

Words Make the World-go-'round: Prosecution History Estoppel Scene from Afar

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“Most wonderful of all are words, and how they make friends one with another, being oft associated, until not even obituary notices them do part.”
William Sydney Porter ("O. Henry") [1862-1910]

I. INTRODUCTION

In the wonderful world of patent law, the words "prosecution history estoppel" often go hand-in-hand with "doctrine of equivalents", inasmuch as the existence of the former serves to limit the range that is available for the latter. This paper will review the interplay of these doctrines from two vantage points.

First, the paper will analyze the potential negative impact of statements made during the prosecution of foreign counterpart patent applications upon the range of equivalents available for the corresponding U.S. patent's claims. Second, the paper will consider how the doctrines are being applied outside of the United States. Third, the paper will consider prosecution practice tips to insure consistency of U.S. and foreign file wrappers.

II. IMPACT OF STATEMENTS MADE DURING FOREIGN PROSECUTION

Statements made during foreign patent prosecution can ultimately have a negative impact upon the range of equivalents that is available under the doctrine of

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equivalents. The Federal Circuit has held that statements made during foreign patent prosecution can be used to determine whether there are “insubstantial” differences between the process in the patent being asserted and the alleged infringer’s process.²

In the *Tanabe* case³, the Federal Circuit considered the question of whether claims directed to a method of producing diltiazem hydrochloride using one of five specific base/solvent combinations including acetone. The alleged infringer’s process employed butanone rather than acetone. The issue was whether the substitution of butanone for acetone amounted to an insubstantial difference.

During the proceedings below, the International Trade Commission (“ITC”) considered statements on behalf of Tanabe before the Finnish, Israeli, and European patent offices. Before each patent office, the Tanabe representative argued patentability of their claimed invention on the basis of unexpected results provided by the specific base/solvent combinations claimed, as compared to other less-efficacious combinations. As proof of the unexpected results, Tanabe submitted a “Comparative Test Report” showing that the process employing acetone was more efficacious than one employing butanone. After considering this information, the ITC concluded that the showing of unexpected results was inconsistent with Tanabe’s later-asserted position that differences between the accused and patented processes were insubstantial.

In affirming the ITC’s ruling, the Federal Circuit alluded to the patentee’s statements regarding unexpected results before the foreign patent offices as a basis for

² See *Tanabe Seiyaku Co., Ltd v. United States Int’l Trade Comm’n*, 109 F.3d 726 (Fed. Cir. 1997)

³ *Id.*

concluding that one of ordinary skill in the art would not consider the use of butanone to be insubstantially different from the use of the patentee's claimed acetone.

Clearly patent practitioners must be mindful of the possible adverse impact upon U.S. patent enforcement opportunities that may result from statements, affidavits, and amendments filed in foreign patent offices that run counter to the patent holder's broad vision for the U.S. claims. For the sake of completeness, therefore, pre-litigation review should include a perusal of all foreign counterpart file wrappers to uncover limiting verbiage in the foreign file histories before the U.S. suit is brought.

Does the patent practitioner need to be concerned about file wrapper estoppel issues and doctrine of equivalents in foreign enforcement actions as well? In view of one recent case from outside of the U.S., the answer is at least "probably".

III. EQUIVALENTS IN FOREIGN COUNTRIES

In some foreign countries, doctrine of equivalents issues are cropping up – but with some non-"insubstantial" differences. Illustratively, in Canada, the Ontario Superior Court of Justice recently ruled on a motion to dismiss the defendant's counterclaim alleging patent infringement.⁴ The asserted patents related to "hot-melt" compounds used to coat automobile parts for inhibiting rusting of the auto parts. The Court considered the issue of whether the patents' claims relating to the use of magnesium complexes as the active ingredients would encompass products in which calcium and barium were substituted for magnesium.

⁴ *Dana Canada v. Lubrizol*, O.S.C.J., Dec, 27, 2001 (LaForme J.)

The Court in the *Dana* case⁵ relied upon a recent decision of the Supreme Court of Canada⁶ to consider the question of whether a skilled worker on the date of publication of the patent would have concluded that barium and calcium would perform substantially the same function in substantially the same way to reach substantially the same result as the results achieved for magnesium by virtue of the claimed invention.

The Court reviewed evidence from the defendant's expert who stated "it is not apparent to me that the substitution of calcium and barium for magnesium would have a material effect on the way the invention works... [n]or is it clear that the inventor intended to exclude the use of calcium and barium as an alternative to magnesium".⁷ In view of this ambivalent evidence, the Court concluded that (a) is not clear that the defendant intended to include anything other than magnesium in the claims, and (b) that the variant of calcium and barium falls outside of the claimed monopoly "in spite of the fact that a substitution would have had no apparent effect on the way that the Lubrizol invention worked".⁸ This acknowledgement of "no apparent effect" appears tantamount to a conclusion of insubstantial differences between the asserted patents' claims and the alleged infringer's use. Such a conclusion stands in stark contrast with the Federal Circuit's "insubstantial differences" analysis, for purposes of finding infringement under the doctrine of equivalents, as discussed in Section II above.

The Court assumed that the defendant had, in the summary judgment proceeding, presented all the evidence that it would present at trial, and concluded that there was no genuine issue for trial. Accordingly, summary judgment was granted.

⁵ *Id.*

⁶ *Free World Trust v. Electro Sante Inc.*, 2 S.C.R. 1024 (2000).

⁷ *Dana Canada v. Lubrizol*, O.S.C.J., Dec, 27, 2001 (LaForme J.)

⁸ *Id.*

On appeal to the Court of Appeal for Ontario, the appeal was allowed and the summary judgment ruling was vacated. The Appeals Court concluded that the trial court had exceeded the narrowly-delineated role of assessing the issue of whether a genuine issue of fact exists as to material facts requiring trial.

In spite of the reversal, the trial court's ruling raises the specter that patent practitioners will need to consider doctrine of equivalents and file wrapper estoppel issues during foreign prosecution, as well as the impact of that the foreign prosecution will have upon the strength and breadth of claim scope of the corresponding U.S. patent.

IV. OBJECTIVE: CONSISTENCY OF U.S. AND FOREIGN FILE WRAPPERS

From the standpoint of good prosecution practice, it is important to carefully review any proposed foreign counterpart argument or amendment before it is filed in the foreign patent office. The review should have the goal of maintaining consistency and uniformity with the corresponding U.S. prosecution.

In the U.S. it is established that a patentee cannot "have their cake and eat it too" by combining a broad disclosure in the specification with narrow claims to avoid scrutiny during prosecution and then assert the doctrine of equivalents during litigation of the patent based upon support provided in the specification.⁹ However, this may not hold true in foreign countries, such as Canada. Accordingly, a global vision for the doctrine of equivalents analysis should take into account the fact that foreign countries that adopt that doctrine may implement and construe the doctrine in a manner different from the evolving construction implemented by the Federal Circuit.

⁹ See generally, Johnson & Johnston Assocs. v. R.E. Serv. Co., 238 F.3d 1347 (Fed. Cir. 2001); Maxwell, 86 F.3d at 1107.