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Comment

A Rebuttable Presumption of Dedication: Protecting the Hard-Luck Patentee From *Johnson & Johnston's* Dedication Rule

*Thomas R. Hipkins**

To further the constitutional objective of “promot[ing] the Progress of Science and useful Arts,”¹ an effective patent system must carefully balance the need to provide fair coverage for patent owners with the need to provide fair notice to the public of what it can and cannot do.² Fair coverage induces inventors to invent, and more importantly, induces others to invest in the invention’s development.³ Fair notice allows competitors to use a patent’s disclosure to “design around” the patent without fear of liability, and perhaps thereby improve on the invention.⁴ The judiciary has debated on how to strike the proper balance when a patentee discloses subject matter in the specification—the part of the patent document that describes the invention—but does not include it in the claims—

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1. U.S. CONST. art. I, § 8, cl. 8.

2. See *Paulik v. Rizkalla*, 760 F.2d 1270, 1276 (Fed. Cir. 1985) (discussing the patent system’s balance between protecting exclusive rights and adding to the “store of knowledge”); Rebecca S. Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. CHI. L. REV. 1017, 1024 (1989) (citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480-81 (1974)).

3. See Eisenberg, *supra* note 2, at 1024-25 (noting that exclusive rights are critical as “too few inventions will be made in the absence of patent protection because inventions once made are easily appropriated by competitors of the original inventor who have not shared in the costs of invention”).

4. See Matthew J. Conigliaro et al., *Foreseeability in Patent Law*, 16 BERKELEY TECH. L.J. 1045, 1056-57 (2001).

the part of the patent document that delineates the property rights.⁵ On one hand, the judiciary has created the doctrine of equivalents, which prevents copyists from making insubstantial changes to escape the literal claim language and avoid liability.⁶ One could argue that someone who practiced disclosed but unclaimed subject matter would be liable to the patentee for infringement, if such subject matter were equivalent to the claimed subject matter. On the other hand, the judiciary has also created the dedication rule, which states that disclosed but unclaimed subject matter is dedicated to the public domain.⁷

In *Johnson & Johnston Associates v. R.E. Services Co.*, the Federal Circuit had the opportunity to determine whether patentees could assert property rights in disclosed but unclaimed subject matter under the doctrine of equivalents or whether such subject matter was dedicated to the public.⁸ Rather than carefully striking a protection/notice balance, the court held that such subject matter was dedicated to the public regardless of the surrounding facts.⁹ Since then, the Supreme Court, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, rejected a similar rule that limited patentees' access to the doctrine of equivalents, holding that such a rule would unfairly upset the protection/notice balance by stripping patentees of vital protection.¹⁰

This Comment asserts that future courts should not follow the *Johnson & Johnston* bright-line dedication rule because it is inconsistent with the Supreme Court's doctrine of equivalents cases, as evidenced by the Court's recent decision in *Festo*. Part I of this Comment surveys the relevant patent law landscape. Part II details the *Johnson & Johnston* holding and its supporting rationale. Part III explains why the *Johnson & Johnston* rule impermissibly upsets the Supreme

5. See, e.g., *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1051 (Fed. Cir. 2002) (en banc) (per curiam); *YBM Magnex, Inc. v. Int'l Trade Comm'n*, 145 F.3d 1317, 1319 (Fed. Cir. 1998); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106 (Fed. Cir. 1996).

6. See, e.g., *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607-08 (1950).

7. See, e.g., *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991).

8. 285 F.3d at 1051.

9. *Id.* at 1054.

10. 122 S. Ct. 1831, 1840-41 (2002) (rejecting the Federal Circuit's "absolute bar" approach to prosecution history estoppel).

Court's notice and protection balance, and proposes a rule for application in future dedication cases. This Comment urges future courts deciding cases in which patentees disclose but do not claim equivalent subject matter to apply a rebuttable presumption of dedication.

I. REALIZING A PROPER BALANCE BETWEEN PROTECTION AND NOTICE

Granting exclusive rights to inventors is key to an effective patent scheme because, in a free-market economy, the exclusivity is the only economic justification for investing large amounts of money and human resources in developing new inventions and then disclosing them to the public.¹¹ For example, it costs an average of \$800 million, and takes between twelve and fifteen years, to develop and test each new pharmaceutical through FDA approval.¹² If a pharmaceutical company knew that at the end of drug development, its competitors could skip the research and testing stages and simply copy its research results to create and market identical products, it would logically do one of two things: it would refrain from investing in drug development altogether,¹³ or it would protect the process and the product's formula via trade secret.¹⁴ Both actions would stifle innovation and deprive the public of potentially life-saving pharmaceuticals.¹⁵ The patent

11. See F. Scott Kieff, *Property Rights and Property Rules for Commercializing Inventions*, 85 MINN. L. REV. 697, 707-12 (2000).

12. Gary S. Becker, *Get the FDA Out of the Way, and Drug Prices Will Drop*, BUS. WK., Sept. 16, 2002, at 16; see also Pfizer Inc., *The Value & Cost of Pharmaceuticals: Questions & Answers*, at <http://www.pfizer.com/pfizerinc/policy/medicare-q&a.html> (reporting that it costs more than \$500 million and takes an average of fifteen years to get a drug approved by the FDA) (last visited Oct. 4, 2002).

13. Kieff, *supra* note 11, at 710.

14. See Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 CAL. L. REV. 241, 266 (1998) (stating that, as a result of inventors keeping their inventions secret, "future innovators will not be able to learn from the scientific and technological insights that led to the original invention, slowing the overall rate of innovation").

15. One commentator expressed the undesirable consequences of an economic system in which inventors did not get exclusive rights to their inventions as follows:

Why should one *entrepreneur* incur the cost and the risk of experimenting with a new machine if another can look on, ascertain whether the device works well or not, and duplicate it if it is successful? Under such conditions the man who watches others, avoids their losses, and shares their gains is the one who makes

system's protection function is essential to inducing innovation.

Notifying the rest of the world of the patentee's exclusive rights, however, allows others to "design around" the patent. That is, read the patent and create new inventions from what they learn without fear of being sued for infringement.¹⁶ Ambiguity in the scope of the exclusive rights creates "[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement."¹⁷ A robust notice function benefits society by making incremental innovative advances possible.¹⁸

In most instances, these two critical interests furthered by the patent system—the protection function and the notice function—conflict with each other.¹⁹ Balancing these respective interests is vital to a good patent system, but is often difficult to do.²⁰ When a patentee attempts to assert the doctrine of equivalents to cover disclosed but unclaimed subject matter, this difficulty becomes manifest.²¹

money; and the system that gave a man no control over the use of his inventions would result in a rivalry in waiting for others rather than an effort to distance others in originating improvements.

JOHN BATES CLARK, *ESSENTIALS OF ECONOMIC THEORY* 360 (1907).

16. See John N. Kandara, Note, *Application of the Doctrine of Equivalents to Means Plus Function Claims: WMS Gaming Inc. v. International Game Technology*, 50 DUKE L.J. 887, 891 (2000) (citing 35 U.S.C. § 154 (2000)).

17. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

18. Ellisen S. Turner, Note, *Swallowing the Apple Whole: Improper Patent Use by Local Rule*, 100 MICH. L. REV. 640, 646 (2001).

19. Conigliaro et al., *supra* note 4, at 1057 ("The protective and notice functions of patents exist in some tension.").

20. See *id.* at 1053 ("The difficulty is that the stronger the rights the law grants to pioneering inventors, the more difficult it becomes for others to improve on those pioneering inventions.").

21. See Scott R. Boalick, Note, *The Dedication Rule and the Doctrine of Equivalents: A Proposal for Reconciliation*, 87 GEO. L.J. 2363, 2364 (1999). The author noted,

Although the disclosed subject matter is not specifically claimed as part of the invention, anyone making, using, or selling the subject matter could still be liable for patent infringement if the doctrine of equivalents is found to apply. This tension between the public notice function of the claims and the doctrine of equivalents has been present in U.S. patent law since its inception.

Id.

A. PATENT LAW FUNDAMENTALS

1. Obtaining a Patent

To obtain a patent, applicants must convince the United States Patent and Trademark Office (USPTO) that both their invention and their application satisfy statutory requirements.²² The Patent Act requires inventions, which are measured wholly by the language of the patent claim, to consist of patentable subject matter,²³ to be novel,²⁴ to be useful,²⁵ and to be nonobvious.²⁶ The Patent Act requires applications to satisfy the enablement requirement, the written description requirement, and the claim definiteness requirement.²⁷ The enablement requirement mandates applicants to disclose enough about the invention in the application's specification section to enable a skilled artisan to make and use it.²⁸ To satisfy the written description requirement, the applicant's specification must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention."²⁹ Claim definiteness requires applicants to particularly point out and distinctly claim the subject matter they regard as their invention.³⁰ The claims, like the "metes and bounds" of a deed, define a patentee's property rights in a patent.³¹

The applicant engages in a negotiation process, called prosecution, with an examiner at the USPTO to establish his invention's patentability.³² All of the correspondence between the examiner and the applicant is kept in a file called the prosecution history. Once the applicant and the examiner

22. John M. Czarnetzky, Note, *Altering Nature's Blueprints for Profit: Patenting Multicellular Animals*, 74 VA. L. REV. 1327, 1336 (1988).

23. 35 U.S.C. § 101 (2000).

24. *Id.* § 102(a).

25. *Id.* § 101.

26. *Id.* § 103.

27. *Id.* § 112.

28. *Id.* § 112, ¶ 1.

29. *New Railroad Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1295 (Fed. Cir. 2002) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)).

30. 35 U.S.C. § 112, ¶ 2.

31. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

32. 35 U.S.C. § 131; Craig Allen Nard, *Certainty, Fence Building, and the Useful Arts*, 74 IND. L.J. 759, 776 (1999).

agree on the patent's property rights, the patent issues, the prosecution history is published, and the exclusive rights become enforceable.³³

Inventors who are dissatisfied with their claims' scope have two options to correct it, depending on when they decide to take action. An applicant who wishes to broaden his claim's scope before issuance can file a continuation application, which allows a patentee to modify the claim's scope while keeping the same disclosure.³⁴ A patentee wishing to broaden his claim's scope after issuance can file a broadening reissue application, in which the patentee can simply correct the claims.³⁵

2. Enforcing a Patent's Exclusive Rights

The U.S. patent system grants applicants who satisfy patentability requirements the right to exclude others from making, using, or selling the claimed inventions for twenty years from the date their application was filed.³⁶ A patentee can sue anyone who infringes those exclusive rights.³⁷ Once litigation ensues, the first step in determining whether a particular product or process infringes a patent claim is to construe the claim.³⁸ In what is called a *Markman* hearing,³⁹ the court construes the claims by consulting both intrinsic⁴⁰ and extrinsic⁴¹ sources.⁴² The fact finder⁴³ then investigates

33. See Mark D. Janis, *Rethinking Reexamination: Toward a Viable Administrative Revocation System for U.S. Patent Law*, 11 HARV. J.L. & TECH. 1, 44 n.188 (1997).

34. See 35 U.S.C. § 120; Jay David Schainholz, Note, *The Validity of Patents After Market Testing: A New and Improved Experimental Use Doctrine?*, 85 COLUM. L. REV. 371, 388 n.87 (1985).

35. See 35 U.S.C. § 251; Boalick *supra* note 21, at 2367-68.

36. 35 U.S.C. § 154(a).

37. *Id.* § 281.

38. *Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (Fed. Cir. 2001).

39. Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH. 1, 7 (2001) (referring to claim construction hearings as *Markman* hearings). These proceedings are so dubbed because of the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). There, the Court clarified that claim construction is a matter of law. *Id.* at 372.

40. Intrinsic sources include the claim language, patent specification, and prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (en banc) (quoting *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991)), *aff'd*, 517 U.S. 370 (1996).

41. Extrinsic sources include expert testimony, dictionaries, and treatises. *Id.* at 980.

42. See *id.* at 979-80.

the similarities between the construed claims and the accused device.⁴⁴

B. RELEVANT PATENT LAW JURISPRUDENCE: THE DOCTRINE OF EQUIVALENTS AND THE DEDICATION RULE

Two conflicting patent law doctrines, both dating back to the nineteenth century,⁴⁵ surface in the discussion of the disclosed but unclaimed equivalents.⁴⁶ They are the doctrine of equivalents and the dedication rule.⁴⁷ To assert property rights in disclosed but unclaimed subject matter, a patentee's only option is the doctrine of equivalents.⁴⁸ One could read the dedication rule, however, as preventing patentees from asserting any property rights in such subject matter, including by resorting to the doctrine of equivalents.⁴⁹ Though in apparent conflict, each doctrine finds support in patent jurisprudence.

1. The Doctrine of Equivalents

The doctrine of equivalents is a judicially created doctrine that expands the scope of a patentee's exclusive rights to include products or processes that are substantially equivalent to the claimed invention.⁵⁰ It prevents an "unscrupulous copyist" from committing "fraud on a patent."⁵¹ For instance,

43. The fact finder is either a jury or a judge in a bench trial.

44. *Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (Fed. Cir. 2001). Infringement is a question of fact. *Markman*, 517 U.S. at 384.

45. See *Edward Miller & Co. v. Bridgeport Brass Co.*, 104 U.S. 350, 352 (1881) (applying the dedication rule); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342 (1853) (applying the rule that later became known as the doctrine of equivalents).

46. See Boalick, *supra* note 21, at 2363-64.

47. *Id.*

48. *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 812 (Fed. Cir. 2002) (explaining that, even though an accused device does not literally infringe, it may infringe under the doctrine of equivalents).

49. See *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054 (Fed. Cir. 2002) (per curiam) (en banc); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1106-07 (Fed. Cir. 1996).

50. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683-84 (Fed. Cir. 1990) ("To say that the doctrine of equivalents extends or enlarges the claims is a contradiction in terms. The claims—i.e., the scope of patent protection as defined by the claims—remain the same and application of the doctrine expands the right to exclude to 'equivalents' of what is claimed.").

51. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607-08 (1950).

suppose a pharmaceutical company's patent claims a composition of four chemical elements. The claims recite one of the elements as "between 2.2 and 2.5 grams of Chemical X." A competitor copies the other three elements exactly, but includes 2.5001 grams of Chemical X. If the pharmaceutical company's exclusive rights extended only to embodiments that fell within the claim's literal language, the competitor would escape liability. The competitor could avoid the twelve to fifteen years and \$800 million invested by the average pharmaceutical company and make a seemingly unfair profit.⁵² In response to situations like this, courts created the doctrine of equivalents.⁵³

In patent litigation, after the *Markman* hearing,⁵⁴ the fact finder reads the claims on the accused product or process.⁵⁵ To find infringement, the fact finder must find every claim limitation or its substantial equivalent in the accused product or process.⁵⁶ An element in the accused device is equivalent to a claim limitation if the differences between them are insubstantial.⁵⁷

52. See *supra* note 12 and accompanying text.

53. See *Graver Tank*, 339 U.S. at 607-08.

54. See *supra* notes 39-42 and accompanying text.

55. See *supra* note 44 and accompanying text.

56. See *DeMarini Sports v. Worth, Inc.*, 239 F.3d 1314, 1322 (Fed. Cir. 2001) (citing *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994)). The Federal Circuit prefers the use of the term "element" to refer to a component in the accused device, and the term "limitation" to refer to a component of the claimed invention. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 563 n.1 (Fed. Cir. 2000), *rev'd on other grounds*, 122 S. Ct. 1831, 1840 (2002). The requirement that the accused product or process must have every claim limitation or its substantial equivalent has been dubbed the "all-limitations rule." To illustrate the all-limitations rule, consider the pharmaceutical example. See *supra* notes 50-52 and accompanying text. For the pharmaceutical company to successfully prove infringement of its drug patent, the accused composition would have to contain all four of the claim limitations, either literally or by equivalents. Therefore, suppose the accused composition contained 2.6 grams of Chemical X, and only two of the other three claim limitations. The all-limitations rule would prevent the pharmaceutical company from asserting the doctrine of equivalents irrespective of whether 2.6 grams of Chemical X was equivalent to "between 2.2 and 2.5 grams of Chemical X."

57. *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1423 (Fed. Cir. 1997). To determine whether the difference between the claim limitations and the accused elements are insubstantial, "[a]n important factor is whether persons reasonably skilled in the art would have known of the interchangeability." *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950). Also, courts have determined substantiality by asking "whether the accused device 'performs substantially the same function in substantially the same way to obtain the same result' as the claim limitation."

Originally announced almost a century and a half ago,⁵⁸ the doctrine of equivalents took root in two landmark twentieth century patent cases, namely *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*,⁵⁹ and *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*⁶⁰ In both cases, the Court acknowledged that the doctrine of equivalents creates uncertainty for competitors, but held that its protection function benefits outweighed the uncertainty.⁶¹ In the Court's first twenty-first century doctrine of equivalents case, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, the Court restated this protection/notice balance.⁶²

a. *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*

The Supreme Court comprehensively endorsed the doctrine of equivalents in 1950 in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*⁶³ There, the claimed invention was a welding flux, one component of which was a chemical known as a silicate.⁶⁴ The accused flux used a manganese silicate.⁶⁵ In earlier litigation involving the same patent, the Supreme Court had invalidated a claim to "silicates" and "metallic silicates,"⁶⁶ but the patentee asserted a still valid claim to "alkaline earth metal silicates."⁶⁷ The accused manganese silicate was a "silicate" and a "metallic silicate," but was not an "alkaline earth metal silicate."⁶⁸ The Court noted that the doctrine of

Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d 801, 813 (Fed. Cir. 2002) (quoting *Graver Tank*, 339 U.S. at 608).

58. See *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342 (1853) (recognizing that the patentee's claim covered not only the embodiment contained within the claim, but also "all other forms which embody his invention").

59. 339 U.S. at 607-10.

60. 520 U.S. 17, 25-42 (1997).

61. See *id.* at 28-29 (applying the doctrine of equivalents despite concerns regarding indiscriminate application of it); *Graver Tank*, 339 U.S. at 607 (applying the doctrine of equivalents, but noting that courts' first resort must be to the literal claim language).

62. 122 S. Ct. 1831, 1837-38 (2002).

63. 339 U.S. at 607-10.

64. See *id.* at 610.

65. *Id.*

66. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 276-77 (1949) (*Graver Tank II*).

67. *Graver Tank*, 339 U.S. at 610.

68. *Id.* Several other claims that literally encompassed manganese were invalidated in prior litigation as being too broad. See *id.* at 616 (Black, J.,

equivalents was “not the prisoner of a formula,”⁶⁹ and affirmed the lower court’s finding of infringement.⁷⁰ The *Graver Tank* Court held that although the manganese silicate was not literally an “alkaline earth metal silicate,” it was an equivalent.⁷¹

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

The Supreme Court revisited the doctrine of equivalents in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,⁷² a case in which the accused infringer, with heavy support from amici, advocated for the doctrine’s abolition.⁷³ The Court unanimously upheld the doctrine’s viability.⁷⁴ After endorsing a flexible application of the doctrine of equivalents,⁷⁵ the Court attempted to clarify a safeguard designed to prevent its indiscriminate application: prosecution history estoppel.⁷⁶

dissenting) (referring to *Graver Tank II*).

69. *Id.* at 609.

70. *Id.* at 612.

71. *Id.* (“Though infringement was not literal, the changes which avoid literal infringement are colorable only.”).

72. 520 U.S. 17, 25-42 (1997).

73. See Donald S. Chisum, *The Supreme Court and Patent Law: Does Shallow Reasoning Lead to Thin Law?*, 3 MARQ. INTELL. PROP. L. REV. 1, 18-19 (1999) (discussing the *Warner-Jenkinson* amicus briefs).

74. See *Warner-Jenkinson*, 520 U.S. at 25-28. The Court rejected the accused infringer’s four arguments that the judicially created doctrine of equivalents did not survive the 1952 Patent Act amendments. *Id.* at 25-28. The accused infringer’s four arguments are summarized as follows. The first three related to 35 U.S.C. § 112, the reissue process, and the prosecution process respectively. *Id.* at 25. The Court held that because these arguments with respect to the 1952 Patent Act amendments were substantially the same as arguments rejected in *Graver Tank* with respect to the 1870 Patent Act amendments, they should suffer the same fate. See *id.* at 26. The accused infringer’s fourth argument was that the “and equivalents thereof” language contained in the “means-plus-function” provision found in 35 U.S.C. § 112, ¶6 precluded courts from allowing the additional protection of the doctrine of equivalents. *Id.* at 25-28. The Court rejected that argument

because § 112, ¶6 was enacted as a targeted cure to a specific problem [i.e., a court decision rejecting a “means-plus-function” claim], and because the reference in that provision to “equivalents” appears to be no more than a prophylactic against potential side effects of that cure, such limited congressional action should not be overread for negative implications.

Id. at 28.

75. See *id.* at 24 (quoting *Graver Tank* as stating that what “constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case”).

76. See *id.* at 30-34.

Prosecution history estoppel precludes patentees from asserting the doctrine of equivalents to cover subject matter surrendered by a patentability-related amendment during prosecution.⁷⁷ To determine which amendments were patentability-related, the Court announced a rebuttable presumption.⁷⁸ Unless the patentee could show otherwise, courts were to presume that the amendment was related to patentability.⁷⁹

c. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*

In 2002, the Supreme Court rejected a bright-line rule limiting the doctrine of equivalents by unanimously reversing the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*⁸⁰ The Federal Circuit had held that “prosecution history estoppel acts as a complete bar to the application of the doctrine of equivalents when an amendment has narrowed the scope of a claim for a reason related to patentability.”⁸¹

77. *See id.* at 31-32. To illustrate prosecution history estoppel, consider the pharmaceutical example. *See supra* Part I.B.1. Suppose the USPTO rejected the pharmaceutical company’s claim to “between 2.2 and 2.5 grams of Chemical X.” The pharmaceutical company, to overcome that rejection, amended its claim to read “between 2.2 and 2.4 grams of Chemical X.” Prosecution history estoppel would preclude the pharmaceutical company from asserting the doctrine of equivalents to cover a composition containing 2.5 grams of Chemical X. This is so, regardless of whether 2.5 grams of Chemical X is equivalent to “between 2.2 and 2.4 grams of Chemical X.”

78. *See Warner-Jenkinson*, 520 U.S. at 33.

79. *Id.*

80. 122 S. Ct. 1831, 1840-42 (2002). In dealing with the prosecution history estoppel issue presented by the *Festo* facts, the Supreme Court did not directly address the *Johnson & Johnston* dedication rule. *See id.* at 1839-40 (noting that the two questions presented were what kinds of amendments should give rise to estoppel, and whether estoppel prevents patentees from asserting any range of equivalence). The Federal Circuit’s absolute bar rule for prosecution history estoppel, however, was similar to the *Johnson & Johnston* dedication rule in that both purported to limit patentees’ access to the doctrine of the equivalents in the name of fair notice. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 575 (Fed. Cir. 2000) (en banc) (noting that the absolute bar “preserv[es] the notice function of patent claims”), *rev’d*, 122 S. Ct. 1831 (2002); *infra* note 154 and accompanying text.

81. *Festo*, 234 F.3d at 574. The Federal Circuit’s prosecution history estoppel rule—dubbed a “complete bar,” *id.*—would work in the following way: As in note 56’s illustration, suppose the pharmaceutical company amended its claim from “between 2.2 and 2.5 grams of Chemical X” to “between 2.2 and 2.4 grams of Chemical X” to overcome a USPTO rejection. An absolute bar would prevent the pharmaceutical company not only from covering compositions containing 2.5 grams of Chemical X under the doctrine of equivalents, but also compositions containing any amount greater than 2.4 grams of Chemical X,

In reversing the Federal Circuit, the Supreme Court noted that “the nature of language makes it impossible to capture the essence of a thing in a patent application.”⁸² It would be unfair, the Court reasoned, to penalize a patentee for failing to delineate a crisp line when such a line, because of the nature of the invention, was incapable of crisp delineation.⁸³ The purpose of prosecution history estoppel is to hold patentees to the lines they crisply delineate during prosecution, granting them property rights in subject matter inside those lines and preventing them from asserting property rights in anything outside.⁸⁴

Continuing the rebuttable presumption trend started in *Warner-Jenkinson*, the *Festo* Court announced a rebuttable presumption of prosecution history estoppel.⁸⁵ Unless the patentee can show that he did not abandon all claims of equivalence to the amended limitation, he would be presumed estopped from asserting the doctrine of equivalents with respect to that limitation.⁸⁶ The *Festo* decision made clear that the doctrine of equivalents will continue to exist as a valuable protection tool despite its adverse effect on the notice function.⁸⁷

2. The Dedication Rule

The dedication rule states that disclosed but unclaimed subject matter is dedicated to the public.⁸⁸ Under this rule, patentees lose all property rights to such subject matter.⁸⁹ The

including 2.4001 grams.

82. *Festo*, 122 S. Ct. at 1837.

83. *See id.* The business community recognized that the Supreme Court’s reversal of the Federal Circuit’s absolute bar restored needed protection to patentees. *See* Scott Ritter, *High Court Sets Aside Decision That Imperiled Inventor Rule*, WALL ST. J., May 29, 2002, at A4, available at 2002 WL-WSJ 3396041.

84. *See Festo*, 122 S. Ct. at 1839.

85. *Id.* at 1842.

86. *Id.* The Court provided three cases in which the patentee could rebut the presumption: (1) when “[t]he equivalent [was] unforeseeable at the time of the application”; (2) when “the rationale underlying the amendment . . . bear[s] no more than a tangential relation to the equivalent in question”; and (3) “some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.” *Id.*

87. *See id.* at 1837-38.

88. *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991).

89. *See id.*

Supreme Court first announced this rule in the late nineteenth century in *Edward Miller & Co. v. Bridgeport Brass Co.*⁹⁰ Shortly thereafter, the Court reiterated the rule in *Mahn v. Harwood*.⁹¹ Then, after a long absence, the Federal Circuit revived the dedication rule in its 1991 decision in *Unique Concepts, Inc. v. Brown*.⁹²

a. *Edward Miller & Co. v. Bridgeport Brass Co.*

In *Edward Miller*, after fifteen years had passed since the patentee's original patent issued, a market had developed (that included the patentee) for subject matter that he had disclosed but failed to claim.⁹³ The patentee obtained a broadening reissue patent⁹⁴ covering such subject matter, and attempted to assert it against one of his competitors.⁹⁵

The Court invalidated the broadening reissue patent, holding that the Patent Commissioner was without authority to grant such a patent after such an unreasonable delay.⁹⁶ To prevent the harm to the notice function that would result from allowing patentees to assert property rights in subject matter that had clearly been in the public domain for such a long period of time, the Court announced its now familiar dedication rule: "[T]he claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed."⁹⁷

90. 104 U.S. 350, 352 (1881).

91. 112 U.S. 354, 361 (1884).

92. 939 F.2d at 1562-63.

93. 104 U.S. at 351.

94. There was not yet a statutory provision specifically addressing time limits for obtaining broadening reissue patents. See Boalick, *supra* note 21, at 2383 n.223. The patentee simply used the ordinary reissue procedure for the sole purpose of enlarging the scope of his claims. See *Edward Miller*, 104 U.S. at 350-51.

95. *Edward Miller*, 104 U.S. at 350-51.

96. *Id.* at 355 ("The granting of a reissue [merely to enlarge the scope of the claims], after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void."). Because the Court invalidated the broadening reissue patent, it never addressed whether the accused product actually infringed. *Id.* Therefore, the Court had no opportunity to apply, or refuse to apply, the doctrine of equivalents.

97. *Id.* at 352.

b. *Mahn v. Harwood*

Three years after *Edward Miller*, the Supreme Court again addressed the dedication rule in *Mahn v. Harwood*.⁹⁸ On facts similar to *Edward Miller*, the Court invalidated a broadening reissue patent⁹⁹ because it did not issue until nearly four years after the original patent issued.¹⁰⁰ The Court noted the importance of holding patentees accountable for actions that notify the world that they hold no property rights in the disclosed but unclaimed subject matter.¹⁰¹

c. *Unique Concepts, Inc. v. Brown*

More than a century later, the Federal Circuit revived the dedication rule in 1991 in *Unique Concepts, Inc. v. Brown*.¹⁰² The court held that the accused product did not literally contain all of the claim limitations because the patentee dedicated it to the public by disclosing it and failing to claim it.¹⁰³ Holding otherwise, according to the court, would encourage applicants to disclose broadly, claim narrowly to avoid USPTO scrutiny, and assert property rights in the disclosed but unclaimed subject matter after the patent issues. In other words, it would encourage applicants to sneak broad claims past the USPTO.¹⁰⁴ Notably, the *Unique Concepts* court went on to apply the doctrine of equivalents, finding the accused product to be not equivalent to the claimed invention.¹⁰⁵

3. Disclosed but Unclaimed Subject Matter

The doctrine of equivalents and the dedication rule pull in opposite directions when a patentee discloses equivalent

98. 112 U.S. 354, 361 (1884).

99. As in *Edward Miller*, there was not yet a statutory limit on time for obtaining broadening reissue patents. See *supra* note 94 and accompanying text. The patentee simply used the reissue proceeding for the sole purpose of enlarging his claims. *Mahn*, 112 U.S. at 357 ("It is apparent that, in the reissue, the claim of invention is greatly enlarged.")

100. *Id.* at 363-64.

101. See *id.* at 361 (stating that disclosing but failing to claim was "notice to all the world . . . that all those parts of the art, machine or manufacture set out and described in the specification and not embraced in such specific claim, are not claimed by the patentee").

102. 939 F.2d 1558, 1562-63 (Fed. Cir. 1991).

103. *Id.* at 1564.

104. See *id.* at 1562.

105. See *id.* at 1563-64.

subject matter but fails to claim it. The dedication rule of *Edward Miller* and *Mahn* suggests that disclosed but unclaimed equivalents are dedicated to the public and are not part of the patentee's exclusive rights.¹⁰⁶ The doctrine of equivalents, if applied broadly, however, suggests that patentees have the right to prevent competitors from practicing subject matter that is equivalent to their claimed invention, regardless of whether it is disclosed in the specification.¹⁰⁷ No Supreme Court decision has directly addressed whether patentees can assert the doctrine of equivalents to cover disclosed but unclaimed equivalents.¹⁰⁸ The Supreme Court has twice incidentally addressed the issue—in *Graver Tank*¹⁰⁹ and in *Warner-Jenkinson*¹¹⁰—and those opinions suggest that the dedication rule from *Edward Miller* and *Mahn* is not appropriate. Prior to *Johnson & Johnston*, the Federal Circuit had also addressed the issue twice, resulting in an apparent internal conflict.¹¹¹

a. Supreme Court References to Disclosed but Unclaimed Equivalents

In Justice Black's *Graver Tank* dissent, he argued that the patentee should not be able to assert the doctrine of equivalents to cover the manganese silicate because it was disclosed in the specification and did not fall within the alkaline earth metal claim.¹¹² In other words, Justice Black argued that when the Court earlier invalidated the claims covering manganese, it caused manganese to be dedicated to the public. Justice Black could not convince the majority of the Court to adopt such a rule.

In addressing the issue of what subject matter could

106. See *supra* note 97 and accompanying text (announcing *Edward Miller's* rule); see also *supra* note 98 and accompanying text (stating that *Mahn* followed *Edward Miller*).

107. Boalick, *supra* note 21, at 2364.

108. *Id.*

109. 339 U.S. 605, 613-14 (1950).

110. 520 U.S. 17, 37 (1997).

111. *YBM Magnex, Inc. v. Int'l Trade Comm'n*, 145 F.3d 1317 (Fed. Cir. 1998); *Maxwell v. J. Baker, Co.*, 86 F.3d 1098 (Fed. Cir. 1996). The Federal Circuit also addressed the issue, in a non-precedential opinion. *Brunswick Corp. v. United States*, Nos. 97-5017, 97-5021, 1998 U.S. App. LEXIS 7198, at *10-11 (Fed. Cir. Mar. 31, 1998) (following the holding in *Maxwell*).

112. *Graver Tank*, 339 U.S. at 613-14 (Black, J., dissenting); see *supra* Part I.B.1.a (discussing *Graver Tank*).

qualify as an equivalent, the *Warner-Jenkinson* Court discussed three scopes of protection under the doctrine of equivalents, which may be analogized to three concentric circles, each encompassing more subject matter than the one before.¹¹³ The smallest circle, advocated by the accused infringer, encompassed only subject matter that was "disclosed within the patent itself."¹¹⁴ The *Warner-Jenkinson* Court called such a proposition "severe" and refused to adopt it.¹¹⁵ The medium-sized circle encompassed all subject matter that was known at the time of issuance to be equivalent, whether disclosed or not.¹¹⁶ The *Warner-Jenkinson* Court stated that even fixing the boundary of what subject matter could be equivalent at the medium-sized circle would result in too much harm to the protection function.¹¹⁷ The *Warner-Jenkinson* Court held that patentees could rightly assert the doctrine of equivalents to cover all subject matter that fell within the third circle, which included subject matter known at the time of issuance to be equivalent, whether disclosed or not, and all subject matter that was later developed to be equivalent.¹¹⁸ Thus, according to the *Warner-Jenkinson* Court, patentees may assert property rights in subject matter falling within the largest concentric circle if it is equivalent to their claimed inventions.

b. Federal Circuit Precedent Directly Addressing Disclosed but Unclaimed Equivalents

Although the Supreme Court has not directly decided whether a patentee can assert the doctrine of equivalents to cover disclosed but unclaimed equivalents, the Federal Circuit addressed the question on two occasions before *Johnson & Johnston*.¹¹⁹ The two holdings appear to conflict with each other.¹²⁰

In *Maxwell v. J. Baker, Inc.*,¹²¹ the Federal Circuit cited *Unique Concepts* and held that the dedication rule prevents

113. See *Warner-Jenkinson*, 520 U.S. at 37.

114. *Id.*

115. *Id.*

116. *See id.*

117. *See id.*

118. *See id.*

119. See *supra* note 111 and accompanying text.

120. See Boalick, *supra* note 21, at 2390-91.

121. 86 F.3d 1098 (Fed. Cir. 1996).

patentees from asserting property rights in disclosed but unclaimed subject matter, either literally or under the doctrine of equivalents.¹²² Like *Unique Concepts*, the *Maxwell* court feared the prospect of patentees sneaking broad claims past the USPTO by disclosing broadly, claiming narrowly to avoid USPTO scrutiny, and asserting property rights in the disclosed but unclaimed subject matter after the patent issues.¹²³

In *YBM Magnex, Inc. v. International Trade Commission*,¹²⁴ the Federal Circuit refused to follow *Maxwell*.¹²⁵ Although both the *Maxwell* patentee and the *YBM Magnex* patentee asserted the doctrine of equivalents attempting to cover disclosed but unclaimed subject matter, the *YBM Magnex* court split a hair and distinguished *Maxwell*.¹²⁶ According to the *YBM Magnex* court, *Maxwell's* holding, preventing patentees from asserting the doctrine of equivalents to cover disclosed but unclaimed subject matter, applied only to *Maxwell's* facts.¹²⁷

II. JOHNSON & JOHNSTON ASSOCIATES v. R.E. SERVICE CO.

In *Johnson & Johnston*, the claimed invention was a method for manufacturing printed circuit boards (PCBs).¹²⁸

122. *Id.* at 1106-07 (citing *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991)).

123. *See id.* at 1107.

124. 145 F.3d 1317 (Fed. Cir. 1998).

125. *Id.* at 1320-22.

126. *Id.* at 1320 (stating that "*Maxwell* accords with the [Supreme] Court's precedent only when its decision is understood and applied in light of its particular facts"). According to the *YBM Magnex* court, the *Maxwell* patentee disclosed but failed to claim a distinct embodiment, *see id.* at 1320, whereas the *YBM Magnex* patentee disclosed a range broader than he claimed. *See id.* at 1318-19 (noting that the patentee claimed "6,000 to 35,000," but the accused infringer practiced the disclosed but unclaimed range of "between 5,450 and 6,000"). The court used this distinction to justify different outcomes. *See id.* at 1322.

127. *See id.* at 1320.

128. *See Johnson & Johnston Assocs. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054-55 (Fed. Cir. 2002) (per curiam) (en banc). One could argue that the patentee who discloses but fails to claim subject matter could get a broadening reissue patent within two years of issuance and assert the doctrine of equivalents on it. By so doing, the argument would go, the patentee would trump the dedication rule, thus refuting the claim that "whenever the dedication rule applies, it trumps the doctrine of equivalents." The problem with this argument is that, by getting a broadening reissue patent within two years of issuance, the patentee does not trump the dedication rule because the dedication rule would not have applied. The *Johnson & Johnston* dedication

Manufacturing PCBs requires placement of fragile copper foils onto nonconductive material.¹²⁹ Workers would often damage the foils during manual placement.¹³⁰ The claimed invention allowed workers to adhere the copper foils to a stiffer substrate for placement.¹³¹ After placing the copper foil/substrate combination, the worker could remove the substrate, leaving only the copper foil.¹³²

The patent disclosed steel and aluminum as substrate materials, but only claimed aluminum.¹³³ The accused infringer's method was the same as the claimed method, but used the disclosed but unclaimed steel substrate.¹³⁴ The district court granted the accused infringer's motion for summary judgment of no literal infringement.¹³⁵ At trial, however, the jury's verdict found the accused infringer liable for infringement under the doctrine of equivalents.¹³⁶ After a hearing before a three-judge panel, the court sua sponte ordered an en banc rehearing.¹³⁷ The issue for the full court was not whether steel was equivalent to aluminum, but whether, by disclosing steel and failing to claim it, the patentee had dedicated it to the public.¹³⁸

The Federal Circuit, in *Johnson & Johnston*, had the

rule applies only in litigation, after the *Markman* hearing, when the claims' scope becomes clear. After all, there is no way to know for sure what subject matter is disclosed but unclaimed until the court determines what *is* claimed. Under *Johnson & Johnston's* rule, in any particular case where the patentee attempts, post-*Markman*, to assert the doctrine of equivalents to cover disclosed but unclaimed subject matter, the dedication rule trumps the doctrine of equivalents.

129. *Id.*

130. *See id.* at 1049.

131. *Id.*

132. *See id.*

133. *See id.* at 1050. The *Johnson & Johnston* patentee filed for and received two continuation patents, *see supra* note 34 and accompanying text, that literally covered the accused steel substrate. *See Johnson & Johnston*, 285 F.3d at 1055. These patents, however, did not issue until after the litigation between Johnson & Johnston Associates and R.E. Service Co. began. *Compare id.* at 1055 n.2 (noting that the continuation patents did not issue until October 1997 and March 1998), with *Johnson & Johnston Assocs. v. R.E. Serv. Co.*, No. C 97-04382 CRB, 1998 U.S. Dist. LEXIS 20235, at *3 (N.D. Cal. Dec. 23, 1998) (noting that the lawsuit began in January of 1997), *rev'd*, 285 F.3d 1046 (Fed. Cir. 2002).

134. *See Johnson & Johnston*, 285 F.3d at 1050.

135. *See id.*

136. *See id.* at 1051.

137. *Id.* at 1048.

138. *See id.* at 1051.

opportunity to carefully craft the relationship between the doctrine of equivalents and the dedication rule. Instead, it simply held that whenever the dedication rule applies, it trumps the doctrine of equivalents.¹³⁹

A. TREATMENT OF PRECEDENT

The *Johnson & Johnston* opinion began with a quick overview of Federal Circuit precedent, followed by a more detailed analysis of Supreme Court precedent.¹⁴⁰ This is appropriate because Federal Circuit precedent, although instructive, is not binding on the court,¹⁴¹ whereas Supreme Court precedent is binding.¹⁴²

The *Johnson & Johnston* court's overview of Federal Circuit precedent, not surprisingly, began with *Maxwell* and ended with *YBM Magnex*.¹⁴³ The court noted that *Maxwell* established a bright-line dedication rule.¹⁴⁴ Then, the court recounted *YBM Magnex's* limitation of *Maxwell* to its facts by its establishment of a rule dedicating only disclosed but unclaimed distinct embodiments.¹⁴⁵

The *Johnson & Johnston* court spent more time on Supreme Court precedent. First, the court relied on *Edward Miller* and *Mahn* to emphasize the predominant role of patents' claims in defining the scope of the property right.¹⁴⁶ The court

139. See *id.* at 1054-55. One could argue that the patentee who discloses but fails to claim subject matter could get a broadening reissue patent within two years of issuance and assert the doctrine of equivalents on it. By so doing, the argument would go, the patentee would trump the dedication rule, thus refuting the claim that "whenever the dedication rule applies, it trumps the doctrine of equivalents." The problem with this argument is that, by getting a broadening reissue patent within two years of issuance, the patentee does not trump the dedication rule because the dedication rule would not have applied. The *Johnson & Johnston* dedication rule applies only in litigation, after the *Markman* hearing, when the claims' scope becomes clear. After all, there is no way to know for sure what subject matter is disclosed but unclaimed until the court determines what *is* claimed. Under *Johnson & Johnston's* rule, in any particular case where the patentee attempts, post-*Markman*, to assert the doctrine of equivalents to cover disclosed but unclaimed subject matter, the dedication rule trumps the doctrine of equivalents.

140. See *id.* at 1051-54.

141. In the Federal Circuit, an en banc court such as *Johnson & Johnston* may overrule its own precedent. See FED. CIR. R. 35(a)(2).

142. See *Agostini v. Felton*, 521 U.S. 203, 237-38 (1997).

143. See *Johnson & Johnston*, 285 F.3d at 1051-52.

144. See *id.* at 1051.

145. See *id.* at 1052.

146. See *id.* at 1052-53.

acknowledged that neither case was on point, but it set the stage for its doctrine-of-equivalents-trumping dedication rule by borrowing some of their language.¹⁴⁷ The court recalled that “claim[s] actually made operate[] in law as a disclaimer of what is not claimed.”¹⁴⁸

After discussing the early dedication cases, the *Johnson & Johnston* court distinguished both *Graver Tank* and *Warner-Jenkinson*.¹⁴⁹ In distinguishing *Graver Tank*, the court emphasized that an earlier Court had invalidated the patentee’s claim covering the disclosed manganese welding flux.¹⁵⁰ Apparently, the Court believed that this distinction gave it license to decide the case with no influence from *Graver Tank*.

In distinguishing *Warner-Jenkinson*, the *Johnson & Johnston* opinion did not even mention the accused infringer’s rejected argument that equivalents should be limited to only disclosed but unclaimed subject matter.¹⁵¹ The court cursorily declared that “*Warner-Jenkinson* did not present an instance of the patentee dedicating subject matter to the public in its specification.”¹⁵²

B. JOHNSON & JOHNSTON’S DEDICATION OF ALL THAT IS DISCLOSED BUT NOT CLAIMED

After discussing Supreme Court precedent, the *Johnson & Johnston* court followed *Maxwell* and announced its bright-line dedication rule: “[W]hen a patent drafter discloses but declines to claim subject matter . . . this action dedicates that unclaimed subject matter to the public.”¹⁵³ Allowing such patentees to assert the doctrine of equivalents, according to the court, would “conflict with the primacy of the claims in defining the scope of

147. *See id.* at 1053.

148. *Id.* (quoting *Mahn v. Harwood*, 112 U.S. 354, 361 (1884)).

149. *See id.* at 1053-54.

150. *See id.* at 1053 & n.1. Judge Dyk, in his concurring opinion, offered another distinction between *Graver Tank* and *Johnson & Johnston*. *See id.* at 1059-61 (Dyk, J., concurring). He argued that the *Graver Tank* disclosure was significantly less clear than the *Johnson & Johnston* disclosure. *Id.* at 1061. Thus, Judge Dyk implied that the *Johnson & Johnston* rule is limited to situations in which the subject matter is *clearly* disclosed but not claimed. *See id.*

151. *See id.* at 1054 (discussing *Warner-Jenkinson*, but failing to mention its reference to disclosed but unclaimed equivalents).

152. *Id.*

153. *Id.*

the patentee's exclusive right."¹⁵⁴ The court gave two primary justifications for its bright-line rule.¹⁵⁵ First, the bright-line rule would discourage applicants from trying to sneak broad claims past the USPTO—disclosing broadly, claiming narrowly, and relying on the doctrine of equivalents.¹⁵⁶ Second, a patentee who disclosed but did not claim was not without remedy because he could still get a broadening reissue patent, or a continuation patent.¹⁵⁷

III. A REBUTTABLE PRESUMPTION OF DEDICATION: A BETTER APPROACH THAN *JOHNSON & JOHNSTON'S* DEDICATION RULE

The Federal Circuit's per curiam opinion in *Johnson & Johnston* upsets the balance between the patent system's protection and notice functions. The *Johnson & Johnston* dedication rule purports to bolster the notice function by drawing a bright line, eliminating any zone of uncertainty.¹⁵⁸ In some cases, however, the line is not nearly so bright as the *Johnson & Johnston* court would like to believe.¹⁵⁹ The nature of language makes it impossible to eliminate all uncertainty from the scope of patent claims.¹⁶⁰ *Johnson & Johnston's* bright-line dedication rule limits patentees' access to the doctrine of equivalents in a way never contemplated by the Supreme Court, either before or after *Johnson & Johnston*.¹⁶¹

154. *Id.* (citing *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997)).

155. Judge Rader's concurring opinion also offered an alternative to the majority's bright-line rule. His rule would preclude patentees from asserting the doctrine of equivalents to "capture subject matter that the patent drafter reasonably could have foreseen during the application process and included in the claims." *Id.* at 1056 (Rader, J., concurring).

156. *See id.* at 1054-55.

157. *Id.* at 1055.

158. *See supra* notes 153-57 and accompanying text (discussing *Johnson & Johnston's* bright-line dedication rule); *supra* note 17 and accompanying text (discussing the zone of uncertainty).

159. *See infra* Part III.C.

160. *See supra* note 82 and accompanying text.

161. *See supra* notes 63-71 and accompanying text (explaining that the *Graver Tank* Court allowed patentees to assert the doctrine of equivalents despite the fact that an earlier Court had invalidated claims that would literally cover the accused device); *supra* notes 76-79 and accompanying text (noting that the *Warner-Jenkinson* Court's prosecution history estoppel analysis involves inquiry into the particular facts surrounding the amendment to determine whether it is patentability-related); *supra* notes 82-84 (discussing how the *Festo* rebuttable presumption of prosecution history estoppel only

As such, future courts faced with disclosed but unclaimed equivalents should reject the bright-line dedication rule in favor of a rule more in tune with the Supreme Court's protection/notice balance: a *Festo*-like rebuttable presumption of dedication.

A. THE *JOHNSON & JOHNSTON* RULE MISTREATS SUPREME COURT PRECEDENT

The *Johnson & Johnston* court missed its opportunity to resolve two conflicting lines of holdings: *Edward Miller* and *Mahn* for the dedication line,¹⁶² and *Graver Tank* and *Warner-Jenkinson* for the doctrine of equivalents line.¹⁶³ Instead, its bright-line rule, dedicating all disclosed but unclaimed subject matter, makes the doctrine of equivalents subservient to the dedication rule whenever they clash. The *Johnson & Johnston* court should have recognized that in *Edward Miller* and *Mahn*, the Supreme Court used language much broader than necessary to decide the case at bar. The *Johnson & Johnston* court should also have realized that both *Graver Tank* and *Warner-Jenkinson* suggested that patentees should be able to assert the doctrine of equivalents to cover disclosed but unclaimed subject matter in some circumstances. Clearly, some remnant of the *Edward Miller* and *Mahn* dedication rule still remains after *Johnson & Johnston*,¹⁶⁴ but its scope is not nearly as broad.

The *Johnson & Johnston* court should have shaped its rule in conformity with *Graver Tank* and *Warner-Jenkinson* and allowed patentees to cover disclosed but unclaimed equivalents with the doctrine of equivalents under some circumstances.¹⁶⁵ Only five years ago, *Warner-Jenkinson* properly struck the balance between the notice function and the protection function in the doctrine of equivalents context.¹⁶⁶ By fixing the outer boundary of what subject matter is available to patentees as

prevents patentees who clearly disclaim certain subject matter from asserting the doctrine of equivalents to cover it).

162. See *supra* Part I.B.2.

163. See *supra* Part I.B.1.

164. See *Rodriguez de Quijas v. Shearson/Am. Express, Inc.*, 490 U.S. 477, 484 (1989) (noting the general principle that, absent a Supreme Court reversal, lower courts cannot ignore Supreme Court precedent).

165. See *id.*

166. See *supra* Part I.B.1.b.

potential equivalents at the outermost concentric circle,¹⁶⁷ the Court implied that patentees should be able to cover at least disclosed but unclaimed subject matter.¹⁶⁸ To the extent that people relied on *Maxwell's* bright-line dedication rule, this *Warner-Jenkinson* implication should have diminished such reliance. The *YBM Magnex* decision recognized this diminished reliance by limiting *Maxwell* to its facts.¹⁶⁹ The *Johnson & Johnston* court should have at least attempted to resolve *Warner-Jenkinson's* disclosed but unclaimed equivalents reference.¹⁷⁰

The *Johnson & Johnston* court, rather than basing its decision on rationale gleaned from *Graver Tank*, sought to distinguish it.¹⁷¹ *Graver Tank* emphasized the importance of providing patentees fair protection and allowed patentees to cover the manganese flux even though it was disclosed but not within the alkaline earth metal claim.¹⁷² The *Johnson & Johnston* court noted that *Graver Tank's* facts were different in that a court, and not the patentee, caused the accused subject matter to be unclaimed.¹⁷³ Instead, the court should have noted that in both cases, the accused subject matter was disclosed but not within the claim-in-suit.¹⁷⁴ *Graver Tank* is not exactly on point, but that does not give the *Johnson & Johnston* court license to completely ignore it.¹⁷⁵ The last thing the *Johnson & Johnston* court should have done was create an anomaly where a patentee faces no barrier when he wishes to assert the doctrine of equivalents to cover disclosed subject matter *that is not within the scope of the claim-in-suit*,¹⁷⁶ but

167. See *supra* Part I.B.3.a.

168. See *supra* Part I.B.3.a.

169. See *supra* note 126 and accompanying text (quoting the *YBM Magnex* court, which, relying on *Warner-Jenkinson*, stated, "*Maxwell* accords with the [Supreme] Court's precedent only when its decision is understood and applied in light of its particular facts").

170. See *supra* note 152 and accompanying text.

171. See *supra* notes 149-50 and accompanying text.

172. See *supra* Part I.B.1.a (detailing *Graver Tank's* holding).

173. See *supra* note 150 and accompanying text.

174. See *supra* note 150 and accompanying text.

175. See *Nichol v. Pullman Standard, Inc.*, 889 F.2d 115, 120 n.8 (7th Cir. 1989) (noting that lower federal courts should follow Supreme Court dicta); *United States v. LaBinia*, 614 F.2d 1207, 1210 (9th Cir. 1980) (noting that Supreme Court principles control unless expressly limited to the particular facts of the case); *United States v. Bell*, 524 F.2d 202, 206 (2d Cir. 1975) (noting that Supreme Court dicta should not be disregarded).

176. See *supra* Part I.B.1.a (noting that the *Graver Tank* patentee was able

faces an insurmountable barrier when he wishes to assert the doctrine of equivalents to cover disclosed subject matter *that was never claimed*.¹⁷⁷

The *Johnson & Johnston* court placed too much emphasis on two cases decided more than a century ago in entirely different contexts.¹⁷⁸ In those cases, the Supreme Court invalidated the patentees' broadening reissue patents.¹⁷⁹ In so doing, the Court prevented patentees from asserting property rights, under a pretense of inadvertence, after they had knowingly allowed a market to develop for the disclosed but unclaimed subject matter.¹⁸⁰ No doubt, such situations lie at the heart of what *Johnson & Johnston's* rule was trying to prevent. When given the opportunity, however, to reiterate *Edward Miller's* broad dedication rule in less notice function-diminishing situations, like those in *Graver Tank* and *Warner-Jenkinson*, the Supreme Court declined to do so.¹⁸¹ That the Court has never overruled *Edward Miller* or its progeny, and has overwhelmingly affirmed the doctrine of equivalents at each opportunity suggests that both must interrelate with each other in some way. Supreme Court precedent mandates, contrary to the *Johnson & Johnston* rule, that patentees should be able to assert the doctrine of equivalents to cover disclosed but unclaimed equivalents in at least some circumstances.

B. *FESTO* CONFIRMS *JOHNSON & JOHNSTON'S* BALANCE FAILURE

The Supreme Court's reversal in *Festo* of the Federal Circuit's bright-line prosecution history estoppel rule as improperly upsetting the protection/notice balance¹⁸² shows that *Johnson & Johnston's* similar rule upsets the same

to assert the doctrine of equivalents to cover his disclosed manganese flux that was not within his asserted claim).

177. See *supra* notes 153-54 and accompanying text (announcing the *Johnson & Johnston* dedication rule). For an explanation of why a patentee could not get past the *Johnson & Johnston* rule's barrier by getting a broadening reissue patent within two years of issuance, see *supra* note 128.

178. See *supra* notes 146-48 and accompanying text.

179. *Supra* note 96 and accompanying text (explaining *Edward Miller's* context); *supra* note 100 and accompanying text (explaining *Mahn's* context).

180. See *supra* Part I.B.2.a-b.

181. See *supra* Part I.B.3.a (discussing how references from both *Graver Tank* and *Warner-Jenkinson* contradict the broad dedication rule announced in *Edward Miller* and *Mahn*).

182. See *supra* Part I.B.1.c.

balance. *Festo's* rebuttable presumption of prosecution history estoppel recognizes the notice function importance of holding patentees accountable for behavior perceived to indicate disclaimer of the subject matter.¹⁸³ *Festo* also recognizes that the mere act of amendment is not conclusive evidence of such behavior.¹⁸⁴ *Johnson & Johnston* recognizes the former but not the latter.¹⁸⁵ *Johnson & Johnston's* rule views the mere fact that the patentee disclosed subject matter that falls outside his claims' literal scope as conclusive evidence of disclaimer.¹⁸⁶ As such, the rule upsets the Supreme Court's protection/notice balance, struck most recently in *Festo*.

C. THE JOHNSON & JOHNSTON RULE UNFAIRLY ELIMINATES PATENT PROTECTION WHEN CLAIM CONSTRUCTION LEAVES DISCLOSED SUBJECT MATTER UNCLAIMED

The gravest injustice resulting from *Johnson & Johnston's* dedication rule is that it unfairly holds patentees accountable for striking the perfect balance between disclosing enough to satisfy the written description and enablement requirements,¹⁸⁷ and not disclosing so much that the disclosure exceeds the claim's scope.¹⁸⁸ This is a tall order because patentees cannot be sure of their claims' scope until long after they must comply with the enablement and written description requirements.¹⁸⁹ Patentees can only claim their inventions as clearly as words will allow them.¹⁹⁰ Parties often hotly contest claim construction at *Markman* hearings,¹⁹¹ signifying that

183. See *supra* notes 85-86 and accompanying text (describing *Festo's* rebuttable presumption of prosecution history estoppel).

184. See *supra* notes 85-86 and accompanying text.

185. See *supra* note 153 and accompanying text (stating unconditionally that a patentee's act of disclosing subject matter but not claiming it dedicates such subject matter to the public).

186. See *supra* note 151 and accompanying text.

187. See *supra* notes 27-29 and accompanying text.

188. See *supra* notes 153-54 and accompanying text.

189. See *supra* notes 38-42 and accompanying text.

190. See *supra* notes 82-83 and accompanying text.

191. See, e.g., *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) ("We engage in claim construction every day, and cases frequently present close questions of claim construction on which expert witnesses, trial courts, and even the judges of this court may disagree."); *N. Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1580 (Fed. Cir. 1993) (Rader, J., dissenting) (noting that the *Markman* hearing was "very close"); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991) (contesting the meaning of the claim term "right angle corner border pieces").

determining the exact meaning of claim terms is by no means cut and dry. Therefore, it stands to reason that a patentee could attempt to claim all disclosed equivalents, fight for such a claim construction, and end up with disclosed but unclaimed equivalents as a result of an adverse *Markman* ruling.¹⁹² Denying such a hard-luck patentee access to the doctrine of equivalents, as mandated by *Johnson & Johnston's* bright-line dedication rule, would be unfair.

Barring hard-luck patentees who attempted to strike the balance but inadvertently disclosed more than they claimed from asserting the doctrine of equivalents runs contrary to the purpose of the original dedication rule: to hold patentees to their categorical disclaimer of the disclosed but unclaimed subject matter.¹⁹³ Such patentees are, instead, the victims of the natural limitations of the written word.¹⁹⁴ In these situations, the disclosed subject matter is neither clearly the patentee's property, nor clearly public property, until after the *Markman* hearing.¹⁹⁵ Therefore, treating such patentees the same as patentees who disclose subject matter and expressly disclaim it would be unfair.

Allowing patentees who attempt to claim all disclosed subject matter, but end up on the wrong side of a *Markman* ruling, to assert the doctrine of equivalents would not

192. Continuing with the pharmaceutical company example, *see supra* Part I.B.1, suppose it disclosed "between 1.5 and 2.5 grams of Chemical X" in its patent specification, and claimed "roughly 2.0 grams of Chemical X." Suppose then, that the pharmaceutical company sued a competitor for making a drug containing 1.5 grams of Chemical X. Both parties could intensely dispute the claim construction. The pharmaceutical company could argue that "roughly 2.0" means "between 1.5 and 2.5," and its competitor could argue that it means "between 1.6 and 2.4." If the court agreed with the pharmaceutical company's competitor, 1.5 grams of Chemical X would be left disclosed but outside the literal scope of the pharmaceutical company's claim. The *Johnson & Johnston* rule would prevent the pharmaceutical company from asserting the doctrine of equivalents against its competitor, regardless of how insubstantially different 1.5 grams is from 1.6 grams. Thus the competitor could sidestep the time and development costs, copy everything exactly, and make an insubstantial change to avoid infringement. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950). This is precisely the type of situation that the doctrine of equivalents was designed to prevent. *See id.* at 608.

193. *See supra* note 97 and accompanying text.

194. *See supra* note 82 and accompanying text (noting that "the nature of language makes it impossible to capture the essence of a thing in a patent application").

195. *See supra* note 192 and accompanying text (defining a hard-luck patentee).

encourage applicants to attempt to sneak broad claims past the USPTO.¹⁹⁶ If a court finds that a patentee disclosed broadly and claimed narrowly to avoid USPTO scrutiny, it should hold that the patentee does not rebut the presumption of dedication as a matter of law.¹⁹⁷ A hard-luck patentee would have shown the USPTO all his cards during prosecution.¹⁹⁸ The patentee and the examiner agreed on a set of claims that they believed accurately captured the invention.¹⁹⁹ Only the limitations of words resulted in disclosed but unclaimed subject matter.²⁰⁰

The hard-luck patentee would find no comfort in either of *Johnson & Johnston's* proposed alternative remedies.²⁰¹ Both broadening reissue patents and continuation patents are for patentees and applicants who are dissatisfied with their claims' scope.²⁰² The hard-luck patentee would be happy with his claim's scope until after a *Markman* hearing.²⁰³ No hard-luck patentee would seek either a broadening reissue patent or a continuation patent because he would believe that his claims were as broad as his specification would support.²⁰⁴

A perfect example of a hard-luck patentee is the patentee in *Unique Concepts*.²⁰⁵ As described above,²⁰⁶ the *Unique Concepts* majority construed "right angle corner border pieces" to mean preformed frame corners, thus leaving mitered frame corners disclosed but not claimed.²⁰⁷ The patentee, however, argued, and convinced dissenting Judge Rich, that "right angle corner border pieces" defined a class of which preformed frame corners and mitered frame corners were members.²⁰⁸ Therefore, because the *Unique Concepts* patentee was unable to

196. See *supra* note 192 and accompanying text.

197. See *supra* notes 104, 123, 156 and accompanying text (describing the situation in which patentees attempt to sneak broad claims past the USPTO, a situation that is unquestionably at the heart of the dedication rule).

198. See *supra* note 192 and accompanying text (noting that a hard-luck patentee attempted to claim all disclosed subject matter).

199. See *supra* note 192 and accompanying text.

200. See *supra* note 82 and accompanying text (quoting *Festo* as stating that "the nature of language makes it impossible to capture the essence of a thing in a patent application").

201. See *supra* note 157 and accompanying text.

202. See *supra* notes 34-35 and accompanying text.

203. See *supra* note 192 and accompanying text.

204. See *supra* note 192 and accompanying text.

205. 939 F.2d 1558 (Fed. Cir. 1991).

206. See *supra* notes 103-04 and accompanying text.

207. See *supra* notes 104-05 and accompanying text.

208. *Unique Concepts*, 939 F.2d at 1567-68 (Rich, J., dissenting).

convince just one more judge of his claim construction, his mitered frame corners were left disclosed but unclaimed.²⁰⁹ Under *Johnson & Johnston's* bright-line dedication rule, the *Unique Concepts* patentee would not be able to argue that the mitered frame corners were equivalent to the preformed frame corners.²¹⁰ The disclosure, coupled with the failure to explicitly claim, would dedicate the mitered frame corners to the public.²¹¹

D. A REBUTTABLE PRESUMPTION OF DEDICATION ACCORDS WITH *WARNER-JENKINSON* AND *FESTO*

Future courts faced with a patentee who has disclosed more than he has claimed should reject the *Johnson & Johnston* rule in favor of a rebuttable presumption of dedication. A rebuttable presumption of dedication would fall somewhere between a rule that would determine dedication based on all the facts and circumstances and the *Johnson & Johnston* bright-line dedication rule. An all-facts-and-circumstances rule would result in too much harm to the notice function because, too often, it would place disclosed but unclaimed subject matter within the zone of uncertainty, thus preventing competitors from designing around the patent.²¹² *Johnson & Johnston's* bright-line dedication rule results in too much harm to the protection function because, too often, it strips hard-luck patentees of valuable protection, thus diluting the incentive to innovate.²¹³

A rebuttable presumption of dedication would serve the notice function better than an all-facts-and-circumstances rule because competitors would know that, absent exceptional circumstances, a patentee dedicates disclosed but unclaimed subject matter to the public.²¹⁴ Moreover, as soon as a patentee

209. *Id.* at 1562-63.

210. *See supra* note 154 and accompanying text. The *Unique Concepts* court actually applied the doctrine of equivalents, but found the mitered frame corners not equivalent to the preformed frame corners. *Supra* note 105 and accompanying text (citing *Unique Concepts*, 939 F.2d at 1563-64).

211. *See supra* note 153 and accompanying text (stating *Johnson & Johnston's* bright-line dedication rule).

212. *See supra* notes 16-18 and accompanying text (discussing the importance of minimizing uncertainty in the scope of a patent's property rights).

213. *See supra* notes 11-15 and accompanying text (emphasizing the need for fair patent protection to provide incentives to innovate).

214. *See infra* Part III.D.1 (describing the exceptional circumstances under

acts to negate hard luck,²¹⁵ competitors can be certain that such subject matter is public property. A rebuttable presumption of dedication would serve the protection function better than *Johnson & Johnston's* bright-line dedication rule because it would not deem disclosed but unclaimed subject matter dedicated unless the patentee acted affirmatively to disclaim it.²¹⁶

Faced with similar protection/notice problems, the Supreme Court's two most recent doctrine of equivalents cases struck the proper balance by adopting a rebuttable presumption.²¹⁷ Both *Warner-Jenkinson* and *Festo* first endorsed a flexible application of the doctrine of equivalents, and then announced a rebuttable presumption.²¹⁸ Both cases recognized the importance of holding patentees to their proclamations of what subject matter is not their property.²¹⁹ Competitors would be much less likely to design around claimed inventions if patentees were later able to assert property rights in such subject matter.²²⁰ *Festo's* rule, however, also recognized the detrimental protection function effect that would result if patentees' actions taken many years earlier served as conclusive evidence of such a proclamation.²²¹ Forcing patent applicants to predict the future in order to fairly protect their inventions would surely stifle innovation because applicants would be weary of undertaking a financial risk without the promise of enforceable exclusive rights.²²² Similarly, a presumption of dedication, rebuttable only by demonstrating a consistent pattern of behavior indicating that

which the patentee can assert the doctrine of equivalents to cover disclosed but unclaimed subject matter).

215. See *infra* Part III.D.1 (describing two types of acts that negate a patentee's hard luck).

216. See *infra* Part III.D.1 (listing the two ways a patentee can affirmatively disclaim subject matter).

217. See *supra* notes 75, 78-79 and accompanying text (describing the holding in *Warner-Jenkinson*); *supra* notes 82-86 and accompanying text (describing the holding in *Festo*).

218. See *supra* notes 75, 78-79, 82-86 and accompanying text.

219. See *supra* notes 77-79 and accompanying text.

220. See *supra* notes 16-18 and accompanying text (describing the importance of clear notice to competitors who wish to design around patents).

221. See *supra* notes 82-84 and accompanying text (noting the unfairness of holding a patentee to clear claims when the claims cannot be made clearly).

222. See *supra* note 11 and accompanying text (explaining how the promise of exclusive rights is often the only economic justification for investing in innovation).

the patentee attempted in good faith to claim the disclosed subject matter most fairly balances the notice and protection functions.

1. A Patentee Can Rebut the Presumption of Dedication by Demonstrating Hard Luck

To show hard luck, patentees must demonstrate at least two things. First, the patentee must have consistently made reasonable arguments for a claim construction that would literally cover the accused subject matter.²²³ Even an inconsistent claim construction argument in a previous case will negate a finding of hard luck.²²⁴ If the patentee argues for a claim construction that would leave subject matter disclosed but unclaimed, or if his claim language prevents him from making a reasonable argument that the subject matter is literally claimed, he proclaims to the world that such subject matter is not his property.²²⁵ Holding otherwise, and allowing him to assert the doctrine of equivalents, would result in too much harm to the notice function. Second, a patentee must not have attempted to cover the disclosed but unclaimed (as a result of an adverse *Markman* ruling) subject matter with either a broadening reissue patent or a continuation patent.²²⁶ Only patentees who are dissatisfied with their claims' scope would resort to such measures.²²⁷ The hard-luck patentee would have believed that his claims satisfactorily covered everything he disclosed.²²⁸ He would believe that his disclosure would not support broader claims and would forego corrective measures.²²⁹ Therefore, a patentee who attempts to cover subject matter with a separate broadening reissue patent or a continuation patent proclaims to the world that his first patent

223. See *supra* notes 38-42 and accompanying text (noting that the patentee advocates for his interpretation of the claim terms at a *Markman* hearing).

224. See Rachel Marie Clark, Note, *Collateral Estoppel of Claim Interpretation After Markman*, 86 MINN. L. REV. 1581, 1613-14 (2002) (discussing collateral estoppel in the claim interpretation context).

225. See *supra* note 101 and accompanying text.

226. See *supra* notes 201-04 and accompanying text; *supra* note 157 and accompanying text (noting the two alternative remedies to patentees who recognize that they did not claim all that they disclosed).

227. See *supra* notes 34-35 and accompanying text.

228. See *supra* note 193 and accompanying text.

229. See *supra* note 204 and accompanying text.

does not secure property rights in such subject matter.²³⁰

2. A Rebuttable Presumption of Dedication is Consistent with *Graver Tank*

A rebuttable presumption of dedication is consistent with the rebuttable presumption trend started in *Warner-Jenkinson*, and followed in *Festo*, and is likewise consistent with *Graver Tank*. In *Graver Tank*, the patentee did not argue for a claim construction that would literally have encompassed the accused flux.²³¹ One might argue, then, that the *Graver Tank* patentee was not a hard-luck patentee, and thus could not have rebutted the presumption of dedication.²³² If this were true, the *Graver Tank* patentee would not have had access to the doctrine of equivalents, a result that would clearly conflict with *Graver Tank*'s actual holding.²³³ The problem with this analysis is that the rebuttable presumption of dedication would never have applied to the *Graver Tank* patentee. Under this Comment's proposed rule, only patentees who disclosed but failed to claim are presumed to have dedicated.²³⁴ Such an act is a disclaimer of the disclosed but unclaimed subject matter.²³⁵ The *Graver Tank* patentee, on the other hand, did not fail to claim, and therefore did not impliedly disclaim, the disclosed subject matter.²³⁶ The rebuttable presumption of dedication is consistent with *Graver Tank* because the *Graver Tank* patentee did not disclose, but failed to claim, the accused flux.²³⁷

230. See *supra* note 101 and accompanying text (noting that disclosing but failing to claim property is a signal that the unclaimed property does not belong to the patentee).

231. The *Graver Tank* patentee could not have done so because claims that literally would have covered the manganese flux were invalidated in earlier litigation. See *supra* note 66 and accompanying text.

232. See *supra* text accompanying note 223 (stating that a "patentee must have consistently [argued] for a claim construction that would literally cover the accused subject matter" to prove hard-luck).

233. See *supra* note 71 and accompanying text (noting that the *Graver Tank* Court found the accused infringer liable to the patentee under the doctrine of equivalents).

234. See *supra* Part III.D (proposing a rebuttable presumption of dedication).

235. See *supra* note 101 and accompanying text (noting that conclusive evidence of disclaimer is a proclamation to the world that subject matter is not the patentee's property).

236. See *supra* note 66 and accompanying text (explaining that the *Graver Tank* patentee had claimed the accused manganese flux, but that claims to it were invalidated in earlier litigation).

237. See *supra* note 66 and accompanying text.

3. The *Johnson & Johnston* Patentee Would Not Have Been Able to Rebut the Presumption of Dedication

Applying the rebuttable presumption of dedication to the facts of *Johnson & Johnston*, it is clear that the *Johnson & Johnston* patentee would not have been able to demonstrate hard luck.²³⁸ The *Johnson & Johnston* patentee did not argue that its claim to an aluminum substrate literally covered the disclosed steel substrate.²³⁹ One might argue that if the *Johnson & Johnston* patentee had known its case would be decided under the rebuttable presumption of dedication, it would have made the literal infringement argument simply to preserve its right to plead hard luck and cover the steel substrate under the doctrine of equivalents. Such a tactic, however, would not suffice to show hard luck. To show hard luck, a patentee must have ended up on the wrong end of a *Markman* ruling, despite having made a *reasonable* argument that his claim literally covered the disclosed subject matter embodied in the accused product or process.²⁴⁰ Arguing that a claim to an aluminum substrate literally covers the accused steel substrate is not reasonable. Thus, the *Johnson & Johnston* patentee would not be able to demonstrate hard luck and thereby rebut the presumption of dedication.²⁴¹ The *Johnson & Johnston* patentee would not be able to assert the doctrine of equivalents to cover the accused steel substrate because it would be deemed to have dedicated the steel substrate to the public.

The *Johnson & Johnston* patentee would also be unable to rebut the presumption of dedication because it sought to protect the disclosed steel substrate with two continuation patents.²⁴² The *Johnson & Johnston* patentee was clearly

238. See *supra* notes 133-35 and accompanying text (detailing *Johnson & Johnston*'s relevant facts).

239. *Johnson & Johnston Assocs. v. R.E. Servs. Co.*, No. C 97-4382 CRB, 1998 U.S. Dist. LEXIS 13142, at *6-7 (N.D. Cal. Aug. 24, 1998) (stating that "[a]ll parties . . . agree that, at a minimum, 'aluminum' means 'commercial grade aluminum'").

240. See *supra* notes 223-25 and accompanying text.

241. See *supra* notes 223-25 and accompanying text (noting that inconsistent claim construction arguments negate hard luck).

242. See *supra* note 133 (noting that the *Johnson & Johnston* patentee had filed for and received two continuation patents to the steel substrate); *supra* notes 226-30 and accompanying text (explaining that attempts to cover disclosed but unclaimed subject matter with a continuation patent or broadening reissue patent negates hard luck).

dissatisfied with its claim's scope, and thought its disclosure would support a broader scope. A hard-luck patentee would have believed that his claim's scope was as broad as his disclosure would support.²⁴³ Therefore, the *Johnson & Johnston* patentee, by attempting to cover the disclosed steel substrate with the two continuation patents, proclaimed to the world that its original patent did not cover the steel substrate. The rebuttable presumption of dedication would prevent the *Johnson & Johnston* patentee from asserting the doctrine of equivalents to cover the steel substrate.

Future courts should allow patentees who make a reasonable attempt to literally claim all disclosed subject matter, but find themselves on the wrong end of a *Markman* ruling, to assert the doctrine of equivalents to cover disclosed but unclaimed subject matter.²⁴⁴ Courts should deem all other patentees who disclose but fail to claim subject matter to have dedicated such subject matter to the public.²⁴⁵ Allowing hard-luck patentees to assert the doctrine of equivalents does not mean that patentees can necessarily prevent their competitors from practicing all of its disclosed but unclaimed subject matter. It only allows courts to ask the question, "Is the disclosed, accused device equivalent to the device recited in the claims?"²⁴⁶ Such a flexible application of the doctrine of equivalents is consistent with the Supreme Court trend most recently followed in *Festo*.²⁴⁷ A rebuttable presumption of dedication, also consistent with the Supreme Court trend of applying rebuttable presumptions in doctrine of equivalents cases, assures that courts protect only hard-luck patentees.²⁴⁸ In all other cases, the notice function carries the day.

243. See *supra* notes 228-29 and accompanying text.

244. See *supra* Part III.D (proposing a rebuttable presumption of dedication).

245. See *supra* Part III.D; *supra* Part I.B.2 (noting the important notice function policy concerns furthered by dedication).

246. See *supra* Part I.B.1 (explaining that the doctrine of equivalents works to extend the scope of patentees' rights to exclude accused products that are equivalent to the claimed invention).

247. See *supra* note 75 and accompanying text (describing the *Warner-Jenkinson* Court's flexible application); *supra* note 80 and accompanying text (describing the *Festo* court's flexible application).

248. See *supra* notes 78-79 and accompanying text (outlining *Warner-Jenkinson's* rebuttable presumption standard); *supra* notes 85-86 and accompanying text (outlining *Festo's* rebuttable presumption standard).

CONCLUSION

In *Johnson & Johnston*, the Federal Circuit impermissibly restricted the doctrine of equivalents's viability by preventing patentees from asserting the doctrine to cover disclosed but unclaimed equivalents. The court's bright-line dedication rule was improper when handed down, and a similar application by any future court would be even more improper in light of *Festo*. When faced with a situation in which a patentee has disclosed subject matter but not claimed it, courts should apply a rebuttable presumption of dedication. Such a rule would restore the balance between the protection function and the notice function struck by the Supreme Court, and thereby best promote the progress of science and the useful arts.