might Be in a Word Document

- Names of people who edited the document
- Date and time the document was created
- Date and time the document was last modified
- Total editing time for the document
- A revision log listing the past ten edits to the document and where the revisions were saved
- Text of previous versions of the document
- Text from other documents open when this document was saved

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The Intersection of Trade Secrets and Patent Law: The Prior User Rights Statute, 35 U.S.C. § 273, Part I

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of unanswered questions regarding the scope of this statute exist that the courts must ultimately resolve.

Does the statute only cover method claims?

Section 273(b)(1) provides an affirmative defense to patent infringement that may be asserted against an infringement claim involving “one or more claims for a method in [a] patent.” On its face, the statute appears to be available only as a defense to charges of infringement of method claims. However, the legislative history indicates that form should not be exalted over substance and that the technical form of a particular claim is not controlling. *See*, 145 CONG. REC. E1,789 (1999) (extension of remarks of Congressman Coble accompanying H.R. 1907). In fact, Senator Schumer went so far as to say that the first inventor defense of section 273 “is intended to protect both method claims and apparatus claims.” 145 CONG. REC. S14836, S14837 (1999). Thus, the term “method” in section 273 arguably may encompass claims drawn to an apparatus and/or system. This possibility raises the question of what claims are *not* within the scope of section 273. Unfortunately, that question’s answer likely must await the courts’ interpretation of this statutory provision.

What constitutes a “method of doing or conducting business”?

Like section 273(b)(1), section 273(b)(3)(A) states that the prior user defense may not be asserted unless the invention for which the defense is asserted is a “method.” Section 273(a)(3) defines the term “method” as meaning “a method of doing or conducting business.” Because there are, as yet, no cases

interpreting this statute, in attempting to ascertain what does and does not constitute a “method of doing or conducting business,” one can look only to the language of the statute and its legislative history.

Examining section 273 as a whole suggests that the phrase “method of doing or conducting business” should be given a broad interpretation to generally cover any business related activity. A contrary reading would render superfluous several of section 273’s other key statutory pro-

snippets

In general, prior user rights protect the expectations and investments of prior users by providing prior users with a limited license to continue use of the later-patented invention.

visions. For example, the statute states that the prior use must be a “commercial use” or that the “method” be “commercially used.” These terms are defined very broadly to include business related activities, both internal and external, having useful end results. Further, the statute also provides exceptions for pre-market-regulatory periods under 35 U.S.C. § 156(g) and use of “methods by non-profit research labs, hospitals and universities.” *See* 35 U.S.C. § 273(a)(1) & (a)(2). Because such subject matter is defined as a commercial use, it would seemingly fall under the definition of a method of doing or conducting business, otherwise the

clarifications of subsections (a)(1) and (a)(2) would be unnecessary.

Legislative history does not clearly resolve the issue of what constitutes a “method of doing or conducting business” within the meaning of section 273. On one hand, certain legislative history indicates that Congress intended the section 273 defense to narrowly apply only to traditional *State Street Bank*-type business methods, *i.e.*, methods confirmed in *State Street Bank* to be within the scope of patentable subject matter under 35 U.S.C. § 101. *See e.g.*, 145 CONG. REC. H6929, H6942 (1999) (remarks of Congressman Coble) (“[I]t is limited...to the *State Street Bank* case....”); *Id.* at H6943 (remarks of Congressman Rohrbacher) (“H.R. 1907 contains a very limited prior user defense that applies only to those business methods which have only been considered patentable in the last few years, and this...flows from [the *State Street Bank* case].”); and *Id.* at H6947 (remarks of Congressman Manzullo) (“In recognition of [the *State Street Bank* case], we felt that those who kept their business practices secret had an equitable cause not to be stopped by someone else who subsequently reinvented the method of doing or conducting the business....”).

On the other hand, different portions of the legislative history support a broader reading of the term “method of doing or conducting business.” Specifically, Senator Schumer remarked that a “method of doing business” includes “a[ny] practice, process, activity or system that is used in the design, formulation, testing, or manufacture of any product or service.” 145 CONG. REC. S14,837 (1999). Interestingly, Congressman Coble, who previously indicated that the defense was limited to *State Street*, stated that “a method

is defined as “an internal method for doing business, such as an internal human resources management process” or “a preliminary or intermediate manufacturing procedure.” 145 CONG. REC. E1,788, E1,789 (1999). Congressman Coble further stated that “[t]he first inventor defense is not limited to methods in any particular industry such as the financial services industry, but applies to any industry which relies on trade secrecy for protecting methods for doing or conducting the operations of their business.” *Id.* Because a great many industries rely on trade secrecy to protect methods, such as intermediate manufacturing procedures, it would seem that those methods would also fall under the definition of a “method” under section 273, though they arguably do not fall within the narrow definition of a “business method” under *State Street Bank*. These statements directly contradict the view that section 273 applies only to “business methods” similar to the financial system at issue in *State Street Bank*.

Given this analysis, it is certainly arguable that the phrase “method of doing or conducting business” in section 273 should not be limited to so-called “business methods,” but instead should extend to any and all methods relating to business or commercial activity (and possibly even system and apparatus claims). Further, it is worth noting that section 273(a)(3) recites a “method of doing *or conducting* business,” not merely “business methods” or “methods of doing business.” In any event, resolution of this critical issue awaits the courts.

What constitutes “commercial use”?

In addition to supporting a broad interpretation of the terms “method” and “method of doing or conducting business,” section

273’s text and legislative history support an expansive view of what constitutes a “commercial use” within the meaning of the statute. Section 273(a)(1) defines the term “commercial use” as the “use of a method in the United States in connection with an internal commercial use or an actual arm’s-length sale or other arm’s-length commercial transfer of a useful end result, whether or not the subject matter at issue is accessible to or otherwise known to the public.” Thus, a commercial use that is accessible to the public (*e.g.*, one that is not a trade secret) may constitute a use that is covered under section 273. Congressman Coble gave a broad interpretation to the term “commercial use” when he stated that:

the use must be in connection with either an internal commercial use or an actual arm’s length sale or other arm’s length commercial transfer or a useful end result. The method that is the subject matter of the defense may be an internal method for doing business, such as an internal human resources management process, or a method for conducting business such as a preliminary or intermediate manufacturing procedure.

145 CONG. REC. E1,788, E1,789 (1999).

Viewing the term “commercial use” to encompass the use of an internal method for human resources management makes it difficult to imagine what, if any, methods that relate in some way to the operation and function of a business producing a “useful end result” would not fall within the scope of a “commercial use.”

Even given broad interpretations of “method” and “commercial use,” questions remain as to whether section 273 will, in practice, provide the desired relief that Congress intended for prior users.

It is arguable that the statute does not go far enough to protect the expectations and investments of prior users. In the next part of this article, we will discuss these uncertainties and reforms proposed by the Federal Trade Commission to address the uncertainties.

For a more in-depth treatment of this statute, please read the authors’ upcoming article on this subject that is scheduled for publication in the November 2004 *Federal Circuit Bar Journal*.

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Electronic Laboratory Notebooks: Improved Data Storage or Increased Burden?

Laboratory notebooks are an essential part of any research operation. They serve as a scientist's diary, recording both day-to-day experiments and the interpretation of results. As a sign of the times, laboratories are increasingly moving away from the use of paper notebooks in favor of using computerized, or electronic, notebooks. Electronic notebooks have obvious advantages, including the ability to store large amounts of data in many different forms, to share or access the information remotely, and the ability to search the information quickly. Care must be taken, however, in utilizing electronic records to guarantee that the information will remain useful. Proper care includes safeguards to maintain the integrity of the electronic records and to store the information to ensure that the electronic record will be available at a future date.

Authentication

When using a notebook, it must be possible to authenticate any entry to alleviate concerns that someone other than the author entered the information, or that the information was modified in any way after being entered. Charles R. Merrill, *Time Is of the Essence*, CIO MAG., Mar. 15, 2000, at <http://www.cio.com/archive/031500/fine.html> (last visited June 17, 2004) [hereinafter "Merrill, *Time Is of the Essence*"]. For paper notebooks, information should be written in ink, no blank spaces should remain, and if alterations are necessary, they should occur by drawing a line through the material, and initialing the space in the margin with the date. Further, the date should be noted on the top of the page and the date and signature of the author should be affixed to the end of that day's notes. The information should also appear in chronological order, except possibly for cross-reference notations, which should be properly dated.

For electronic notebooks, unless the notebook pages are printed frequently and signed by the author, an electronic signature must be used. Safeguards must be observed when using electronic signatures because they can be far easier to duplicate or forge than their paper equivalents and are less capable of restricting document alteration after being affixed. Thus, the use of certain electronic signatures, such as digitized images of paper signatures, typed notations, digitized letterhead, or electronic mail headers, is problematic. Cf. *Tutorial*, in AM. BAR ASS'N, DIGITAL SIGNATURE GUIDELINES, at 3 (1996) [hereinafter "*Tutorial*"]. Instead, an effective electronic signature needs to be very difficult to reproduce and, when executed, falsification or alteration of either the signed matter or the signature needs to be impracticable. *Id.* at 7-8. This can be achieved by using a digital signature, where the authenticity can be verified either through a public key infrastructure ("PKI") system (where authenticity is verified through the author's unique private key), or the use of a biometric device (e.g. fingerprint readers, retina scanners, etc.). COLLABORATIVE ELEC. NOTEBOOK SYS. ASSOC., LEGAL ACCEPTABILITY GUIDE FOR ELECTRONIC RECORDS, at 146 (2001) [hereinafter "CENSA GUIDELINES"]. Alternatively, a password-based electronic signature system can be used, but such systems require additional safeguards because passwords can be easily compromised. *Id.*

A PKI system uses a dual-key encryption system wherein each signer possesses a pair of complementary software keys – one private key and one public key – comprising what is referred to as an asymmetric cryptosystem. See *Tutorial*, *supra*, at 9. The private key, which is held

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snippets

Care must be taken...in utilizing electronic records to guarantee that the information will remain useful. Proper care includes safeguards to maintain the integrity of the electronic records and to store the information to ensure that the electronic record will be available at a future date.

HYV_U : _WUR_ `aZZ_ `W`f_dM
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only by the signer, is used to either fix an electronic signature or encrypt a document, while the public key is provided to another individual for the purpose of verifying the electronic signature or decrypting the document. See *id.* at 9-16. The system is secure because, although the keys are mathematically related, it would not be computationally feasible to derive a private key from knowledge of a public key. *Id.* Because an asymmetric cryptosystem requires the signer to distribute a public key, however, and therefore others can attempt to use the same public key, identification of a signer with a particular public key can be problematic. Therefore, most digital signature systems utilize a trusted third party, or certification authority, to associate the signer with a given key pair. *Id.* at 16.

Integrity

The integrity of an electronic notebook must also be certain, to alleviate any concerns that the electronic notebook was altered or removed from the system after the date of its creation. Therefore, an electronic signature system must possess the means to date stamp the records and guarantee that the record's content cannot be altered without detection subsequent to this date stamping. Merrill, *Time Is of the Essence*. As an example, digital signature systems can incorporate an electronic fingerprint, referred to as a hash. *Tutorial* at 10. A hash function creates a digital freeze frame of a document by using an algorithm to translate the text into a digital code, or hash result, which is unique for that document. *Id.* The hash result is derived from the content of the document so that any modification of the document, including the alteration or deletion of a single charac-

ter, will yield a different hash result. *Id.* at 13-14.

As an added safeguard, digital signature systems can fix the date of a document's creation by using a trusted time-date stamp ("TTDS") that is provided by an independent source and prevents entries from being altered or deleted after being date stamped. Merrill, *Time Is of the Essence*. This process is referred to as digital notarization. CENSA GUIDELINES at 173. After a hash result is created by the software on the signer's desktop or local server, it is communicated to a certification authority. Charles R. Merrill, LEGAL GUIDE: GUIDE FOR LEGAL COUNSEL ON MITIGATION OF RISK FROM ELECTRONIC RECORDS, at <http://www.surety.com/home/legal.html> (last visited Oct. 1, 2001) (on file with author). A composition hash, or "superhash," is derived from all of the hash results collected by the certification authority at a given time, and a certificate containing the superhash and parameters by which the document's time-stamp can be validated is returned to the signer. See, e.g., *id.* This certificate can then be committed to archival storage along with the record it references. See, e.g., *id.* Validation of the record occurs through calculating the hash result for that record and comparing it to the hash result of the certified record. See, e.g., *id.* If the record has not been modified since it was first hashed, then the hash result will be identical. See, e.g., *id.* A test superhash can also be created from both the record and the cryptographic information stored with the record. See, e.g., *id.* If the test superhash matches the actual superhash, then the time of creation is unassailably verified. See, e.g., *id.* Please note, however, that absent security measures that restrict system access, a signer who relies on hash processing alone would not

be able to readily establish the identity of the signer, *i.e.*, a signer could establish the "when" and the "what," but not the "who." *Id.* Therefore, digital signature cryptography and TTDS should be used in concert.

Reliability

An electronic record must also be reliably accessible in the future, for obvious reasons. Therefore, electronic records must be committed to safe, archival storage on a regular basis. CENSA GUIDELINES at 36-38. Further, this commitment procedure should ensure that the modification or deletion of an electronic record is detectable, analogous to the detection of an erasure of text or the removal of a page from a paper-based notebook. Moreover, hardware considerations play a significant role in establishing a system's reliability. This is especially true when the relative impermanence of certain forms of digital media is taken into account. Therefore, care should be taken to estimated lifetime of the media on which the record is stored, whether magnetic or optical.

Conclusion

While electronic laboratory notebooks offer many advantages in terms of long-term data storage and reliability, they come with their own set of issues. Before moving to an electronic system, one should confer with an attorney to implement proper procedures to ensure the authenticity, reliability and integrity of data created and stored in electronic format.

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Festo Extended: Honeywell v. Hamilton Sundstrand

On June 2, 2004, the Court of Appeals for the Federal Circuit issued an important en banc decision regarding prosecution history estoppel and the doctrine of equivalents. In *Honeywell International, Inc. v. Hamilton Sundstrand, Corp.*, 370 F.3d 1131 (Fed. Cir. 2004) (en banc), the Federal Circuit held that the presumption of prosecution history estoppel applies when an allowable dependent claim depending from a rejected independent claim is rewritten as an independent claim and the original, rejected independent claim is cancelled. *Id.* at 1134. The Court expressly applied its holding to two separate situations: (i) where the dependent claim includes a further limitation on a limitation already found in the original independent claim, and, somewhat surprisingly, (ii) where the dependent claim includes a claim limitation not found in the original independent claim. *Id.* at 1141.

The claims at issue in *Honeywell* each contained a limitation directed to “adjustable inlet guide vanes.” 370 F.3d at 1134-1136. As filed, however, the “adjustable inlet guide vanes” limitation was only found in claims that depended from broader independent claims, and, during prosecution, the Patent Office (“PTO”) rejected these broader independent claims as obvious in light of prior art. *Id.* at 1137. The PTO also rejected the dependent claims with the “adjustable inlet guide vanes” limitation for depending from a rejected independent claim, but noted that the dependent claims would be allowable if rewritten in independent form. *Id.* To gain allowance, the applicants cancelled each rejected independent claim and rewrote the three dependent claims with the “adjustable inlet guide vanes” limitation to expressly incorporate the limitations of each corresponding cancelled independent claim. *Id.*

Simplifying for purposes of discussion, two types of claims were at issue in *Honeywell*. The first was an apparatus claim that included elements A, B', C, D, E, F and G, wherein element B' included the “adjustable inlet guide vanes” limitation, which circumscribed a preexisting limitation in the corresponding rejected independent claim. The second was a method claim that included elements A, B, C and D, wherein element D was the “adjustable inlet guide vanes” limitation, which was a limitation not present in the corresponding rejected independent claim.

The Federal Circuit began its analysis in *Honeywell* by holding that, as a general proposition, under the holdings and facts of the seminal *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003) (en banc) cases, it was “clear that the addition of a new claim limitation can give rise to a presumption of prosecution history estoppel, just like an amendment that narrows a preexisting claim limitation.” 370 F.3d at 1141. The *Honeywell* Court then addressed rewriting dependent claims in independent form by stating that if rewriting a dependent claim into independent form, coupled with the cancellation of the original, independent claim, results in a narrowing amendment, then a presumption of surrender arises. *Id.* The critical question to the Federal Circuit was whether an amendment narrows the overall claim scope of an independent claim to secure a patent.

Applying these propositions to the claims at issue in *Honeywell*, the Federal Circuit held that a presumptive surrender of equivalents arose for each of the indepen-

snippets

[T]he effect of the *Honeywell* decision is really to advance the effect of *Festo*. Now, more than ever, to avoid a concession of equivalents, claim amendments during prosecution need to be avoided....Likely, this will require thorough prior art searches and analyses to foresee the references that the Patent Office will apply against filed claims. Armed with this information, claims should be drafted to realistically reflect the scope a particular invention deserves—and no broader.

dent claims at issue, regardless of whether an amendment merely limited a preexisting claim element or whether it added a completely new element to the claim at issue. 370 F.3d at 1144. Although the Federal Circuit expressly held that the scope of the presumptive surrender applies only to the amended or newly added limitation—not to any unamended limitations—the presumptive surrender applies to the entire scope of equivalents, even for a newly added limitation. *Id.*

Judge Newman's lone, spirited dissent provides a compelling case for a better reading of the doctrine of equivalents, and perhaps foreshadows the return of the doctrine of equivalents to the Supreme Court:

My colleagues not only impose the presumptive surrender of *Festo*, but also presume estoppel against the entire universe of technology. That is, instead of presuming surrender of the territory between the original scope of the claimed element and the scope of that element after a narrowing amendment—the rule developed in *Festo*—the court now presumes unlimited surrender when an element was not originally claimed at all and therefore presents no outer limit of surrendered territory.

370 F.3d at 1147. Newman concluded her dissent with these thoughts:

Today's new rule solves no problem, rights no wrong, addresses no unmet

need. Future applicants may attempt to obtain access to the doctrine of equivalents through avoiding dependent claims. Patent applications will cost more, since independent claims carry a heavier fee than dependent ones. There will be more opportunities for mistakes, and insignificant changes in the wording of limitations that would have been incorporated by reference will be fodder for litigation. Examination will probably take longer, because the use of dependent form adds organization to the claims and makes them easier to understand. The losers are those patentees who had no reason to foresee today's new rule, and future patentees who will have to cope with it.

Id. at 1153.

Judge Newman's comments notwithstanding, the effect of the *Honeywell* decision is to advance the effect of *Festo*. Now, more than ever, to avoid a concession of equivalents, applicants should avoid claim amendments during prosecution. To do so, clients need to work closely with their patent attorneys to accurately define claim scope before filing a patent application. Likely, this will require thorough prior art searches and analyses to foresee the references that the Patent Office will apply against filed claims. Armed with this information, applicants, in cooperation with their patent attorneys, should

draft claims that realistically reflect the scope a particular invention deserves—and no broader.

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With offices in Chicago and Washington state, MBHB provides comprehensive legal services to obtain and enforce our clients' intellectual property rights, from navigating patent office procedures to litigating complex infringement actions. However, we don't merely procure rights and litigate cases; we craft winning strategies that achieve our clients' business objectives.

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Review of Developments in Intellectual Property Law

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