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claims 1 and 19 of the '718 cannot be infringed under the doctrine

a person having ordinary skill in the art

arguments must be coordinated so that a consistent interpretation

disclaimed exit angles less than 30 degrees in the claims

statements made during foreign prosecution can be used as evidence

the specific base-solvent combinations were not obvious and therefore patentable

in 2007, applications for U.S. patents rose 4.9 percent



The Effect of Statements

Made During Prosecution of Foreign Counterpart Patent Applications on United States Patent Claim Scope



PATENT PROSECUTION BY THE NUMBERS

The need for independent inventors, small businesses, and large corporations to strategically protect their intellectual property rights in today’s knowledge-based economy has led to record levels of patent application filings in the U.S. and abroad. In 2007, according to the United States Patent and Trademark Office (“USPTO”), applications for U.S. patents rose 4.9 percent to 467,243,¹ and the World Intellectual Property Organization reported a record 156,100 patent applications filed under the Patent Cooperation Treaty.² In China, the growth and volume of patent applications in 2007 were unprecedented. China’s State Intellectual Property Office reported a 21.1 percent increase in patent applications (more than four times the increase in the U.S.), for a staggering total of 694,153 applications.³ As more and more manufacturing operations head overseas, and with China’s increased willingness to enforce patent rights, the number of non-U.S.-filed applications will only continue to rise.

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These numbers reflect patent protection that is increasingly global in scope. As a result, more and more patent applications in the United States (and around the world) have non-U.S. counterparts. This creates challenges for practitioners with clients seeking patent protection in the United States and abroad. One such challenge for practitioners in prosecuting a client's patent portfolio is managing the growing volume of U.S. and non-U.S. prosecution history. Non-U.S. prosecution history must be managed effectively (and consistently), since it may be used in determining the scope of U.S. patent claims.

THE USE OF U.S. PATENT PROSECUTION HISTORY

U.S. patent practitioners are all too familiar with the concept of prosecution history estoppel or patent disclaimer, which occurs when a patentee, either through argument or amendment, surrenders claim scope during the course of prosecution. See *Heuft Systemtechnik GmbH v. Indus. Dynamics Co.*, 2008 U.S. App. LEXIS 13486, 12–16 (Fed. Cir. June 25, 2008). The recent *Heuft* decision underscored the importance and effect of prosecution history estoppel when the Federal Circuit held that the plaintiff, Heuft, disclaimed exit angles less than 30 degrees for bottle-arranging claims in a divisional application, based on statements and amendments made during prosecution of the parent application.

In *Heuft*, the invention was directed to an apparatus for handling and inspecting bottles for defects. A key feature of such systems is the stability of the bottle arrangement during inspection. The Federal Circuit stated that during prosecution of the parent application, “Heuft not only repeatedly distinguished its claims over” a partic-

ular reference, but it “also amended all of those claims to require an exit angle between 30° to 100°.” *Id.* Consequently, the Federal Circuit stated that it had “little difficulty concluding that Heuft clearly and unmistakably disclaimed exit angles less than 30°.” *Id.* Because the arguments and amendments Heuft made during prosecution of the parent application related to the same subject matter at issue in the divisional application, the Federal Circuit held that “prosecution disclaimer [arose] from [the] disavowals made during the prosecution of ancestor patent applications” and therefore Heuft disclaimed exit angles less than 30 degrees in the claims of the divisional application as well. *Id.* As a result of Heuft's disclaimer in the parent application, the Federal Circuit held that the defendant's products that included exit angles of either 12 or 14 degrees did not infringe Heuft's patent that issued on the basis of the divisional application.

As a result of prosecution history estoppel and its potential to limit claim scope, experienced U.S. patent practitioners carefully prosecute applications before the USPTO and refrain from making unnecessary statements and amendments that may be used to limit the scope of a patent. As the filing of international applications continues to increase, U.S. practitioners must be equally cognizant of what occurs during non-U.S. prosecution, as non-U.S. prosecution history may be used to limit the scope of U.S. patent claims as well.

POTENTIAL EFFECT OF FOREIGN PROSECUTION HISTORY

Foreign patent prosecution must be managed with the same care as the U.S. prosecution because foreign prosecution history may

application, the Federal Circuit held that the defendant's products that included exit divisional application.

be used when interpreting the scope of corresponding U.S. patent claims. See *Caterpillar Tractor Co. v. Berco*, 714 F.2d 1110 (Fed. Cir. 1983). For example, in *Caterpillar*, the district court held that Berco's type II seal infringed claims 1, 10, and 19 of U.S. Patent No. 3,841,718 ("the '718 patent"), directed to a method for sealing lubricated tracks on crawler-type tractors. Berco appealed the district court's decision to the Federal Circuit and argued, among other things, that Caterpillar's instructions to its foreign counsel and representations made by Caterpillar's foreign counsel to the German patent office indicated that Berco's type II seal was not contemplated by Caterpillar and therefore claims 1 and 19 of the '718 could not be infringed under the doctrine of equivalents. In addition, regarding claim 10, Berco argued that Caterpillar's instructions and representations added a limitation to the claim. On these points, the Federal Circuit stated that when instructions to foreign counsel or representations to foreign patent offices made by an applicant during prosecution of a corresponding foreign application provide "relevant evidence" with respect to claim interpretation, such information "must be considered." *Id.* at 1116 (emphasis added). However, even though the Federal Circuit considered Caterpillar's instructions and the representations that it made during prosecution of its German application, the Federal Circuit held that nothing in the instructions or representations served as a basis for denying application of the doctrine of equivalents to claims 1 and 19, nor did it read a limitation into claim 10. Consequently, the Federal Circuit affirmed the district court's decision.

The Federal Circuit has also used statements made during foreign prosecution as evidence of

whether one skilled in the art would consider use of an alternative element to be interchangeable with the patentee's claimed element. See *Tanabe Seiyaku Co. v. U.S. Intern. Trade Com'n*, 109 F.3d 726 (Fed. Cir. 1997). In *Tanabe*, the Federal Circuit held that the International Trade Commission ("ITC") was correct in using statements made by Tanabe to the European, Finnish, and Israeli patent offices in evaluating whether or not a person of ordinary skill in the art would have considered two solvents from the same chemical family to be interchangeable. *Id.* *Tanabe*, which owned a U.S. patent for a chemical reaction used in the production of a pharmaceutical compound, brought suit for infringement against a competitor. Tanabe alleged that by substituting the solvent butanone for acetone in its patented process, the competitor had infringed Tanabe's patent under the doctrine of equivalents. *Id.* In determining whether or not Tanabe's patent was infringed under the doctrine of equivalents, the ITC examined Tanabe's claims in light of statements made to the foreign patent offices during prosecution of the Tanabe counterpart applications.

During prosecution of the foreign counterpart applications, Tanabe had successfully argued that "the specific base-solvent combinations" of its process were not obvious and were therefore patentable. *Id.* The ITC and the Federal Circuit agreed that because these statements "suggest to a person skilled in the art that other solvents, including butanone, may not be interchangeable with the claimed solvents," they weakened Tanabe's argument that butanone and acetone were equivalents in its patented process. *Id.* at 733. Accordingly, these foreign statements,

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coupled with experimental test results, led the ITC to conclude, and the Federal Circuit to affirm, that there was no infringement of Tanabe's process under the doctrine of equivalents. *Id.* at 734.

The Federal Circuit continues to use statements made to foreign patent offices to determine how a person of ordinary skill in the art may construe U.S. patent claims. See *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367 (Fed. Cir. 2005). In *Gillette*, the Federal Circuit determined that Gillette's claims for a razor "comprising" three blades were infringed by Energizer's Quattro,[®] a four-bladed razor. Energizer unsuccessfully argued that Gillette's "comprising" language was meant to exclude razors with more than three blades and that a person having ordinary skill in the art would not understand the claim to encompass a razor with four blades. The Federal Circuit disagreed, finding that "comprising" was an open-ended term that could include razors with more than three blades. *Id.* at 1374.

In rejecting Energizer's argument, the Federal Circuit relied on Energizer's own statements made to the European Patent Office during prosecution of a virtually identical claim in Gillette's European counterpart application. The Federal Circuit stated, "[Energizer] itself endorsed an open interpretation of 'comprising' . . . before the European Patent Office," and it further stated that this "blatant admission [by Energizer] clearly supports this court's holding that those skilled in the art would construe the claims of the . . . patent to encompass razors with more than three blades." *Id.* at 1374.

Caterpillar, *Tanabe*, and *Gillette* illustrate that statements or representations made during prosecution of foreign counterpart applications may be used to determine the claim scope of related U.S. patents. Such statements may be as valuable as statements made by an applicant during prosecution of a U.S. application in determining whether an applicant surrendered claim scope during the course of prosecution. Accordingly, statements and representations made during foreign prosecution must be made carefully and consistently because they may be used to limit the scope of a U.S. patent's claims, as in *Tanabe*, or to under-

mine defenses in infringement actions, as was the case in *Gillette*. As foreign applications increase, the number of statements made during foreign prosecution and the need for consistency will only continue to increase.

WHAT DOES THIS MEAN FOR CLIENTS AND PRACTITIONERS?

Based on *Caterpillar*, *Tanabe*, and *Gillette* and the increase in patent application filings worldwide, foreign patent prosecution must be managed carefully to avoid an unintentional loss in U.S. patent claim scope and hence a decrease in patent value. While national patent laws differ around the world, resulting in the necessity for practitioners to use different arguments to obtain related patents, these arguments must be coordinated so that a consistent interpretation of the claims is ensured. Inconsistency in claim interpretation may provide the foundation for alternative (potentially less valuable) claim interpretation and may provide evidence of the understanding of a person having ordinary skill in the art.

Foreign prosecution history may also be valuable to clients seeking to avoid litigation or in designing around existing patented solutions. Because foreign prosecution history may be used to shed light on the scope of a U.S. patent claim, clients may find that based on comments made during foreign patent prosecution, a U.S. patent claim may be narrower than it first appears. Practitioners may be able to aid clients in reducing litigation risk and design-around costs by investigating foreign prosecution history as part of accurately determining the scope of the U.S. patent claim at issue. Accordingly, it may be advantageous for a client and practitioner to:

- Determine at the outset who will manage or control prosecution of the international portfolio for related applications—preferably, this will be a single practitioner who will be able to ensure that all arguments and representations made during prosecution of the related patents are consistent; and
- Notify foreign associates of the possible detrimental effect that inconsistent arguments or representations made during prosecution of foreign counterpart applications can have on U.S. claim scope.

CONCLUSION

The increasingly global scope of patent protection requires clients and U.S. patent practitioners to be more aware of and more involved in what transpires during prosecution of foreign applications that have U.S. counterparts. Failure to do so may result in an unintentional and unnecessary surrender of patent scope. Companies must be cognizant of the potential risks of inconsistent prosecutions and should ensure that their patent counsel take the necessary steps to obtain the broadest patent protection possible. ▶▶

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ENDNOTES

¹United States Patent and Trademark Office, Patent Applications Filed 2007 (preliminary data), http://www.uspto.gov/web/offices/com/annual/2007/50302__table2.html; all web sites last visited November 18, 2008.

²Unprecedented Number of International Patent Filings in 2007, Press Release, World Intellectual Property Organization, February 21, 2008. Available at http://www.wipo.int/pressroom/en/articles/2008/article__0006.html.

³State Intellectual Property Office, Applications for Three Kinds of Patents Received from Home and Abroad, 2007, http://www.sipo.gov.cn/sipo_English/statistics/gnwsznb/2007/200801/t20080116__230750.htm.