



Question Q229

National Group: United States

Title: The use of prosecution history in post-grant patent proceedings

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Questions

- 1) What types of post-grant proceedings are available in your jurisdiction? Are post-grant proceedings available both at a patent office and at a court?**

There are several types of post-grant proceedings available in the United States, including patent infringement litigation in the U.S. federal courts, which resolves issues of both alleged patent infringement and patent validity, as well as additional issues that may be presented. In addition to litigation in the courts, post-grant proceedings are also available in the United States Patent and Trademark Office (PTO), including “reexamination,” which may be *ex parte* (at original request of patent owner or third party), *inter partes* (only at third

party request) or reissue under 35 U.S.C. § 251 (which may only be requested by the patent owner).

Under the AIA, certain changes in post-grant PTO proceedings will result. *Inter partes* reexamination will be replaced by *inter partes* review on September 16, 2012, and several additional post-grant procedures will be available, including “post-grant review.” Post-grant review will apply to applications filed on or after March 16, 2013, which are subject to the new first-inventor-to-file laws. Reexamination proceedings under current practice are limited to issues of patentability based on prior art in the form of patents or printed publications only. The post-grant review procedure to be implemented March 16, 2013 will allow for consideration of patentability issues under any ground including those arising under 35 U.S.C. §101 and 112.

Other post grant procedures that will be available under the AIA include Supplemental Examination, which may only be requested by the patent owner, and the Transitional Program for Covered Business Method Patent, which can be requested by a party charged with infringement of a patent. Both of these procedures go into effect on September 16, 2012.

2) In your country or region, may the prosecution history be taken into account for purposes of interpreting claim scope during post-grant proceedings?

Yes, the prosecution history is considered one of the principal tools in interpreting the meaning of terms used in issued claims together with the wording of the claims themselves and the specification, which provides a context for the construction of the terms. These elements are considered parts of the “intrinsic record” used in the interpretation of the claims in patent infringement proceedings in the federal courts involving claims for alleged infringement of the granted patent. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) (“Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent . . . Nonetheless, the prosecution

history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor had limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.”).

Traditionally in the PTO, where the claim interpretation standard is “the broadest reasonable interpretation consistent with the specification,” in reissue or reexamination proceedings there is no required analysis of a patent’s owner’s statement/argument. As of September 16, 2012, however, the AIA allows the patent owner’s statement regarding claim scope made, among other places during prosecution to be used “to determine the proper meaning of a patent claim” in an ex parte reexamination, inter partes review or post grant review, once initiated. Such statements are not used in the determination to initiate one of these proceedings nor in reissue applications.

If the answer to question 2 is yes, please answer the following questions:

- a) Please explain the types of prosecution history that may be considered. For example:**
- i. Does applicable prosecution history include amendments, arguments, or both?**

The applicable prosecution history would include both amendments to the wording of the claim terms themselves, as well as any arguments regarding terms without amendment that was presented during prosecution in attempts to distinguish prior art references as applied by the examiner, for example. See, e.g., *Pods, Inc. v. Porta Stor, Inc.*, 484 F.3d 1359, 1366-67 (Fed. Cir. 2007); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995) (“The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.”).

ii. Could applicable prosecution history include a limiting interpretation that is *implied* through the applicant’s arguments, or would it include only *explicit* definitional statements?

As a general proposition, statements made on behalf of the applicant during prosecution in the PTO may affect the potential scope of the claims in one of two principal fashions: *either* as a so-called “disclaimer” of potential meaning and/or scope affecting the potential, literal breadth of the claim *or* as a limitation on the potential meaning and/or scope of the claims under the doctrine of equivalents.

Explicit, definitional statements made in the course of prosecution would definitely impact the literal scope of the claims. In addition, limiting interpretations of a claim term may also result from the presentation of arguments distinguishing prior art structures as disclosed in various references. For example, the effect of an argument that a particular reference does not disclose a claimed feature of the invention may prove to be quite definitive to literal claim meaning. *See, e.g., Southwall Technologies v. Cardinal*, 54 F.3d at 1576-77 (limiting claims to direct deposit of metal oxide as distinguished from two-step processes in light of arguments distinguishing a prior art reference).

As for the effect of arguments presented during prosecution on the range of equivalents, what is referred to as “prosecution history estoppel”, a number of authorities have held that any alleged “surrender” based on arguments presented during prosecution (as distinguished from direct claim amendments) must be “clear and unequivocal.” *Pods, Inc. v. Porta Stor*, 484 F.3d at 1367. Where multiple arguments are made in an effort to distinguish the prior art, each of these arguments may separately give rise to an estoppel against the potential range of equivalents. *Id.* at 1368 (“Since PODS offered each argument as a separate basis for distinguishing Dousset, its rectangular frame argument

created a separate estoppel.”); see also *Southwall Technologies*, 54 F.3d at 1582-83.

iii. Does applicable prosecution history include only amendments to the claims, or does it also include amendments to any aspect of the disclosure?

As a general proposition, amendments to the patent specification are not permitted under U.S. practice if they serve to expand the original disclosure of the application in any material fashion (i.e., add “new matter”). See, e.g., 37 C.F.R. 1.53(b) (“ . . . No new matter may be introduced into an application after its filing date.”). As a result, the effect of relevant prosecution history on potential claim scope is most commonly derived from direct claim amendments or related arguments in distinguishing prior art. Amendments to the disclosure at the request of the examiner, or an objection by the examiner to attempts to modify the disclosure to add certain subject matter, for example, could also potentially affect the resulting interpretation of the claims or limit the scope of equivalents since it would be part of the prosecution history. See *Cross medical Products v. Medtronic*, 480 F.3d 1335, 1340-42 (Fed. Cir. 2007).

iv. Does it matter if the amendments and/or arguments are made to overcome prior art versus being made to address sufficiency or some other formal requirement?

In general, it would not matter whether the amendment or related arguments were made in relation to prior art or in response to a rejection based on another statutory ground, such as adequate support in the specification for the proposed limitation under 35 U.S.C. § 112. This is particularly true in relation to the potential application of the doctrine of equivalents, since any narrowing amendment or argument related to patentability, regardless of the statutory ground, has the effect of limiting the potential range of equivalents under

controlling authorities. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002). (“It does not follow, however, that amendments for other purposes will not give rise to estoppel . . . We agree with the Court of Appeals that a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.”).

v. Does it matter if the prosecution history has the effect of broadening the interpretation of the claim, versus narrowing it?

As a fundamental matter, the claims are interpreted as they would be understood by a person of ordinary skill in the relevant art (starting with their ordinary and customary meaning). *Phillips v. AWH Corp.*, 415 F.3d at 1312-13. To the extent a term used in a claim is intended to have any different meaning (apart from or even contrary to its generally accepted meaning), such a different or conflicting meaning must be clear from the specification of the patent, also as a general proposition under U.S. practice. *Phillips*, 415 F.3d at 1315 (“ . . . For that reason, ‘claims must be read in view of the specification, of which they are a part.’ . . . As we stated in *Vitronics*, the specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’”); see also *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000) (“While we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning, the written description in such a case must clearly redefine a claim term ‘so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to redefine that claim term.’ [citation omitted] Absent an express intent to impart a novel meaning, claim terms take on their ordinary meaning.”).

Note, however, that except for a broadening reissue filed within two years of patent issuance (see 35 USC § 251 *et. seq.*) no currently existing post grant procedure, or procedure newly available under the AIA, may result in any claim broadening in any fashion. One would have to constrain the effects of any prosecution history statements in those proceedings, in view of that restriction, if valid claims were assumed to be the result.

If the proper starting point for claim construction is the ordinary meaning of the term, in light of the specification, prosecution history will generally have the effect of narrowing the potential scope of the claim relative to that ordinary meaning interpretation. It is conceivable, however, that since the prosecution history is considered part of the intrinsic record utilized in construing the claims, certain events that may occur during prosecution, such as statements or actions of the examiner, might shed further light on the proper meaning of the term as used in the claim relative to an alternative construction.

b) Does the applicability of prosecution history depend on when the prosecution history occurred? For example, does it matter if a particular statement by an applicant was made during initial examination as opposed to during a later invalidity proceeding?

The prosecution history applicable to the interpretation of terms used in the claims of a patent most commonly comprises the file of the proceedings related to its prosecution in the United States Patent and Trademark Office, both during the original prosecution or during any subsequent reexamination or reissue proceedings (or post-grant AIA proceedings). Under certain circumstances, statements made by a patentee during formal proceedings in the courts might also be taken into account, as a practical matter, in construing the scope of the claims. Under the AIA, a new procedure will permit third parties to submit a “claim scope statement” to the PTO consisting of statements made by the patent owner concerning claim scope in a

proceeding before a federal court or the PTO itself. See 35 U.S.C. § 301(a)2. Note that Section 301(d) specifically disallows consideration of patent owner statements “for any purpose other than to determine the proper meaning of a patent claim” in an IPR, PGR or ex parte reexam proceeding that has been ordered.

With respect to timing, statements made during the prosecution of one application may also affect the construction of the same or similar terms as used in a separate, but related application. This effect may extend to patents that were actually granted *before* the relevant prosecution history event occurred in relation to the affected claim term. See, e.g., *Andersen Corp. v. Fiber Composites LLC*, 474 F.3d 1361, 1368 (Fed. Cir. 2007); see also *Verizon Services Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306-07 (Fed. Cir. 2007) (Applying statements from the prosecution of a later application to an earlier granted patent: “Verizon nonetheless argues that the disclaimer in the ’291 application process (leading to the ’497 patent) should not apply to the ’880 patent because it occurred after the ’880 patent issued. We reject this argument.”).

c) Does the applicability of prosecution history depend on the type of post grant proceeding, or on the authority before which the proceeding is held? For example, would prosecution history be more applicable in an infringement action at court than in a post-grant patent office invalidity proceeding?

The consideration of prosecution history in interpreting the claims is applicable in the context of an infringement action in the federal courts; however, a different standard is applied to the interpretation of claims while the application is pending in the U.S. Patent Office in post-grant proceedings.

Claims pending in a patent application or reexamination in the PTO are given their “broadest reasonable interpretation” consistent with the specification. In litigation, after the application is granted as a patent, the claims will be interpreted

consistent with the *Phillips* principles outlined above, including consideration of statements made during the relevant prosecution proceedings in the PTO.

But the uses/applicability of the prosecution history is not generally governed by the nature of the proceeding in a litigation, whether the statement was made in the PTO, a US court system or, even in some situations, the EPO. See *eg.*, *Tanabe v. USITC*, 109 F3d 726 (Fed Cir 1997). In the PTO, patent owner statements are not used for claim interpretation for reissue application or for determining whether to initiate an *ex parte/inter partes* reexamination, and will not be used to determine whether to initiate AIA *inter partes* review or post grant review. They will only be used in *ex parte* reexaminations, *inter partes* reviews and post grant reviews, once initiated, after September 16, 2012.

d) Is the applicability of prosecution history limited to infringement proceedings where equivalents are an issue?

No. As noted previously, prosecution history (including related arguments) are used both in interpreting the claims for purposes of literal infringement as well as in separately evaluating the potential scope of equivalents for infringement under the doctrine of equivalents. See *Southwall Technologies*, 54 F.3d at 1578 (“Claim interpretation in view of the prosecution history is a preliminary step in determining literal infringement, while prosecution history estoppel applies as a limitation on the range of equivalents if, after the claims had been properly interpreted, no literal infringement has been found.”).

e) Could prosecution history from a corresponding foreign application be considered in a post-grant proceeding in your jurisdiction? If so, under what circumstances?

As a general proposition, only the prosecution history in the United States is considered part of the formal or “intrinsic record” utilized in construing the meaning of

the claims. On the other hand, it is possible that developments arising during prosecution of a corresponding application in another country may be used for various purposes, such as to prove knowledge of facts bearing on defenses to claims of infringement, or as evidence related to potential technical equivalents. See, eg., *Tanabe vs. USITC*, 109 F.3d 726 (Fed. Cir. 1997) *But see AIA Eng'g Ltd. v. Magotteaux Int'l. S/A*, 657 F.3d 1264, 1279 (Fed. Cir. 2011) (“[O]ur precedent cautions against indiscriminate reliance on the prosecution of corresponding foreign applications in the claim analysis”).

f) Is the use of prosecution history authorized by statute or by case law in your jurisdiction?

The use of prosecution history is authorized by case law in the United States, for litigation and by 35 USC §301 for PTO review proceedings: *ex parte* reexamination *inter partes* review and post grant review.

g) Explain the policy reasons for considering prosecution history during the claim interpretation process.

The general policy reasons for considering prosecution history as part of claim interpretation is that the file of the proceedings is available to the public and forms part of the record on which the public may rely in considering the scope of the claims for purposes of avoiding infringement of the granted patent. *Desper Prods, Inc. v. QSound Labs., Inc.*, 157 F.3d 1325, 1337 (Fed. Cir. 1998) (Public has right to rely on applicant's remarks in seeking allowance of their claims.); see also *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1221 (Fed. Cir. 1996) (“Just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under Section 112.”)

If the answer to question 2 is no, please answer the following questions:

- h) Is the disallowance of use of prosecution history mandated by statute or by case law in your jurisdiction?**

Not applicable.

- i) Explain the policy reasons for not considering prosecution history during the claim interpretation process.**

Not applicable.

- 3) Assuming that at least some countries will consider foreign prosecution history as part of claim interpretation in their jurisdictions, does this have implications for how you would handle prosecution of a patent application in your country? Is this problematic?**

As reflected in the preceding discussion, the prosecution history already has a very significant effect on the potential scope of the claims resulting in the United States patent. As a result, significant care must already be exercised in prosecution of the application. However, if the same prosecution could potentially have an impact outside the United States, then even greater care would have to be exercised under those circumstances.

- 4) In your country or region, may a patent be invalidated in post-grant proceedings on the basis of the same prior art which was taken into account by the examiner of the patent office during prosecution of the patent? If so, may the patent be invalidated on the basis of the same prior art and the same argument used by the examiner or may the same prior art only be used if it is shown that there is a new question based on some other teaching or aspect of that prior art?**

Yes, yes. Although issued U.S. patents are entitled to a statutory presumption of validity under 35 U.S.C. § 282 in subsequent litigation in the federal courts (which presumption can only be overcome by “clear and convincing evidence”), courts are not prevented from determining that the patent is invalid based on the same or substantially the same prior art that was considered by the examiner (particularly since a trial will involve the testimony of witnesses, including expert witnesses, for example, that were not available to the examiner). There are several case authorities, however, stating that the statutory

presumption of validity is more difficult to overcome when the only art relied upon was also considered by the examiner in the Patent Office during prosecution. See *American Hoist & Derrick Co. v. Sowa & Sons*, 725 F.2d 1350, 1358-60 (Fed. Cir. 1984); see also *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1467 (Fed. Cir. 1990). So, as a practical matter, most defenses to a federal court action will be based on additional prior art or evidence that was not considered by the PTO. See, eg., *Microsoft v. i4i*, ___ US ___, 131 S.Ct. 2238 (2011).

In the case of post-grant proceedings before the PTO itself, it is also possible for reexamination to be ordered based on prior art that was also of record or considered by the examiner during the original prosecution, both in the case of *ex parte* reexamination under 35 U.S.C. § 302 or under *inter partes* reexamination under 35 U.S.C. § 311, provided that the party requesting reexamination demonstrates a “substantial new question of patentability” (*ex parte* reexamination) or that a reasonable likelihood that petitioner will prevail with respect to at least one of the challenged claims exists (*inter partes* reexamination/AIA *inter partes* review) in relation to that art usually, this is done by presenting arguments that place the teachings of the art in a “new light” relative to the proceedings before the examiner, which might involve examination of a portion of the prior art reference not previously mentioned in prosecution or a new understanding of a previously examined passage or a new combination of references.. See 35 U.S.C. §§ 303(a) and 312(a).

Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the use of prosecution history in post-grant proceedings. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws:

1) Is harmonization of the applicability of prosecution history in post-grant proceedings desirable?

Yes.

2) Is it possible to find a standard for the use of prosecution history that would be universally acceptable?

Yes, it would seem that a harmonized standard could be developed for possible application throughout the world.

3) Please propose a standard you would consider to be broadly acceptable for a) the types of prosecution history that should be considered, if any; and b) the type of proceeding and circumstances in which it should be considered.

Prosecution history should be considered as part of claim interpretation and should include consideration of both claim amendments and arguments that are presented on behalf of the Applicant to the examining authority during prosecution in the relevant patent office. Since the Examiner in a respective patent office may be influenced by these arguments in considering the potential grant of the claims in the first instance, it seems only fair that the public should be able to use these arguments to influence their construction in any subsequent matter involving their potential enforcement, or related proceedings. It is also seems fair to consider arguments made in one patent office in connection with the enforcement of a patent in another country, under certain circumstances, provided that the factual arguments made in one country are made in a context that is relevant to the same or similar issue in another country, such as technical equivalence or whether certain claim limitations encompass specific structures that may have been distinguished during prosecution as outside the scope of the "invention." The latter issue should be considered carefully, however, as material differences in the legal standards related to patentability in different countries, or material differences in the claims themselves, may make the use of prosecution history in another country inappropriate or unfair.