Avoiding Prosecution Estoppel and Saving Money

Thomas G. Field, Jr.

Prosecution history estoppel arises in different ways. For example, the seemingly neglected case, U.S. v. Adams, 383 U.S. 39, 52 (1966), confirms that unexpected results may be used to overcome evidence of obviousness. Yet, when the patentee argued for an unexpected result in the companion case, Graham v. John Deere, 383 U.S. 1, the Court refused to consider it. The reason, as noted at 23, is that "Graham did not urge before the Patent Office the greater 'flexing' qualities… which he so heavily relied on in the courts." The opinion, at 25, also approves the trial court's refusal to permit testimony along those lines.

In *Graham,* it appears, 383 U.S. at 26, that applicant was unfamiliar with an important Glencoe patent. Thus he had no incentive to flag unexpected results or to otherwise distinguish it in his specification. This seems basic. Yet, as an examiner, I refused to consider several Rule 132 affidavits because specifications were silent concerning the advantage supposedly demonstrated.

Proposed amendments to specifications referring to previously undisclosed advantages over (previously unknown) art would likewise be refused as introducing new matter. Moreover, refiling under § 120 might accomplish nothing given that the recitation of previously undisclosed advantages over the prior art would be denied the benefit of the earlier filing date.

A second form of estoppel limits patentees' literal scope of protection as well as protection under the doctrine of equivalents. Either way, subject matter surrendered to evade prior art during prosecution cannot infringe.

As most readers will know, application of prosecution estoppel in the context of the doctrine of equivalents was recently explored in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722 (2002). At 737, the opinion rejects a Federal Circuit attempt to estop patentees regardless of their attorneys' reasons

for narrowing claims. Acknowledging the difficulty of assessing whether claims were limited for some reason other than to evade prior art, the Court, at 740, nevertheless approved only a strong presumption that apparent reductions in scope had a different objective — putting a concomitantly heavy burden on patentees to so demonstrate.

The second form of estoppel is equally applicable to so-called literal claim interpretation. As with any document, including rules and statutes, the so-called plain meaning of language is sometimes difficult to discern. In such circumstances, it is often most clearly revealed when successive drafts are considered.

Yet, what if initial claims are written narrowly, perhaps to avoid any risk that further limitations will be needed? Claims, of course, do not literally cover unclaimed territory, leaving only the possibility that it might be captured under the doctrine of equivalents. That seems not to have been considered by the Supreme Court., but it was addressed in Maxwell v. J. Baker, Inc., 86 F.3d 1098 (Fed. Cir. 1996). At 1107–08, it states: “A patentee may not narrowly claim his invention and then, in the course of an infringement suit, argue that the doctrine of equivalents should permit a finding of infringement because the specification discloses the equivalents.”

Such a conclusion, the opinion goes on to explain, is compelled by §112, which requires applicants to particularly point out and distinctly claim their inventions. It seems also to be compelled by the fact that the PTO examines only claims that appear, not ones (interferences aside) that might have been submitted.

Although § 102(e), for example, dictates unavoidable uncertainty in especially active arts, risks of over- or underclaiming are reduced, if not eliminated, when attorneys have full command of available art. I’m therefore surprised that current and former students commonly report that they are expected to prepare applications without benefit of a novelty search.

Reflecting on my intense, if brief, experience examining in an exceedingly close

art (polyolefin blends in the mid 60s), I am also surprised that interviews after the first office action were rare. I would have welcomed interviews at that time, but interviews were generally uncommon.

After scheduling an interview, some attorneys wasted their time as well as mine because they lacked any sense of examiners' roles. Aside from that, however, interviews often revealed that attorneys and I had been talking past one another. In such circumstances, regardless of when the interview occurred, we often agreed on a way to make the case allowable. At a minimum, we better focused our positions for possible appeal.

As noted above, easy first-action allowances pose risks, but when prosecution goes beyond that, early interviews have great potential for reducing the potential for prosecution-based estoppel. Failing to understand an examiner's position increases the chances of making unnecessarily narrowing amendments. The sooner attorneys understand examiners' positions, the better. The earlier such understanding is achieved, the more time will be available to craft amendments that forfeit the least territory. More time will also serve a host of other useful ends, including, for example, providing the opportunity for better assessment of the potential for overcoming rejections with affidavits and, if they seem worthwhile, to get them into the record.

Attorneys, particularly those farming out work, should also consider the extent to which timely knowledge of prior art and examiners' positions is apt to save money. Ever larger filing and legal fees make it increasingly penny-wise, absent time bars, to file without novelty searches. Examiners search, but what is the additional cost to the client of learning what could have been learned much earlier? When territory worth having seems to be available, many clients want it all. If so, initial rejections are likely, and the more quickly that attorneys know precisely what is bothering examiners, the less patents will cost.

[I appreciate the comments of Thomas G. Field III, Intellectual Property Counsel, Saint-Gobain, concerning an earlier draft.]