

Prosecution History Disclaimer: Beware of What You Clearly and Unambiguously Say

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Patent prosecutors typically are cautious when making arguments that distinguish their client's invention from the prior art. This caution was traditionally based on the concern that later, when the client enforced its patent rights against a potential infringer, these arguments may provide the basis for restricting the range of equivalents available to the patentee under the doctrine of prosecution history estoppel. Prosecution history estoppel normally limits the range of equivalent elements that are available to satisfy a claim element under a doctrine of equivalents analysis (*ie*, when there is no literal infringement of that claim element). Recent decisions by the Federal Circuit not only reaffirm the significance of statements made during prosecution; they also extend their impact to a literal infringement analysis. A patentee who during prosecution "clearly and unequivocally" disavows the prior art (or even defines the invention) may affect the literal scope of the claims. This doctrine is now regularly referred to as prosecution history disclaimer.

Under this doctrine, a claim term may receive a "gloss" that limits the claim to a particular feature that is not

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expressly stated in the claim, and the result can play out at the level of a literal infringement analysis. Thus, an accused infringer should closely examine prosecution history statements, not only as a source of arguments to limit the patentee's range of equivalents, but also as a source of potentially determinative evidence for a favorable claim construction to avoid literal infringement. Similarly, patent prosecutors should carefully phrase the arguments made during prosecution so as to avoid unnecessarily emphasizing arguments or distinctions in order to obtain allowance of claims, thereby limiting the opportunity of a future alleged infringer to successfully invoke the doctrine of prosecution history disclaimer.

THE FEDERAL CIRCUIT'S EARLY HISTORY OF 'DISCLAIMER'

For years, the Federal Circuit has relied on "disclaiming" statements made in the prosecution history to construe claims, even though the phrase "prosecution history disclaimer" was not used. For example, in *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448 (Fed. Cir. 1985), the claim term "copper ion," in the context of a process for hydrolizing a nitrite that required the "presence of copper ion," was construed to not include metallic copper catalysts, even though there was no such express limitation in the claim. *Id.* at 452-53. This construction was based on a statement in the specification that the use of metallic copper alone was not effective, as well as a statement in

response to a Patent Office rejection in which the patentee argued that a prior art reference that disclosed the use of metallic copper did not teach the "copper ion" feature in the claim. In particular, the patentee stated that metallic copper was "outside [the] claims." *Id.* at 453. The Federal Circuit took note of these positions by the patentee and stated "[b]y making this disclaimer or concession, [the patentee] surrendered any interpretation of its claim that would include metallic copper catalysts." *Id.*

Ten years later, the Federal Circuit continued to apply this disclaimer doctrine in *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570 (Fed. Cir. 1995). In this case, the court construed "sputter-deposited dielectric" used in an improved heat mirror to require formation of the dielectric by a one-step reactive sputtering process, even though such a one-step process was not expressly stated in the claim term at issue. *Id.* at 1576-77. During prosecution, the patentee stated that its sputter-deposited dielectric "can be laid down directly" by a reactive sputtering process and then "directly connected to the oxide." The Federal Circuit treated this prosecution history as a clear and unambiguous statement disclaiming a two-step process of depositing a metal and then oxidizing the metal. *Id.*

By the mid-1990s, the Federal Circuit was clearly recognizing the doctrine of prosecution history disclaimer as a claim limiting principle, noting that "[p]rosecution history serves as a limit on the scope of claims

by excluding any interpretation of the claim language that would permit the patentee to assert a meaning for the claim that was disclaimed or disavowed during the prosecution in order to obtain claim allowance.” See *Zenith Labs, Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418 (Fed. Cir. 1994) (finding no disclaimer); *Southwall*, 54 F.3d 1570; *York Prods., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568 (Fed. Cir. 1996) (finding no disclaimer).

RECENT FEDERAL CIRCUIT DECISIONS ON DISCLAIMER

The prosecution disclaimer doctrine has been refined and more frequently invoked in the last couple of years, with the Federal Circuit developing a standard for evaluating the nature of potentially disclaiming statements. For example, statements that can be characterized as clear, deliberate, unequivocal, and/or unmistakable can give rise to a disclaimer, whereas vague or ambiguous statements generally cannot. In *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314 (Fed. Cir. 2003), the court set forth a standard for applying the prosecution disclaimer doctrine and the policy basis for the standard. The court explained that the disclaimer doctrine attaches when a patentee makes a statement of “unequivocal[] disavow[all],” and where the statements are “clear and unmistakable.” *Id.* at 1324-26. The court found that this standard struck the balance between the public notice function of prosecution history and the right of patentees to pursue broad patent coverage. *Id.* at 1325.

The technology in *Omega* concerned a laser sighting system for use on infrared thermometers. The patentee argued in prosecution, on several occasions, that the claimed method for outlining an energy zone (which recited the claim term “to visibly outline”) distinguished the prior art because it did not add appreciable heat to the energy zone so as to affect the accuracy of the temperature measurement. *Id.* at 1327. The Federal Circuit noted that the patentee’s repeated statements of what its invention “could not be” (*ie*, precluding

appreciable heat from entering the energy zone and affecting the temperature of the zone), resulted in a “deliberate surrender of claim scope, unmistakable in its effect because it is not suitable to multiple interpretations.” *Id.* Accordingly, the court limited the claim term “to visibly outline” to a function that did not add heat in the manner distinguished by the patentee during the prosecution history. *Id.* at 1328.

Another recent decision applying prosecution history disclaimer is *Microsoft Corp. v. Multi-Tech*, 357 F.3d 1340 (Fed. Cir. 2004). In *Microsoft*, the technology at issue was personal computer-based systems for simultaneously transmitting voice and data to a remote site over a telephone line. The Federal Circuit relied on prosecution history disclaimer to limit the claim terms “sending,” “transmitting,” and “receiving” data packets to the direct transmission of data packets over a telephone line, even though no such limitation was expressly stated in the asserted claims. *Id.* at 1350-51. The court noted Multi-Tech’s repeated and consistent description of its invention in the specification as communicating directly over a telephone line, including about two dozen references in the specification to data transmission “over” or “through” a telephone line. *Id.* at 1347-48. The Federal Circuit also noted Multi-Tech’s response to an office action in which it argued that a “standard telephone line” established the point-to-point connection between telephone equipment on each end of the line used in the invention. *Id.* at 1349. The Federal Circuit found that Multi-Tech’s specification statements and prosecution history statements describing its invention in the context of telephone line transmission “unambiguously” demonstrated Multi-Tech’s understanding of its inventions as limited to the transmission of data packets directly over a telephone line. *Id.*

The prosecution disclaimer doctrine was not applied, however, by the Federal Circuit in a recent 2004 case in which the disclaimer argument was raised. In *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327 (Fed. Cir. 2004), the claim term at issue was “horizontal drive means for

rotating said lamp” used in a claim for a wireless, remote-controlled portable searchlight. Defendant Wal-Mart argued that the claims at issue were limited to lamps capable of 360° rotation, even though there was no such express limitation in the claim. *Id.* at 1332.

Wal-Mart based its contention on a statement in the specification of the patent application that described the ability of the lamp to have 360° rotation, as well as several statements made during prosecution. For example, in response to a Patent Office rejection, the patentee argued: 1) that a prior art reference was distinguished because it “would not be rotatable so as to be able to sweep through 360° or greater as achieved by applicants’ invention”; 2) that the claims at issue in the Patent Office rejection were amended to recite rotation through at least 360° to avoid prior art; and 3) that the claims recited “separate horizontal and vertical drive means for tilting and rotating as well through 360°” to carry out two different types of adjustments, tilting and rotation. *Id.* at 1333.

The Federal Circuit noted that there were dependent claims that expressly recited the 360° limitation argued during prosecution, but the 360° limitation was not expressly recited in the asserted independent claim. As a result, the court did not apply the disclaimer doctrine to either the specification statement or the prosecution history statements because the statements did not rise to the level of “clear disavowal.” *Id.*

CONCLUSION

The doctrine of prosecution history disclaimer can be used to characterize statements in the prosecution history as “clear and unambiguous” or “unmistakable” which, if accepted, can limit the meaning of claim terms in a literal infringement analysis, even if the limited meaning is not expressly provided in the claims. Patent prosecutors and litigators must consider this doctrine in creating and evaluating prosecution histories.