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EXPANDING THE REISSUE PROCEDURE: A BETTER WAY TO DO BUSINESS

Continued technological development is inextricably entwined with the fiscal prosperity of this country. To further the development of science and technology, the founding fathers granted Congress the power to create the patent system. Under the system that Congress enacted, inventors claim an invention by filing an application with the Commissioner of the Patent and Trademark Office ("PTO"). The application must contain a specification which "shall conclude with one or more claims particularly pointing and distinctly claiming the subject matter which the applicant regards as his invention." Once the PTO grants the patent, the inventor, also known as the patentee, has the right to exclude others from making, using, or selling his invention throughout the United States for seventeen years.

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1 U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have the Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").
4 Each claim defines the patent owner's legal rights; it defines the boundaries of the property right conferred by the patent. E.g., Palumbo v. Don-Joy Co., 762 F.2d 969, 974 (Fed. Cir. 1985).
years. An unauthorized party who violates the patentee's statutory rights commits literal infringement. Even if a party does not literally infringe a patent, the court may still find infringement based upon the judicially created doctrine of equivalents.

The doctrine of equivalents extends claims beyond the literal interpretation of the language; i.e., it determines whether the accused product is "equivalent" to that described by the claim language. The doctrine of equivalents thus is applicable for a claim which does not "read on" an allegedly infringing device because one or more limitations of the claim are not met exactly.

Problems exist, however, in applying the doctrine of equivalents. For instance, the doctrine of equivalents provides little analytical framework. Additionally, problems include, among others, procedural difficulties, the failure of juries to understand complex technologies, and uncertainty in the courts. Legal writers have criticized the doctrine of equivalents for these deficien-

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7 35 U.S.C. § 271(a) (1982). The literal infringement inquiry is a two-step process: the trier first interprets the claims to determine their proper scope, and then the trier must apply those interpretations to the accused device to determine whether it infringes the claimed invention. Palumbo, 762 F.2d at 974.

10 "Read on" means that each technical phrase in the claim must literally describe a corresponding element or connection in the description of the allegedly infringing product or method. ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING § 18, at 43 n.5 (1990).
11 Johnson v. IVAC Corp., 885 F.2d 1574, 1580 (Fed. Cir. 1989).
12 See Malta v. Schulmerich Carillons, Inc., 952 F.2d 1320, 1325-26 (Fed. Cir. 1991) ("This court has not set out in its precedent a definite formula for determining the equivalency between a required limitation or combination of limitations and what has been allegedly substituted therefor in the accused device. Nor do we propose to adopt one here.") (quoting Corning Glass Works v. Sumitomo Elec. U.S.A., 886 F.2d 1251, 1259 (Fed. Cir. 1989)).
13 See infra notes 74-87 and accompanying text.
14 See infra notes 69-70 and accompanying text.
15 See infra notes 91-92 and accompanying text.
While the Court of Appeals for the Federal Circuit ("CAFC") continues to refine the doctrine of equivalents, the problems remain unresolved.

This Note proposes a solution to the problems that exist as a result of the doctrine of equivalents: Congress should replace the doctrine of equivalents with an expanded reissue procedure. The current reissue procedure functions as a correction provision by allowing enlargement of patent claims within two years of granting the original patent. The PTO grants a reissue patent, just as it issues the original patent. The reissue procedure co-exists with the doctrine of equivalents. A patentee could sue another party for literal infringement or infringement under the doctrine of equivalents based upon claims in the original patent or reissue patent or both. From the patentee's perspective, suing for literal infringement using the reissue claims may be less desirable because the public has more protection, at the expense of the patentee, than under the doctrine of equivalents.

This proposed solution advocates abolishing the doctrine of equivalents and expanding the reissue procedure to allow for changes in patent claims over the entire life of the patent. Such an expansion of the reissue procedure is a viable solution to many problems in patent law while protecting the patentee's invention,

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17 In 1982, Congress passed the Federal Courts Improvement Act, creating the Court of Appeals for the Federal Circuit. The CAFC hears several types of cases, but one of its primary functions is to hear all appeals from the federal district courts involving patents. The purpose of this single court of appeals is to unify patent doctrine. The Supreme Court rarely reviews its decisions. See Adelman, supra note 16, at 981 n.10.

18 See, e.g., Parker, supra note 16, at 264 (noting that "the Federal Circuit has also gradually expanded and complicated the basic analytical structure which patent cases are decided").


20 See infra notes 44-54 and accompanying text (discussing current reissue procedure and intervening rights).
thus upholding a primary function of the doctrine of equivalents.21

Section I discusses the history and present status of the doctrine of equivalents, the current reissue procedure, and inherent problems with the doctrine of equivalents. Section II explains the proposed solution. In Section III, this Note analyzes the advantages of an expanded reissue procedure. Section IV discusses potential concerns with this proposal. Last, Section V presents hypothetical situations illustrating the benefits of the proposed solution.


This section discusses the historical development of the doctrine of equivalents and then the present status of this doctrine. The section next explains the current reissue procedure and concludes by discussing inherent problems with the doctrine of equivalents, both independent of and in relation to the current reissue procedure.

A. HISTORY OF THE DOCTRINE OF EQUIVALENTS

The doctrine of equivalents arose in equity. In modern times, the doctrine of equivalents has shifted from its equitable beginnings to a secondary infringement test that litigants frequently use.22 This Note's proposed solution better incorporates the fairness considerations of equity for both the public and the patentee than the present doctrine of equivalents.

Historical analysis of the doctrine of equivalents frequently begins with the Supreme Court case Winans v. Denmead,23

21 This solution is an acceptable proposition of law. In the two most famous applicable Supreme Court cases, the dissenting opinions stressed the importance of following acts of Congress instead of using the judicially created doctrine of equivalents. Graver Tank & Mfg. Co. v. Linde Air Prods., 339 U.S. 605, 613 (1950) (Black, J., dissenting); Winans v. Denmead, 56 U.S. (15 How.) 330, 347 (1853) (Cambell, J., dissenting). Each opinion noted many problems that have continued to plague the doctrine of equivalents jurisprudence, such as uncertainty in the coverage of the claims. See infra notes 28-29 and accompanying text; infra notes 33-36 and accompanying text (discussing respective dissenting opinions).


decided in 1853. In *Winans*, the defendant's design did not literally infringe the plaintiff's patent claims but instead incorporated the plaintiff's improvements in a different form. The plaintiff patentee in *Winans* had designed a new coal transport vehicle, shaped as a frustum cone, that allowed lighter cars to carry heavier loads. The defendant's car, in contrast, was shaped as an octagon with a pyramidal base. The defendant's design, although shaped differently, achieved the same result as the patentee's invention. The trial court found no literal infringement because the defendant's product did not fall within the patentee's claims. The Supreme Court, basing its decision on the doctrine of equivalents, reversed the lower court in a five-to-four decision. The majority began its analysis with the premise that a patent cannot be granted merely for a change of form. The Court then held that the jury could reasonably find that the infringing car impermissibly incorporated the improvements from the plaintiff's patent. The majority ruled that "to copy the principle or mode of operation described, is an infringement, although such copy should be totally unlike the original in form or proportions."

The dissent argued that the majority was circumventing congressional intent because the statute required that the patentee "describe his invention, in such full, clear, and exact terms, that from the description, the invention may be constructed and used." The dissent further argued that nothing "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 these wise and salutary requisitions of the act of Congress." The dissent thus highlighted the problems with the majority's position of incorporating equity into an infringement analysis.

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24 Cf. Wegner, supra note 16, at 6 (explaining that while courts and academic writers trace doctrine of equivalents to *Winans*, this starting point overlooks approximately forty years of case law).
26 Id.
27 Id. at 341.
28 Id. at 347 (Cambell, J., dissenting).
29 Id.
Nearly a century later, the Supreme Court again examined the use of the doctrine of equivalents in the oft-cited case *Graver Tank & Manufacturing Co. v. Linde Air Products.*\(^{30}\) There, as in *Winans*, the Court found infringement based on the doctrine of equivalents.\(^{31}\) The Court explained its infringement test under the doctrine of equivalents as follows:

> What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.\(^{32}\)

This holding is important because it is the current articulation of the doctrine of equivalents.

Justice Black’s dissent, however, charged that these arguments did not justify sterilization of Acts of Congress.\(^{33}\) Justice Black noted that Congress “entrusted the Patent Office, not the courts, with initial authority to determine whether expansion of a claim was justified.”\(^{34}\) He also argued that “what is not specifically claimed [in the patent] is dedicated to the public” and that giving


\(^{31}\) *Id.*

\(^{32} Id.* at 609.

\(^{33} Id.* at 613 (Black, J., dissenting).

\(^{34} Id.* at 615.
the "patentee the benefit of a grant that it did not precisely claim is no less 'unjust to the public' and no less an evasion of [the statute] merely because done in the name of the 'doctrine of equivalents.'" Finally, Justice Black identified a fundamental problem in applying the doctrine of equivalents: the public cannot rely on the language of a patent claim.

The problems that both dissenting opinions highlight still exist today. This Note’s proposed solution would alleviate these deficiencies. Furthermore, this proposed solution better considers the equitable concerns that served as the underpinnings of both majority opinions.

B. PRESENT STATUS OF THE DOCTRINE OF EQUIVALENTS

Under the doctrine of equivalents, "infringement may be found if an accused device performs substantially the same function in substantially the same way to achieve substantially the same result." This three prong test, the "function/way/result" test, is deceptively simple. A product or process does not infringe, though satisfying this analytically fluid test, if two additional requirements are not met: (1) prosecution history estoppel, and (2) the prior art limitation.

Prosecution history estoppel, also known as "file wrapper estoppel," prohibits the patentee from recapturing through equivalents certain coverage given up during the patent prosecution. The scope of the equivalents, in other words, is limited where the patentee restricted his original claims during prosecution to obtain his patent. The court-determined equivalents, therefore, cannot encompass claims that are inconsistent with the PTO's restrictions in granting the patent.

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26 Id. at 617.
The prior art limitation prevents equivalents from extending to an infringing device within the public domain, i.e., found in the prior art at the time the patent is issued. The CAFC developed a method of analyzing the prior art limitation designed to aid the trier of fact which uses hypothetical patent claims. In *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, the court stated:

Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then prior art is not a bar to infringement under the doctrine of equivalents.

Commentators, however, have been critical of this method.

The doctrine of equivalents in its present form uses a mechanical, instead of an equitable, approach. This mechanical application ignores the fairness considerations that the Supreme Court embraced in its decisions applying the doctrine of equivalents.

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40 *Loctite*, 781 F.2d at 870.
41 904 F.2d 677 (Fed. Cir. 1990).
42 *Id.* at 684.
43 *See, e.g.*, Parker, *supra* note 16, at 264 (noting that the CAFC "has explicitly dictated an entirely new, and potentially exceedingly complex, test for determining whether or not a patent is infringed under the Doctrine of Equivalents"); *see also infra* notes 81-88 and accompanying text (discussing this criticism in relation to this Note's proposal).
C. CURRENT REISSUE STATUTE

The patent statute contains a limited reissue procedure that functions as a correction provision. This procedure allows enlargement of patent claims within two years of the granting of the original patent. Narrowing claims, in contrast, is not subject to the two-year limitation. The PTO grants reissue claims only for errors that occur without deceptive intent. Furthermore, the application for reissue cannot introduce any new matter.

The current patent statute also contains a provision establishing reissue rights for the public and the patentee. When the PTO...

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44 35 U.S.C. § 251 (1988) which reads in part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partially inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

... No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the granting of the original patent.

45 Wayne-Gossard Corp. v. Moretz Hosiery Mills, 384 F. Supp. 63, 71 (W.D.N.C. 1974) (finding claims for reissue patent not invalid for failure to file application within two years after grant of original patent where scope of the reissue claims was narrower).


The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissue patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant
grants the reissue, the patentee surrenders the original patent in return for the new patent except "to the extent that its claims are identical with the original patent." The unaltered claims constitute a continuation of the original patent with no variation in the patentee's rights.

The current reissue procedure limits a patentee's rights for the reissue claims through two separate considerations, known as intervening rights. First, prior to the PTO granting the reissue, the patentee has no rights against another party whose product does not literally infringe an original claim but does infringe the reissue claim. The statute grants the alleged infringer an absolute right to continue to use or sell the specific thing made, purchased, or used prior to the reissue. Second, if the purchase, practice, use, or substantial preparation was made before the grant of the reissue, the court may allow the continued manufacture, use, or sale of the now-patented item and the continued use of any process. In granting this continuation, the court considers these enumerated factors "to the extent and under such terms as [it] deems equitable for the protection of investments made or business commenced before the grant of the reissue."

of a reissue anything patented by the reissue patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the reissue, to the extent and under such terms as the court deems equitable for the protection of the investments made or business commenced before the grant of the reissue.

49 Id.
50 Id.
53 Id.
54 Id. Process is defined as a method of treating material to produce a particular result or product. A process can also relate to a new use of a known composition, apparatus, or the like. HILDRETH, supra note 39, at 5.
These intervening rights may be avoided, in theory, by drafting claims more broadly or narrowly in the initial application. If the patentee desires to make these changes after the patent has issued, intervening rights arise to protect the public. If the patentee relies on the doctrine of equivalents to find infringement instead of this reissue statute, then the court does not consider intervening rights and the public loses this congressionally mandated protection.

D. INHERENT PROBLEMS WITH THE DOCTRINE OF EQUIVALENTS

The doctrine of equivalents must meet both the demands of the Constitution in the Intellectual Property Clause and congressional directives. The doctrine of equivalents, however, fails to fully implement either of these criteria.

1. Constitutional Shortcomings. The doctrine of equivalents began as a tool of equity, an alternative of last resort. Today, however, the doctrine of equivalents routinely functions as a secondary infringement test, an issue of fact to be resolved in virtually every patent suit. Thus, in most infringement suits, equivalency is an issue that the trier of fact must resolve. Such prolific use of the doctrine of equivalents inhibits the patent system from fulfilling its constitutional purpose: the promotion of progress in the useful arts.

Infringement by the doctrine of equivalents fundamentally conflicts with the policy that patent claims define and measure the scope of a patent. The public has no method to design around claims because there are no clear bounds. The patent system is premised, in part, upon public reliance on the claim language. The CAFC has stated that "[d]esigning around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitution-
In another case, the CAFC noted that the public may come to believe that they can never rely upon the patent language because protection will be extended beyond the scope of the claims. The court also noted that the result of routine use of the doctrine of equivalents will cause patent claims to cease serving their intended purpose because competitors will never know whether their actions infringe a patent.

The doctrine of equivalents thus undermines a constitutional purpose of the patent system. Since use of the doctrine of equivalents provides no definite limits and its use has become widespread, the current system hinders the public's ability to design around patents, a fundamental purpose of the Intellectual Property Clause.

2. Circumventing Congress. The co-existence of the current reissue procedure and the doctrine of equivalents is unsatisfactory because the doctrine of equivalents circumvents a congressional directive. Within the two-year statutory period, a patentee may attempt to expand his patent to encompass another's product or process using either a reissue patent or the doctrine of equivalents. The patentee's use of the congressionally created reissue procedure invokes intervening rights pursuant to 35 U.S.C. § 252. In contrast, the patentee who relies solely upon the judicially created doctrine of equivalents affords the public no protection as Congress mandated in establishing these intervening rights. The doctrine of equivalents therefore circumvents Congress's statutory requirements. This practice is unjustifiable because courts lack the power to implicitly negate statutes.

II. THE PROPOSED SOLUTION

Congress should expand the reissue procedure to encompass the life of the patent. Such expansion would resolve the continuing problems with the application of the doctrine of equivalents. Con-
gress should also abolish any distinction between types of reissues and instead give the patentee freedom to broaden or narrow his claims. Once Congress expands the reissue procedure, it should make two modifications to the current reissue procedure: (1) an allowance for new technology developments, and (2) a modification of the intervening rights provision.

Congress should amend the present statute to allow a reissue for new technology developments. This proposed technology development provision differs from new matter. To qualify, the applicable technology would need to be unavailable during the original prosecution, to be applicable to the granted claims, and to supplement the claims instead of changing their nature. This provision would require the patentee to be more proactive than under the present system because the patentee would be forced to consider potential new technology developments that could affect his patent. The patentee thus would be more cognizant to the possibility of obtaining a reissue patent, and his reissue patent would result in broader public knowledge. This provision consequently would better promote the useful arts, a constitutional purpose of the patent system.

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64 35 U.S.C. § 251 explicitly addresses the two-year time limitation to grant a reissue patent if it enlarges the scope of the claims of the original patent. The statute, however, does not address narrowing the scope of claims. See Wayne-Gossard Corp. v. Moretz Hosiery Mills, 384 F. Supp. 63, 71 (W.D.N.C. 1974) (finding claims for reissue patent not invalid for failure to file application within two years after grant of original patent where scope of the reissue claims was narrower).

65 Cf Adelman & Francione, supra note 16, at 728 (arguing that sole legitimate function of doctrine of equivalents should be limited to covering technology literally unavailable during prosecution).

66 New matter is new substantive disclosure which would have the effect of changing the invention or of introducing what might be the subject of another patent application. Siebert Cylinder Oil Corp. v. Harper Steam Lubricator Co., 4 F. 328, 333 (C.C.D. Conn. 1880). A new technology development, in comparison, is matter that is covered by the present patent wherein technological developments have improved or transformed the matter.

67 Similar to the doctrine of equivalents, if the "total of the technological changes [are] beyond what the patentee disclosed" in the specification, a reissue would be inappropriate. Texas Instruments v. United States Int'l Trade Comm'n, 805 F.2d 1558, 1571 (Fed. Cir. 1986). Under the doctrine of equivalents, "[i]t is the entirety of the technology embodied in the accused devices that must be compared with the patent disclosure. Any other view distorts both the correct interpretation of the claims and their application to the accused devices." Id. at 1570 (citations omitted).
Also, under the proposed system, Congress should modify intervening rights. These intervening rights would be based upon the filing date of the reissue, not upon the grant date.68 The patentee's right to sue for infringement, in comparison, would begin when the PTO grants the reissue.69

If the infringing party acted prior to the patentee filing a reissue application, intervening rights would exist pursuant to the current reissue procedure.70 Parties who use a process or product after the reissue filing date, however, would not receive the benefit of intervening rights. The need for confidentiality in the reissue process is not required since the reissue patent would only correct errors or allow modifications for new technological developments. Hence, the reissue application could be filed with the patent to give the public notice. Parties then could risk using the filed, but not granted, reissue patent. These parties, in effect, would gamble on whether the PTO will disapprove the reissue, thus eliminating liability, or whether the PTO will grant it, thus creating liability for infringement.

This proposal provides an opportunity for the parties to "design around" both the patent and the reissue application, further supporting the constitutional directive of promoting the useful arts. This proposal also allows the patentee to circumvent intervening rights if he files a reissue patent before another party uses a product or process that the reissue claims encompass. This proposal thus alleviates a constitutional shortcoming of the doctrine of equivalents.

Concurrent with these statutory changes, the doctrine of equivalents should be abolished.

68 One commentator who considered the reissue as an alternative to the doctrine of equivalents noted that the filing date, instead of the grant date, should determine intervening rights since the reissue proceedings may take two or more years and thus prejudice the patentee's rights. Wegner, supra note 16, at 35.

69 Using the filing date appears, in theory, more just; pragmatically, this would create many new problems. How does one enforce the prospective approval of a reissue? On what basis may a court issue an injunction? What happens if a patentee bars an alleged, non-literal infringer from using the prospective reissue, and the PTO subsequently rejects the reissue?

III. ADVANTAGES OF THE PROPOSED REISSUE PROCEDURE

An expanded reissue procedure provides numerous benefits over the doctrine of equivalents. Specifically, the expanded reissue procedure offers the following advantages: improving decision consistency, eliminating procedural difficulties and confusion in the courts, providing the inventor with an equal scope of patent equivalents, better resolving the fundamental tension with the purpose of the doctrine of equivalents, and better satisfying the policy considerations of the doctrine of equivalents.

A. BENEFITS OF THE PTO'S EXPERIENCE AND KNOWLEDGE

The PTO's experience and knowledge provide many advantages over a court in deciding patent equivalents. The PTO better understands patent law and technology and thus would provide greater certainty in determining patent equivalents.

The jury in a patent infringement case faces a broad scope of inventions dealing with complex topics, ranging from electrical engineering, to complex polymer production, to a variety of nascent technologies. Even without considering these complicated sciences, juries have increasingly been criticized as being ill-equipped to decide adequately the basic issues in the cases before them. These criticisms are spurred in part by the educational background of some juries. In contrast, under an expanded reissue procedure, the PTO would decide these complex issues. PTO examiners are specialists. They concentrate only on particular fields, and in many technologies, further specialize within a given branch. In some cases, the reissue examiner may be the same examiner who originally granted the patent. Compared to a jury, the PTO examiners better understand the complex technologies.

In addition, the expanded reissue procedure would make decisions concerning patent equivalents more logical and predict-

72 In one complex case involving antitrust and patent violations, the jury's average education was at the tenth grade level. Douglas W. Ell, Note, The Right to an Incompetent Jury: Protracted Commercial Litigation and the Seventh Amendment, 10 CONN. L. REV. 775, 776 (1978) (discussing SCM Corp. v. Xerox, 463 F. Supp. 983 (D. Conn. 1978)).
able, creating greater certainty. The PTO's greater technical expertise would provide sound and consistent decisions. Improved consistency is inherent since the PTO is a small administrative body with daily tasks revolving around patents. Federal courts, on the other hand, consider patent claims infrequently. Federal judges, although possessing astute legal minds, may lack the scientific background to decide equivalency issues as effectively as the PTO. Some federal judges may have a scientific background different from the subject of the doctrine of equivalents before them. The PTO examiners, in contrast, specialize in these technologies. Hearings before the PTO thus would provide a better forum to determine the scope of equivalents as compared to a bench trial because it is unlikely that a federal judge will decide an equivalency issue in a particular area in which he or she has a technical expertise.

B. ELIMINATING PROCEDURAL DIFFICULTIES

The courts' lesser knowledge in the technical fields is matched by procedural difficulties. The court must define the scope of equivalents for a patent, a difficult task; it requires an understanding of the technology in the patent at issue, the accused device, and the prior art—all of which affect the scope of equivalents. Prosecution history estoppel also varies the range of equivalents. The CAFC has further complicated the courts' task with its hypothetical claim method.

Under the doctrine of equivalents, the court must "review the

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73 This proposal may be further developed. The PTO could resolve disputes between the parties—the one seeking the reissue and the one allegedly infringing. The PTO presently functions as a dispute resolution body. See, e.g., 37 C.F.R. § 1.291-97 (1992) (protests and public use proceedings); 37 C.F.R. § 1.601-90 (1992) (interferences).

74 In one case, the CAFC stated that "unlike a jury in a district court case, the [U.S. International Trade Commission] resolves disputes involving patent infringement matters with some regularity and thus is aware of doctrine of equivalents jurisprudence." Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 832-33 (Fed. Cir. 1991) (emphasis added). The PTO, based upon its function, is more aware of legal issues concerning patents than the U.S. International Trade Commission. A fortiori, the PTO is more capable than a jury of understanding legal issues involving patent equivalents.

75 Judges, in the applicable infringement situations under the expanded reissue procedure, would still decide questions of equity and damages, areas in which they are highly qualified and experienced.
content of the patent, the prior art, and the accused device, and essentially redefin[e] the scope of the claims."76 The court conducting the analysis first decides whether the patent qualifies as either a pioneer invention or an improvement.77 This determination sets the scope of equivalents available for a patent. In addition, prior art and prosecution history estoppel vary the range of equivalents.78 Furthermore, the scope of equivalents may turn on "the totality of change in the accused devices from that described in the [claim] specification."79

Considering prosecution history estoppel specifically, the PTO possesses greater knowledge and experience concerning claim breadth limitations. For instance, the PTO understands why it previously required the surrender of a particular claim or removal of certain language. A trial court, however, is inexperienced at such practice and may not fully understand the reasons for these amendments to the original claims.80 A court's unfamiliarity with these issues could possibly skew its decisions.

Considering the prior art limitation, the CAFC established a method using hypothetical patent claims to verify the breadth of the equivalents. The CAFC's method set the same bounds as the PTO would have set in that situation. The Wilson Sporting Goods court ruled that "the pertinent question [for the court] then becomes whether that hypothetical claim could have been allowed

76 Texas Instruments v. United States Int'l Trade Comm'n, 805 F.2d 1558, 1572 (Fed. Cir. 1986).
77 See, e.g., Slimfold Mfg. Co. v. Kinkead Indus., 932 F.2d 1453, 1457 (Fed. Cir. 1991) (noting that invention in crowded field is entitled only to narrow scope of equivalents); Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532 (Fed. Cir. 1987) ("A pioneer invention is entitled to a broad range of equivalents.").
78 Texas Instruments, 805 F.2d at 1572 ("While the prior art and prosecution history are necessary considerations in applying the doctrine of equivalents, they do not of themselves control the breadth of equivalents available under the doctrine."); see supra notes 39-40 and accompanying text (discussing how prior art and prosecution history estoppel affect scope of equivalents).
79 Texas Instruments, 805 F.2d at 1572.
80 The CAFC highlighted the complexity of prosecution history estoppel interpretation, noting that "amendments may be of different types and may serve different functions. Depending on the nature and purpose of an amendment it may have a limiting effect within a spectrum ranging from great to small to zero." Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1363 (Fed. Cir. 1983).
by the PTO over the prior art.\textsuperscript{81} Thus, the applicable standard is the PTO's likely determination. This ruling raises a rhetorical question: Who is better qualified than the PTO itself to decide as the PTO would in a given situation?

The \textit{Wilson Sporting Goods} holding has made the courts’ task exceedingly complex.\textsuperscript{82} First, confusion may result because “the case to be presented by the patentee in support of the hypothetical claims will be similar in many respects to the validity evidence to be offered by it in rebuttal against an invalidity defense raised by the alleged infringer.”\textsuperscript{83} The next complication is the classic patent law requirement that “a claim be interpreted in the same manner for the purposes of both validity and infringement.”\textsuperscript{84} The claims that a patentee would try to prove valid are different from the claims that a defendant would try to prove invalid.\textsuperscript{85} Further complications may arise when “another, preliminary and subsidiary, validity analysis is introduced with respect to a second claim, or set of claims.”\textsuperscript{86} The complicated situation may be exacerbated if the suit involves a means-plus-function claim\textsuperscript{87} where the fact finder must contend with two types of “validity” analyses as well as with two types of equivalency analyses.\textsuperscript{88} A jury must decide this litigation mess. Unfortunately, this jury may have difficulty with its basic tasks; i.e., it may not fully understand the applicable rules and principles of law or the judge’s instructions.\textsuperscript{89}

These procedural difficulties are eliminated under the expanded reissue procedure, thus potentially reducing litigation costs. Under the expanded reissue procedure, the PTO would determine the equivalents and then the fact finder in the subsequent trial would determine whether literal infringement exists. If the process or product infringed the reissue patent, a judge would decide the remedy since the doctrine of intervening rights is equitable in

\textsuperscript{81} \textit{Wilson Sporting Goods Co. v. David Geoffrey & Assocs.}, 904 F.2d 677, 684 (Fed. Cir. 1990) (emphasis added).
\textsuperscript{82} \textit{Parker}, supra note 16, at 264.
\textsuperscript{83} \textit{Id.} at 274-75.
\textsuperscript{84} \textit{Id.} at 275.
\textsuperscript{85} \textit{Id.}
\textsuperscript{86} \textit{Id.}
\textsuperscript{87} See infra notes 129-130 and accompanying text (discussing means-plus-function claim).
\textsuperscript{88} \textit{Parker}, supra note 16, at 275-76.
\textsuperscript{89} \textit{Friedland}, supra note 69, at 197.
nature. If infringement of the reissue patent occurred after the filing date, however, the court would award damages since intervening rights would be irrelevant. The expanded reissue procedure therefore drastically simplifies the present quagmire existing under the doctrine of equivalents.

Another benefit of the expanded reissue procedure is the increased likelihood of a summary judgment or an out-of-court settlement because literal infringement would be the only cause of action for patent infringement. This translates into a savings of time and resources for the parties and the court.

The financial aspect of a reissue procedure also strongly supports adoption of the expanded procedure. Attorney’s fees to prepare and prosecute a patent application may total approximately $6000. These fees, however, may be lower for a reissue since it modifies the original patent. In contrast, the average attorney’s fees per litigant to prepare and try a patent infringement case will soon approach $1,000,000. The benefits of the expanded reissue procedure—uncomplicated litigation and an increased probability of summary judgment—may result in enormous money savings.

Under the proposed reissue procedure, the PTO’s involvement would alleviate procedural difficulties that the courts presently experience. As a result, infringement litigation would be less complicated and less expensive.

C. REMOVING UNCERTAINTY IN THE COURTS

Confusion over the various infringement doctrines is another problem that exists in the courts. Uncertainty results from confusion between the doctrine of equivalents and either literal infringement or a means-plus-function claim under 35 U.S.C. § 112.

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92 Id.
Confusion often arises concerning the distinction between literal infringement and the doctrine of equivalents. Some “[c]ourts have appeared to find direct or literal infringement while in reality applying the doctrine of equivalents.” Conversely, “other courts have found infringement under the doctrine of equivalents in cases where there was literal infringement.”

Courts also use an “equivalency” analysis to find infringement in both the doctrine of equivalents and a means-plus-function claim of 35 U.S.C. § 112. Although both infringement theories use the word “equivalents,” the application is different under each theory; a determination of section 112 equivalence, unlike the doctrine of equivalents, does not currently use the equitable tripartite function/way/result test. Furthermore, the doctrine of


95 The CAFC stated the test for the means-plus-function limitation to read on an accused device in Valmont Industries v. Reinke Manufacturing Co., 983 F.2d 1039, 1042 (Fed. Cir. 1993):

[T]he accused device must employ means identical to or the equivalent of the structures, material, or acts described in the patent specification. The accused device must also perform the identical function as specified in the claims.

In 1986, however, the CAFC held:

Whether the issue is equivalency of a means that is described in the specification to perform a function in a “means” clause of a combination claim (i.e., literal infringement), or equivalency to the claimed invention as a whole (i.e., infringement by the doctrine of equivalents), the test is the same three part test of history: does the asserted equivalent perform substantially the same function in substantially the same way to accomplish substantially the same result. (In the case of “means” clauses, of course, the function is that stated in the claim.)


96 Valmont Industries, 983 F.2d at 1043.
equivalents and section 112 have different origins and purposes. A district court recently confused these two infringement theories and was subsequently reversed by the CAFC.

Congressional approval of the expanded reissue procedure would eliminate these problems. First, courts would be unable to confuse literal infringement and infringement under the doctrine of equivalents. The courts would only consider literal infringement, which includes the subcategory of means-plus-function infringement. Second, only one type of “equivalents” would exist, thus removing another source of confusion. Eliminating the source of these past mistakes would benefit the affected parties and the judicial system.

D. THE DOCTRINE OF EQUIVALENTS AND THE PROPOSED REISSUE EXPANSION PROVIDE AN EQUAL SCOPE OF COVERAGE TO THE PATENTEE

Replacing the doctrine of equivalents with an expanded reissue procedure would not cause the patentee to lose any claim protection. The allowable scope of patent claims would be the same for both methods of determining equivalents because they use analogous rules: prior art limitations, prosecution history estoppel, limitations on new matter, and provisions for advances in technology.

The doctrine of equivalents and the expanded reissue procedure both limit the scope of patents where it would encroach on a product or process in the prior art. Likewise, these methods bar the scope of the patentee’s claims from including certain coverage given up during the prosecution of the patent. This limitation is known as prosecution history estoppel in the doctrine of equivalents. Under the reissue procedure, coverage is limited to “error without any deceptive intention.” This limitation prevents the patentee from changing claims to recapture subject matter that was intentionally surrendered during the prosecution of the original

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97 Id. at 1043-44 ("Section 112, ¶ 6, limits the broad language of means-plus-function limitations in combination claims to equivalents of the structures, materials, or acts in the specification. The doctrine of equivalents equitably expands exclusive patent rights.").
98 Id. at 1044.
This concept, known as the "recapture rule" for a reissue, is the same as prosecution history estoppel.

Another limitation to the scope of equivalents is that the original patent must have intended to encompass the requested claims. The reissue statute specifically requires that "no new matter shall be introduced into the application for reissue." Likewise, the doctrine of equivalents does not provide coverage which the patentee could not have lawfully obtained from the PTO during patent prosecution.

Although different from new matter, technological developments similarly affect the scope of patent equivalents. The doctrine of equivalents permits advances in technology. Likewise, this proposal also permits the patentee to obtain a reissue for new technology affecting his claims.

These two methods, the doctrine of equivalents and the expanded reissue procedure, thus give the patentee an equal scope of protection. The expanded reissue procedure therefore will not diminish the patentee's coverage. Unlike the doctrine of equivalents, however, the reissue remains in force for the life of the patent and is available against all future infringers. Thus, the expanded reissue procedure provides equal coverage for the patentee, yet avoids the problems of the doctrine of equivalents.

E. THE EXPANDED REISSUE PROCEDURE BETTER RECONCILES THE FUNDAMENTAL TENSION RESULTING FROM THE COMPETING OBJECTIVES OF THE DOCTRINE OF EQUIVALENTS

The doctrine of equivalents has two competing objectives which cause an inherent tension: (1) to permit "designing around" the patent by giving the public fair notice of the claimed invention, and

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100 Curtis B. Hamre et al., Reissue and Reexamination, 29 J.L. & TECH 311, 312 (1989).
101 E.g., In re Weiler, 790 F.2d 1576 (Fed. Cir. 1986).
104 See Atlas Power Co. v. E.I. du Pont de Nemours & Co., 750 F.2d 1569, 1581 (Fed. Cir. 1984) ("[D]evices changing the patented invention with advances developed subsequent to the patent could infringe under the doctrine of equivalents.").
(2) to protect fully the patentee's invention. Since these are opposing goals, they cannot be reconciled and no solution completely satisfies both objectives. The question, however, is one of balance. Emphasis must be placed on the constitutional requirement to promote the useful arts.

An expanded reissue procedure offers the better solution to this inherent tension. The expanded reissue procedure would shift more importance to giving the public fair notice and would allow the public to rely on and design around the claims, thus promoting the useful arts. This emphasis on the constitutional requirement to promote the useful arts would give the patentee less, yet adequate, protection compared to that provided by the doctrine of equivalents.

The expanded reissue procedure appropriately places the responsibility of using proper claim language on the patentee. The patentee controls his fate by choosing the claim language. Under the expanded reissue procedure, the patentee may correct mistakes in claim drafting. No similar protection of the public exists under the doctrine of equivalents. Today's competitors and businesses are subject to an uncertain range of liability, yet they cannot rely on the claim language and lack an analytical framework to determine the scope of the claims. Unfortunately, as the law stands today, the public's only options entail costly litigation to defend non-literal infringement or total restraint from using the product or process. It is only fair to hold the patentee responsible for his chosen claim language, as the expanded reissue procedure requires. A patent system using the doctrine of equivalents wherein the public cannot rely on the claim language is unfair and fails to satisfy its constitutional mandate.

The expanded reissue procedure would better satisfy the Intellectual Property Clause by allowing the public to design around patents, thus encouraging progress in the useful arts. Furthermore, under the proposal, the patentee must be cognizant

107 See Pennwalt, 833 F.2d at 945 (Bennett, J., dissenting in part) ("Equally important to the statutory purpose of encouraging progress in the useful arts, is the policy of affording the patent owner complete and fair protection of what was invented.").
of new technology relevant to his invention; this further promotes the constitutional purpose of the patent system by increasing public knowledge through the patentee's resulting claims in his reissue patent.

F. THE PROPOSED REISSUE EXPANSION SATISFIES THE POLICY CONSIDERATIONS OF THE DOCTRINE OF EQUIVALENTS

An expanded reissue procedure would meet the Supreme Court's goals in approving the doctrine of equivalents. The expanded reissue procedure protects against a copyist, protects the inventor, and prevents fraud on a patent.

In *Graver Tank*, the Supreme Court recognized that

> to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. \(^{108}\)

The expanded reissue procedure would satisfy the goal of protecting the patentee from the "unscrupulous copyist." This is true even though the patentee may not have the same scope of coverage against infringement by the copyist. \(^{109}\) After the PTO grants the reissue and literal infringement exists under the reissue claims, a court applying its equity balancing pursuant to 35 U.S.C. § 252 will not allow the "unscrupulous copyist" to continue manufacturing and selling the product or process. This remedy will discourage a copyist in the same way potential liability discourages a copyist under the doctrine of equivalents.

The *Graver Tank* Court also noted a second concern: without the

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\(^{109}\) Infringement may not exist until the reissued patent is granted, and then intervening rights may arise.
doctrine of equivalents, the inventor would be “at the mercy of verbalism,” “subordinating substance to form,” and “[deprived] of the benefit[s] of his invention, foster[ing] concealment rather than disclosure of inventions.” The reissue procedure solves this problem of subordinating substance to form by allowing the patentee to expand the claim language in a reissue. Moreover, the patentee in this ex parte process would be responsible for his chosen claim language. Thus, the goal of protecting the inventor is met without the paternalism evidenced in other areas of the law, such as analogous contract and property law.

The Graver Tank Court enunciated a final goal: one may not practice fraud on a patent. Filing a reissue will alleviate fraud by allowing the patentee to correct mistakes in claim drafting. The expanded reissue procedure, similar to the doctrine of equivalents, thus meets this goal.

IV. PATENTEE CONCERNS WITH THE PROPOSED SOLUTION

Under the proposed expansion of the reissue procedure, the patentee may have two concerns: intervening rights and burden of proof considerations. Neither of these concerns, however, undermine the validity of this proposal. The expanded reissue proposal offers an appropriate level of protection for both the public and the patentee.

A. INTERVENING RIGHTS

The possible existence of intervening rights is, from the patentee's perspective, a drawback of the expanded reissue procedure.

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110 Id.
111 See infra notes 112-115 and accompanying text (discussing contract and property analysis compared to doctrine of equivalents).
112 Graver Tank, 339 U.S. at 608. Fraud on a patent occurs when an infringer steals the benefits of an invention.
113 From the patentee's perspective, however, the potential intervening rights create an imperfection. Nevertheless, the balance between complete protection of the patentee and the public's ability to rely on the language of the patent must be set. A preference should exist for the expanded reissue procedure for many reasons including the problems with the doctrine of equivalents, the constitutional mandate to promote the useful arts, and the permanency of the reissue procedure.
Under the proposed system, however, this drawback is mitigated because filing for a reissue would bar subsequent infringers from obtaining any benefits from intervening rights. Intervening rights, however, would arise only when the alleged non-literal infringer acts before the reissue filing date. The party using the invention is not potentially liable until the grant date of the reissue. After the PTO grants the reissue, the now-infringing party could continue to use or to market the product as the court deems equitable. These modified intervening rights are acceptable and fair. The patentee, as opposed to the public and the courts, should be responsible for using the proper claim language. Thus, if the claims are too restrictive, the patentee should be responsible, rather than the party relying on the patent language.

Analogous legal arguments support the proposition that the patentee should be responsible for his claim language. For example, if a business owner decides a contract is more restrictive than desired, the courts will not expand its scope to cover what was excluded during its drafting. The same principle should apply to a patent claim. Similarly, if a real property owner divides an estate but incorrectly records the "metes and bounds," the courts will not broaden the limits of one sub-estate at the expense of another. Instead, non-judicial changes are required. Alteration of the "metes and bounds" of a patent should also require a non-judicial procedure. In contrast, the doctrine of equivalents provides more leniency than analogous contract and property law. This increased tolerance exists because the claim boundaries are not rigidly set. Specifically, the doctrine of equivalents "expands the right to exclude to 'equivalents' of what is claimed." Based upon these analogous legal arguments, the leniency that courts use under the doctrine of equivalents is unwarranted.

114 See 17A C.J.S. Contracts § 373 (1963) ("[T]he law does not countenance a change in the contractual status which would result in unfair advantage to one and impose undue burden on the other.").
The expanded reissue procedure would use the same standard for a plaintiff to prevail as in other civil actions. Under the doctrine of equivalents, the standard for the plaintiff to prevail at trial may be lower than in other civil matters. This latitude is misplaced, not only considering these analogous legal theories, but also because a patentee during prosecution is operating in an ex parte proceeding. Under the expanded reissue procedure, the courts would strictly and literally interpret the patent claim language. The inventors and their agents thus would be held to a higher, though not unreasonable, standard. The patentee may remedy the improperly written claims by filing a reissue. And, if a patentee files a reissue before another party uses the product or process, corrections may be implemented without the consequences of intervening rights.

The patentee has an additional weapon to protect his invention: use of a “means-plus-function” claim. This statute permits the patentee to use broad functional language in the claims to explain the invention. The patentee, without using the reissue procedure, may file an infringement action against any party producing or selling his invention with insubstantial changes and substitutions, thus evading any intervening rights.

Based upon analogous legal arguments and the standards used in other civil matters, the use of modified intervening rights would be fair and proper under the proposed reissue procedure.

B. BURDEN OF PROOF CONSIDERATIONS

Present law places the burden of proving infringement on the

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure material, or acts described in the specification and equivalents thereof.

119 Id.

120 In some instances, however, the means-plus-function claims may not be useful, such as in unpredictable arts. See Adelman & Francione, supra note 16, at 714 n.176, 722 n.213 (discussing need for greater disclosure to support broad claim when technology is unpredictable, such as in chemical reactions or in other art with unpredictable, rather than predictable, factors).
patentee while the defendant bears the burden of proof for the affirmative defense of patent invalidity. This affirmative defense requires proof by clear and convincing evidence because all patent claims by statute are entitled to a presumption of validity. The defendant also bears the burden of proof for affirmative defenses concerning the doctrine of equivalents, such as prosecution history estoppel and claim invalidity. These affirmative defenses must satisfy a preponderance-of-the-evidence standard.

Under an expanded reissue procedure, the patentee would still carry the burden to prove literal infringement of the reissued patent. The accused infringer would likewise bear the burden to prove patent invalidity by clear and convincing evidence. Since the doctrine of equivalents would not apply, the patentee would no longer address the scope of equivalents. The defendant, correspondingly, would not use affirmative defenses specific to the doctrine of equivalents, such as prosecution history estoppel. Instead, the patentee, in effect, would prove the "equivalents" to the PTO. The patentee thus would still prove the same claims, but to the PTO instead of to a court as he would under the doctrine of equivalents.

The PTO must meet a preponderance-of-the-evidence standard to reject the patentee's reissue. Likewise, the doctrine of equivalents requires that the defendant, in order to reject the plaintiff's equivalents, must satisfy a preponderance-of-the-evidence standard.

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123 E.g., Jones v. Hardy, 727 F.2d 1524, 1528 (Fed. Cir. 1984).
125 E.g., Carman Indus. v. Wahl, 724 F.2d 932, 942 (Fed. Cir. 1983).
126 Id. at 942 n.28; JACK H. FRIEDENTHAL ET AL., CIVIL PROCEDURE HANDBOOK § 9.2, at 441 n.5; see generally 60 AM. JUR. 2D Patent § 1072 (1987).
127 See Wilson Sporting Goods Co. v. David Geoffrey & Assocs., 904 F.2d 677, 685 (Fed. Cir. 1990) (placing burden on plaintiff to prove hypothetical claims because "any other approach would ignore the realities of what happens in the PTO and violate established patent law").
128 In re Caveny, 761 F.2d 671, 674 (Fed. Cir. 1985) ("[T]he standard of proof required to properly reject the claims of a patent application is necessarily lower than that required to invalidate patent claims . . . . [P]reponderance of the evidence is the standard that must be met by the PTO in making rejections . . . .").
Arguments may arise that the accused infringer may lose judicial protection in comparison to the doctrine of equivalents, but this criticism is inappropriate. First, the standards are not exactly equivalent. The patentee wins against the PTO and loses against the defendant when the evidence for the patentee is exactly equal to the opposing evidence. Determining when the evidence satisfies the preponderance-of-the-evidence standard is somewhat arbitrary; thus, a small variation in judicial line drawing creates questionable concerns. This questionable concern is further mitigated since an expanded reissue procedure would permit the PTO to develop knowledgeable, consistent standards in establishing this preponderance-of-the-evidence standard. Conversely, under the current doctrine of equivalents, the standards could vary from court to court, further discouraging a competitor from attempting to design around the patented device.

Second, opponents of this proposal may also argue that the PTO would use less resources than a defendant trying to reject the patentee's "equivalent," thus undermining the patentee's protection. A reexamination procedure mitigates this concern and protects the public. The accused infringer may request the reexamination, and the PTO will approve the request if a "substantial

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129 The prosecutor's burden may be lower than the preponderance-of-the-evidence standard. When the burden is on the PTO, then a situation where the evidence is evenly balanced would lead to the granting of a patent. See Parker, supra note 16, at 281 n.72. In comparison, the defendant would prevail if an evenly balanced situation exists in a civil trial. See generally SSIH Equipment S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 380 (Fed. Cir. 1983) (Nies, J., additional views) ("It suffices for present purposes simply to recall that in American law a preponderance of the evidence is rock bottom at the fact-finding level of civil litigation.").


Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

131 37 C.F.R. § 1.510(a) (1992) states: "Any person may, at any time during the period of enforceability of a patent, file a request for reexamination by the Patent and Trademark Office of any claim of the patent on the basis of prior art patents or printed publications cited
new question of patentability" exists. The reexamination, although an ex parte proceeding, may significantly involve the party requesting the reexamination. The accused infringer possesses an important advantage under the reexamination procedure. The granted reissue enjoys no presumption of validity; instead, the reexamination is neutral, free of any presumptions. The knowledgeable and experienced PTO, rather than an unspecialized court, conducts this reexamination. Furthermore, a reissue proceeding does not bar an accused infringer from using the affirmative defense of patent invalidity in a subsequent trial. Thus, if the PTO improperly grants a reissue, the reexamination procedure provides the public and an accused infringer with recourse.

Therefore, based upon the burden of proof considerations, the proposed expanded reissue provision adequately protects the patentee. The possibility of a reexamination protects the public.

V. HYPOTHETICAL APPLICATIONS OF THE EXPANDED REISSUE PROCEDURE

Applying the expanded reissue procedure to past appellate court cases effectively illustrates the expanded reissue procedure. Graver Tank, arguably the most cited doctrine of equivalents case, is an appropriate example. This Supreme Court case involved two electric welding compositions or fluxes. The claims for the fluxes encompassed a combination of alkaline earth metals. In using the invention, the patentee combined silicates of calcium and magnesium, two alkaline earth metal silicates. The alleged infringer's device was similar in all respects except that it used silicates of
manganese, a non-alkaline earth metal, instead of silicates of magnesium. The alleged infringer also used the same mechanical methods, resulting in identical welds. Based upon these similarities and the trial court record, the Court ruled for the patentee, holding that "[i]t is difficult to conceive of a case more appropriate for application of the doctrine of equivalents." 136

An expansion of the reissue procedure provides a more efficient way to reach the same result. When the patentee discovered the alleged infringement, he could apply for a reissue. The proposal would also permit the patentee to apply for a reissue if he realized that a copyist could use another metal to infringe his patent or if manganese was recently discovered (the new technology provision), thus circumventing intervening rights. In theory, the PTO would likely reach the same result as the Court and grant the reissue; 137 the PTO, however, would be a more efficient use of resources since a specialist in this field would grant the reissue. After the PTO approved the reissue, the patentee could bring suit for literal infringement. Since the patentee's claim would now explicitly encompass manganese, summary judgement for the infringement would be possible.

In contrast to this illustration of the proposed reissue procedure, the trial process under the doctrine of equivalents is more complex. For example, the Supreme Court noted the scope of evaluation endured by the trial court:

This trial occupied some three weeks, during which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. 138

136 Id. at 612.
137 But see Wegner, supra note 16, at 28 (noting that as simple matter of chemistry, Graver Tank holding is incorrect).
Under the expanded reissue procedure, a trial to resolve the literal infringement issue would require less resources than the above-described three week hearing because of the benefits of the PTO’s experience and knowledge.

Once the court decides the literal infringement issue under the expanded reissue procedure, the question of intervening rights arises if non-literal infringement began prior to the filing date. If intervening rights are applicable, the patentee has no recourse until the reissue is granted and the defendant is not liable during this period. For the period after the reissue, the court would decide using equitable considerations whether to allow the defendant to continue using the flux. Under the facts in Graver Tank, it is likely that the defendant would be judged not to have rights after the reissue is granted since the record “contain[ed] no evidence of any kind to show that [the defendant’s flux] was developed as the result of independent research or experiments.” In fact, the Supreme Court in Graver Tank repeatedly emphasized that the defendant’s flux was a product of imitation, not experimentation or invention.

The expanded reissue procedure would consider these important equitable concerns. Articulation of the function/way/result test, however, does not facially consider this equitable factor. Thus, the expanded reissue procedure better incorporates the Supreme Court’s equity rationale than does the present doctrine of equivalents. Furthermore, under the expanded reissue procedure, the public could design around the patent claim without the fear of liability for non-literal infringement.

Another pertinent hypothetical applies the expanded reissue procedure to the facts of the Wilson Sporting Goods case. In this case, the patented item was a golf ball, constructed with many dimples on its surface. In the plaintiff’s claims, the golf ball design

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139 See supra notes 47-54 and accompanying text (for a discussion of 35 U.S.C. § 252 patent reissue procedures).
140 Id.
141 Graver Tank, 339 U.S. at 611.
142 Id.
143 This emphasis on equity is important, especially since the doctrine of equivalents arose from fairness considerations.
included six great circle paths which did not intersect any of these dimples. The defendant's golf balls also used six great circles, but the dimples intersected the great circles. A third golf ball, prior art existing before the plaintiff's patent, also had great circles intersected by dimples. The trial court ruled that the defendants willfully infringed the plaintiff's patent. On appeal, the CAFC held that no infringement occurred since the equivalents encompassed the prior art. ¹⁴⁶

In this situation, an expanded reissue procedure again would more efficiently reach the same result. The plaintiff would request a reissue to expand the scope of its claims to encompass golf balls with dimples that intersected the six great circles. Prior art would preclude the reissue, as the CAFC found under these facts. The plaintiff therefore could not successfully bring an infringement suit. If the plaintiff did file a complaint, the court would summarily dismiss it. Thus, the expanded reissue procedure would require less time, money, and resources to achieve the same result.

As a variation of this hypothetical, the plaintiff could have made two independent claims during patent prosecution—one for a golf ball with dimples intersecting the great circles and another for dimples that did not intersect the great circles. The PTO would have rejected the first claim based on prior art preclusion. If another defendant constructed golf balls with dimples intersecting the great circles, the PTO would deny the plaintiff's reissue application, precluding the plaintiff from successfully bringing a literal infringement suit. Although under the present system a district court would reach the same conclusion, the expanded reissue procedure is less expensive and more efficient for the parties, the court, and the public.

VI. CONCLUSION

From its origins, the purpose of the doctrine of equivalents was to protect the patentee. Today, the doctrine supports the same goal, but many problems have arisen. An expanded reissue procedure eliminates many of the problems and uncertainties created by the doctrine of equivalents, while satisfying the same

¹⁴⁶ Id. at 686.
objectives.

An expanded reissue procedure provides numerous advantages over the judicially created doctrine of equivalents. First, and most importantly, the reissue proposal better meets the Constitutional mandate to promote the useful arts by allowing the public to design around patents. The expanded reissue procedure additionally would result in more consistent decisions by using the PTO’s expertise. This proposal would also alleviate problems that the federal courts experience with the doctrine of equivalents. By using the PTO, the expanded reissue procedure would be more efficient for the courts and the litigants.

Congressional adoption of the expanded reissue procedure would assign adjudication of patent equivalents to the PTO instead of to the federal courts. This system would use resources more effectively than under the doctrine of equivalents because the PTO would decide technical matters. The court would then determine whether there was a literal infringement under the reissue patent. If the court found literal infringement, it would determine associated damages and equitable relief. This simple solution is better than the present uncertainty created by the doctrine of equivalents. The Supreme Court in *Graver Tank* noted that literal infringement is “dull,” but considering the many problems plaguing the doctrine of equivalents, there is something to be said for a court only deciding a mundane, or “dull,” type of infringement.

ALLAN G. ALTERA

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146 *Graver Tank*, 339 U.S. at 607.