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Carole F. Barrett

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THE APPLICABILITY OF THE DOCTRINE OF FILE WRAPPER ESTOPPEL TO PREVENT RECAPTURE OF ABANDONED PATENT CLAIMS

INTRODUCTION

An inventor attempting to patent a machine, process, manufacture, or composition believed to be novel, useful, and unobvious in light of prior invention¹ must make written application to the Commissioner of Patents and Trademarks.² The application must include drawings where necessary, and a specification describing the invention with such particularity that a "person skilled in the art" will be able to duplicate the invention.³ Additionally, the specification must describe the "best mode" of producing the invention and conclude with claims which point out and distinctly claim the "subject matter which the applicant regards as his invention."⁴

The original application, amendments made during prosecution, and other documents submitted in defense of the application⁵ by the applicant and his patent attorney or agent are stored in a jacket known as a file wrapper. Although strict confidence is maintained with regard to the contents of the file wrapper during prosecution,⁶ the file is open to the public after the patent is issued.⁷

¹ Three elements are critical to patentability: novelty, utility, and nonobviousness. 35 U.S.C. §§ 101, 102, 103 (1976); *Graham v. John Deere Co.*, 383 U.S. 1, 16 (1966).

² 35 U.S.C. § 111 (1976).

³ *Id.* § 112 (1976).

⁴ *Id.* One commentator has equated the function of the claim to that of the real property deed, since both describe the metes and bounds of the grant. J. LANDIS, *MECHANICS OF CLAIM DRAFTING* 518 (2d ed. 1974); see *MANUAL OF PATENT EXAMINING PROCEDURE* § 608.01 (h)-.01(q) (4th ed. 1979 & 1980) [hereinafter cited as MPEP].

⁵ See note 35 *infra*. For an explanation of the appeal procedure see 37 C.F.R. § 1.111 (1979).

⁶ 35 U.S.C. § 122 (1976); 37 C.F.R. § 1.14 (1979); see MPEP, *supra* note 4, at §§ 101-104.

⁷ 37 C.F.R. § 1.11 (1976) provides:

(a) After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of the patent are open to inspection by the general public, and copies may be obtained upon paying the fee therefor

Id. § 1.11(a); see *Ziegler v. Phillips Petroleum Co.*, 483 F.2d 858, 870 (5th Cir.), *cert. denied*, 414 U.S. 1079 (1973); *Levin v. Ripple Twist Mills, Inc.*, 416 F. Supp. 876, 884 n.16 (E.D. Pa.

During infringement actions⁸ the court and the alleged infringer scrutinize the contents of the file wrapper to ascertain the true scope of the patent.⁹ In this regard, an examination of the file wrapper is undertaken to determine if the expansive patent interpretation requested by the patentee in the infringement action had been denied by the Patent Office during prosecution. If so, the court may apply the doctrine of file wrapper estoppel to prevent the assertion of claims, or their equivalents,¹⁰ which had been surrendered during prosecution of the patent.¹¹

Disagreement exists among courts concerning which papers within the file and what types of rejections¹² should be considered to determine the scope of the claimed invention and, therefore, the issue of infringement.¹³ This Note will examine the doctrine of file

1976), *appeal dismissed*, 549 F.2d 795 (3d Cir. 1977); see MPEP, *supra* note 4, at § 103.

⁸ A person granted a patent or his assignee has "the right to exclude others from making, using, or selling the invention throughout the United States" for a term of seventeen years. 35 U.S.C. § 154 (1976). The patent holder may enforce his right of exclusion in a civil action for infringement. *Id.* § 281. In such an action the court may issue an injunction, *id.* § 283, award damages, *id.* § 284, and, where appropriate, attorney fees, *id.* § 285.

⁹ The practice of offering the contents of the file wrapper as evidence of the subject matter claimed or abandoned is well established. See, e.g., *Hubbell v. United States*, 179 U.S. 77, 80 (1900); *Phoenix Caster Co. v. Spiegel*, 133 U.S. 360, 364-65 (1890); *Shepard v. Carrigan*, 116 U.S. 593, 597 (1886).

¹⁰ See notes 26-29 and accompanying text *infra*.

¹¹ See, e.g., *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37 (1942); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926); *Hubbell v. United States*, 179 U.S. 77, 80, 83 (1900). Since file wrapper estoppel is only applicable where the patentee attempts to expand his monopoly beyond a literal reading of its grant, *National Research Dev. Corp. v. Great Lakes Carbon Corp.*, 410 F. Supp. 1108, 1120 (D. Del. 1975), it may not be invoked to prevent a finding of infringement where the "accused matter falls clearly within the claim," *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950).

Although the doctrine is most often invoked where the original claim is broader than that actually granted, it is also applied where the cancelled claim is narrower than the final claim. See, e.g., *Scriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 221 (1940); *Morgan Envelope Co. v. Albany Paper Co.*, 152 U.S. 425, 429 (1894); *Kaiser Indus. Corp. v. McLouth Steel Corp.*, 400 F.2d 36, 51-56 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969); *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.*, 149 U.S.P.Q. 168, 202 (E.D.N.Y. 1966), *aff'd*, 372 F.2d 263 (2d Cir. 1967). One commentator has suggested that such an application be termed estoppel in reverse. 4 D. CHISUM, PATENTS § 18.05[5] (1979).

¹² Claims may be rejected for either prior art, MPEP, *supra* note 4, at § 706.02, or non-prior art reasons, *id.* at § 706.03. Prior art rejections are premised on anticipation or the lack of novelty, 35 U.S.C. § 102 (1976), or obviousness, *id.* § 103. Non-art rejections include those premised on vagueness and indefiniteness, non-statutory subject matter, incompleteness, prolixity, old combination, aggregation, multiplicity, new matter, obvious method, undue breadth, and lack of utility under 35 U.S.C. § 101. See MPEP, *supra* note 4, at § 706.03.

¹³ See, e.g., *Coleco Indus., Inc. v. United States Int'l Trade Comm'n*, 573 F.2d 1247, 1257-58 (C.C.P.A. 1978); *Interdent Corp. v. United States*, 531 F.2d 547, 551-52 (Ct. Cl.

wrapper estoppel as it traditionally has been interpreted by the courts.¹⁴ Alternative judicial interpretations of the doctrine as currently advanced will be analyzed in light of recent case law, and the trend to expansively construe the doctrine will be endorsed.¹⁵

BACKGROUND

The seminal decision involving the application of file wrapper estoppel was handed down by the Supreme Court nearly four decades ago in *Exhibit Supply Co. v. Ace Patents Corp.*¹⁶ In *Exhibit Supply*, the Court had granted certiorari to determine whether the respondent's patent for a contact switch in a pinball machine had been infringed.¹⁷ To ascertain the scope of the patent holder's claims, and thus decide the issue of infringement, the Court reviewed both the prior art¹⁸ and the contents of the file wrapper.¹⁹ The file wrapper clearly indicated that the applicant originally had claimed a conducting means "carried by the table," but had amended the claims to read a means "embedded in the table"²⁰ after the original claims were rejected as reading on the prior art.²¹ The Court concluded that the applicant had abandoned the broad "carried by" claim and, therefore, should be estopped to construe the narrower claim as its equivalent.²² Although the Court did not ignore the applicant's statements concerning the scope of his invention,²³ it premised the estoppel on the amendments to the

1976) (per curiam); *Arvin Indus., Inc. v. Berns Air King Corp.*, 525 F.2d 182, 185 (7th Cir. 1975); *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66, 75 (3d Cir.), cert. denied, 409 U.S. 997 (1972); *Quikey Mfg. Co. v. City Prods. Corp.*, 409 F.2d 876, 878-79 (6th Cir. 1969); *Jack Winter, Inc. v. Koratran Co.*, 375 F. Supp. 1, 20 (N.D. Cal. 1974); *H.M. Chase Corp. v. Idaho Potato Processors*, 96 Idaho 398, 407-10, 529 P.2d 1270, 1279-82 (1974).

It is generally held that for file wrapper estoppel to become a justiciable issue, it must be raised at trial by the alleged infringer, but at least one court has held that it can be raised by the court *sua sponte*. See *General Instrument Corp. v. Hughes Aircraft Co.*, 399 F.2d 373, 385-86 (1st Cir. 1968).

¹⁴ See notes 30-50 and accompanying text *infra*.

¹⁵ See notes 51-114 and accompanying text *infra*.

¹⁶ 315 U.S. 126 (1942).

¹⁷ *Id.* at 128.

¹⁸ Prior art includes all subject matter already patented or in the public domain which would render the application unpatentable. See J. LANDIS, *supra* note 4, at 532.

¹⁹ 315 U.S. at 132-34; see note 24 and accompanying text *infra*.

²⁰ 315 U.S. at 133.

²¹ *Id.* at 136.

²² *Id.* at 137; accord, *Cohn v. Coleco Indus., Inc.*, 558 F.2d 53, 58-59 (2d Cir. 1977).

²³ See *id.* at 133.

claims,²⁴ thus admonishing applicants that amendments would be viewed as material disclaimers and strictly construed.²⁵

In refusing to allow the patentholder to reassert claims surrendered by amendment, the *Exhibit Supply* Court precluded an expansive interpretation of the scope of the patent that is ordinarily obtainable through employment of the doctrine of equivalents. This doctrine permits the patentholder to assert that his patent grants him a monopoly not only over the precise chemical, device, or process patented, but also over equivalent chemicals, devices, or processes.²⁶ The purpose of the doctrine of equivalents is to prevent infringement by one producing a device which "performs substantially the same function" as the plaintiff's device "in substantially the same way to obtain the same result."²⁷ The doctrine thus operates to prevent that infringement which, though not literal, would convert a patentholder's right into a worthless and hollow thing.²⁸

²⁴ *Id.* at 136. The Court noted that the applicant had rejected the amendment proposed by the examiner, preferring to cancel the offending claim and to substitute a "significantly amended" claim which urged acceptance of the questionable claim. *Id.* at 133. In response, the examiner recognized the truth of some of the applicant's suggestions, *id.*, and thereafter, made an additional recommendation for modification, *id.* at 134. The applicant acquiesced, and the claim was allowed. *Id.*

²⁵ *Id.* at 137. *See, e.g.,* *Smith v. Magic City Kennel Club*, 282 U.S. 784, 790 (1931); *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886); *accord, Ekco Prods. Co. v. Chicago Metallic Mfg. Co.*, 347 F.2d 453, 455 (7th Cir. 1965). According to the Court, by amending his claim, the applicant "recognized and emphasized the difference" between the two claims and "proclaimed his abandonment of all that is embraced in that difference." 315 U.S. at 136. *See I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 440, 444 (1926); *Hubbell v. United States*, 179 U.S. 77, 80, 83 (1900).

In addition to holding the patentee estopped from reasserting claims surrendered in the Patent Office, the Court reiterated its longstanding position that an applicant who amends his claims acquiesces in the examiner's rejection and, therefore, is foreclosed from challenging the validity of the rejection in a subsequent infringement action. 315 U.S. at 137. The Supreme Court has long held that appeal is the appropriate remedy for an applicant dissatisfied with a claim rejection. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926); *Hubbell v. United States*, 179 U.S. 77, 83 (1900); *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886); *see* note 35 *infra*.

²⁶ *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950). The *Graver Tank* Court advised that equivalence must be determined on a case-by-case basis, since each ingredient must be viewed in light of the prior art, the qualities it exhibited, the purposes for which it was used, and the functions it performed in the patented invention. *Id.* at 609. Additionally, it must appear that a person "reasonably skilled in the art" in question would have realized the interchangeability of the patent and the alleged infringing ingredients. *Id.* at 609.

²⁷ *Id.* at 608 (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)); *see Machine Co. v. Murphy*, 97 U.S. 120, 125 (1877).

²⁸ *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950). Through

Where the scope or validity of a patent is in issue, courts frequently are faced with the difficult task of harmonizing the expansive doctrine of equivalents, which protects the totality of the patentholder's rightful monopoly, with the restrictive doctrine of file wrapper estoppel, which insures that claims abandoned to secure a patent are not reclaimed as part of the patentholder's monopoly.²⁹ Crucial to this task is a determination of precisely what was surrendered during prosecution and what remains as the essence of the invention.³⁰

PRESENT INTERPRETATIONS OF FILE WRAPPER ESTOPPEL

Three distinct interpretations of file wrapper estoppel—classic file wrapper estoppel, estoppel by admission, and non-art estoppel—have been adopted by the courts. Some jurisdictions have accepted all three forms; others apply only one or two. Classic file wrapper estoppel is applied by all jurisdictions where claims have been narrowed by amendment or abandonment to overcome a prior art rejection.³¹ Estoppel by admission is invoked increasingly by courts where claims have been narrowed or abandoned solely or primarily through the clarifying remarks, arguments, and admissions of the applicant or his patent attorney or agent.³² Finally,

application of the doctrine of equivalents the Court sought to prevent piracy by those who introduced minor variations which added nothing to the invention, but were sufficient to take the copied matter outside the literal words of the claim and, therefore, "outside the reach of the law." *Id.* The principles of equivalency were described by Judge Learned Hand as a doctrine, unique to patent law, which empowers the courts to stretch words and "on proper occasions . . . make them cover more than their meaning will bear." *Royal Type-writer Co. v. Remington Rand, Inc.*, 168 F.2d 691, 692 (2d Cir.), *cert. denied*, 335 U.S. 825 (1948).

²⁹ The doctrine of equivalents has been described as "'subservient to file wrapper estoppel.'" *Interdent Corp. v. United States*, 531 F.2d 547, 551 (Ct. Cl. 1976) (quoting *Tate Eng'r, Inc. v. United States*, 477 F.2d 1336, 1341 (Ct. Cl. 1973)).

³⁰ As one commentator has noted, the *Exhibit Supply* Court did not portend the abandonment of equivalence by totally restricting the patentholder to a narrow, literal reading of his amended claims. Rather, a fair and reasonable interpretation of the claims was sanctioned. D. CHISUM, *PATENTS* § 18.02[3] (1979).

³¹ See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966); *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942); *Koppers Co. v. S & S Corrugated Paper Mach. Co.*, 517 F.2d 1182, 1185 (2d Cir. 1975); *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66, 75 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972); *Strahle v. Dillard's Dep't Stores*, 459 F. Supp. 396, 398 (W.D. Tex. 1978). See MPEP, *supra* note 4, at § 706.02. See generally note 11 *supra*.

³² See, e.g., *Arvin Indus., Inc. v. Berns Air King Corp.*, 525 F.2d 182, 185-86 (7th Cir. 1975); *Quickey Mfg. Co. v. City Prods. Corp.*, 409 F.2d 876, 878-79 (6th Cir. 1969); *Jack Winter, Inc. v. Koratron Co.*, 375 F. Supp. 1, 20 (N.D. Cal. 1974); *Interdent Corp. v. United*

non-art file wrapper estoppel is applied where the applicant has narrowed or abandoned claims subsequent to a rejection for reasons other than obviousness or invalidity in light of the prior art.³³

Classic File Wrapper Estoppel

Classic file wrapper estoppel is premised on the theory that an invention previously patented or in the public domain cannot be claimed or patented by the applicant.³⁴ It prevents claims that have been amended during patent prosecution from being reclaimed by construction or by resort to the doctrine of equivalents.³⁵ Although courts applying classic file wrapper estoppel place primary reliance on a showing of prior art rejection and

States, 531 F.2d 547, 551-52 (Ct. Cl. 1976); *Coleco Indus., Inc. v. United States Int'l Trade Comm'n*, 573 F.2d 1247, 1255-58 (C.C.P.A. 1978).

³³ See, e.g., *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F.2d 400, 406 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935 (1966) (dicta); *H.M. Chase Corp. v. Idaho Potato Processors*, 96 Idaho 398, 409, 529 P.2d 1270, 1281 (1974). See MPEP, *supra* note 4, at § 706.03.

³⁴ *Trio Process Corp. v. L. Goldstein's Sons, Inc.*, 461 F.2d 66, 75 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972). Summarizing the principle of classic file wrapper estoppel, the *Trio Process* court held that an applicant who abandons or redrafts a claim after a prior art rejection concedes his non-invention of that which he disclaims, and thereafter, will not be allowed to assert that his invention lay in what was disclaimed. *Id.*

³⁵ *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942); *Weber Electric Co. v. E.H. Freeman Electric Co.*, 256 U.S. 668, 677 (1921); *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66, 75 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972). An applicant is precluded from reasserting claims abandoned or surrendered during prosecution, notwithstanding that he might have been entitled to claim more than he did and still have avoided the prior art. *Nationwide Chem. Corp. v. Wright*, 584 F.2d 714, 718 (5th Cir. 1978). See generally *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942). Indeed, the court will not second-guess the examiner, but will enforce the limitation chosen by the applicant after a required amendment. *Nationwide Chem. Corp. v. Wright*, 584 F.2d 714, 718 (5th Cir. 1978). If an applicant wishes to preserve a rejected claim, he must protest that rejection in the Patent Office or in the courts. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443-44 (1926).

Whenever a claim is rejected, the Patent Office notifies the applicant of the reasons for the rejection, and provides other information to assist him in determining the appropriateness of continuing the solicitation. 35 U.S.C. § 132 (1976); 37 C.F.R. §§ 1.11-127 (1979); MPEP, *supra* note 4, at § 706.02-.03. Additionally, an applicant may request an interview with the examiner concerning the application. 35 U.S.C. § 132 (1976); 37 C.F.R. § 1.133 (1979); MPEP, *supra* note 4, at § 713. An applicant may appeal to the Board of Examiners, if his claims have been rejected twice. 35 U.S.C. § 134 (1976); 37 C.F.R. §§ 1.113, 1.191-198 (1979). If an applicant is dissatisfied with the decision of the Board of Appeals within the Patent Office, he may appeal either to the Court of Customs and Patent Appeals, 35 U.S.C. § 141 (1976); see 37 C.F.R. §§ 1.301-302 (1979), or initiate an action against the Commissioner in the United States District Court for the District of Columbia. 35 U.S.C. § 145 (1976); 37 C.F.R. §§ 1.303-304 (1979). The judicial alternatives are mutually exclusive. 35 U.S.C. § 141 (1976); 37 C.F.R. § 1.303 (1979).

actual amendment, they also consider, as did the *Exhibit Supply* Court,³⁶ the arguments advanced on behalf of the applicant during prosecution.³⁷

The recent decision in *Nationwide Chemical Corp. v. Wright*³⁸ is illustrative of classic estoppel. The patentholder alleged infringement of his process patent which claimed elimination of certain citrus diseases upon application of "four ounces per acre" of a specific hexachlorophene derivative.³⁹ The alleged infringer was using the same hexachlorophene derivative, in amounts only slightly in excess of four ounces per acre, in substantially the same way, to eliminate the diseases enumerated in the purportedly infringed patent.⁴⁰ Finding that the quantity specified in the patentee's amended claim was selected solely to overcome longstanding prior art rejections, the Fifth Circuit applied file wrapper estoppel to preclude the patent holder from expanding the scope of his monopoly through the doctrine of equivalents.⁴¹ In refusing to substi-

³⁶ 315 U.S. 126, 133-34 (1942); see note 23 and accompanying text *supra*.

³⁷ See, e.g., *Moore Business Forms, Inc. v. Minnesota, Mining & Mfg. Co.*, 521 F.2d 1178, 1184 (2d Cir. 1975); *Welch v. General Motors Corp.*, 330 F. Supp 80, 83-84 (E.D. Va. 1970); *Autogiro Co. v. United States*, 384 F.2d 391, 400 (Ct. Cl. 1967). The Second Circuit, which had a long tradition of examining only the prior art, and the claims and amendments, see note 51 *infra*, recently implied in *Moore Business Forms* that, although alterations in claims were "of primary importance," distinguishing remarks made by the applicant or his representative might affect the court's decision. 521 F.2d at 1184.

³⁸ 584 F.2d 714 (5th Cir. 1978).

³⁹ *Id.* at 715-16.

⁴⁰ *Id.* at 716.

⁴¹ *Id.* at 716-17. The *Nationwide* court posed a hypothetical prosecution to illustrate the use of the doctrine of equivalents after a prior art rejection. *Id.* at 718. The court suggested that if the patentholder had amended his claim to read two to four ounces of chemical to avoid prior art claiming four to eight ounces, and if the defendant were using one ounce in his process, the doctrine of equivalents would allow a finding of infringement. *Id.* See *Ziegler v. Phillips Petroleum Co.*, 483 F.2d 858, 871 (5th Cir.), *cert. denied*, 414 U.S. 1079 (1973); *Hunt Tool Co. v. Lawrence*, 242 F.2d 347, 354 (5th Cir.), *cert. denied*, 354 U.S. 910 (1957). This conclusion was premised on the finding that the lower limit of the amended claim was not required by the Patent Office to avoid a prior art rejection. 584 F.2d at 718. The *Nationwide* court emphasized its belief that the Patent Office was not to be "second guessed" as to what might have been or could have been allowed as patentable. *Id.* at 718. Rather, a patentee who chose a limit after a prior art rejection was bound by his self-selected limitation. *Id.* at 717.

A similarly strict interpretation of an amendment required to overcome prior art rejections was given in *Ekco Prods. Co. v. Chicago Metallic Mfg. Co.*, 347 F.2d 453, 455 (7th Cir. 1965). The *Ekco* court refused to consider how closely the allegedly infringing device approximated the patented invention, or whether the applicant might have been able to insist on a less restrictive amendment. *Id.* at 454. The court suggested that once it determined that the applicant "was forced to introduce [an] element to avoid rejection," it would hold the patentee "strictly to the letter of the limited claims granted to him." *Id.* at 454-55.

tute its judgment for that of the patent examiner, the court suggested that it would be improper to judicially assign to the patentholder a monopoly that had been denied him by the Patent Office.⁴²

In order for classic estoppel to apply, as the *Nationwide* court indicated, it is required that the claim have been amended to overcome a prior art rejection.⁴³ The emphasis placed on the purpose of the amendment is illustrated by a recent district court decision in *Johnson & Johnson v. W.L. Gore & Assocs.*,⁴⁴ an infringement action brought by the holder of a patent for polytetrafluoroethylene tape with specific gravity of approximately 1.2 to 1.8.⁴⁵ With respect to the designated specific gravity range, the court found that while the upper limit was specifically selected to avoid the prior art, the lower level was not.⁴⁶ Thus, since the allegedly infringing tape had a specific gravity of .9, the court held that, had the patent been valid, the patentee would not have been precluded by file wrapper estoppel from resorting to the doctrine of equivalents to expand the "literal coverage of its claims."⁴⁷

Caselaw indicates unequivocal acceptance of classic file wrapper estoppel to bar application of the doctrine of equivalents for the purpose of expanding the patentee's monopoly to include those elements abandoned during prosecution.⁴⁸ Prior art cited by the

⁴² 584 F.2d at 718. One commentator has suggested that while *Nationwide* was a significant decision, the Fifth Circuit applied file wrapper estoppel in a "niggardly" manner thereby "substantially emasculat[ing] . . . the doctrine without any countervailing benefit." PAT. L. PERSP. § B.1[1][b] (1979).

⁴³ 584 F.2d at 718. *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66, 75 (3d Cir.), cert. denied, 409 U.S. 997 (1972); *Eimco Corp. v. Peterson Filters & Eng'r Co.*, 406 F.2d 431, 438 (10th Cir. 1968), cert. denied, 395 U.S. 963 (1969).

⁴⁴ 436 F. Supp. 704 (D. Del. 1977).

⁴⁵ *Id.* at 709. The facts and results of the *Johnson & Johnson* case are almost identical to those suggested by the *Nationwide* court in its hypothetical patent prosecution. See note 41 *supra*.

⁴⁶ 436 F. Supp. at 709.

⁴⁷ *Id.* at 731. The *Johnson & Johnson* court suggested in dicta that claims cannot be expanded under the doctrine of equivalents to cover claims originally abandoned in avoidance of "a rejection based on prior art or indefiniteness." *Id.* at 730 (emphasis added). The use of file wrapper estoppel after a rejection premised on indefiniteness or other non-art reasons, see note 79 *infra*, is considered improper by those jurisdictions adhering strictly to classic estoppel. See, e.g., *Koppers Co. v. S & S Corrugated Paper Mach. Co.*, 517 F.2d 1182 (2d Cir. 1975); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381 (10th Cir. 1965), cert. denied, 383 U.S. 933 (1966).

⁴⁸ See, e.g., *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942); *Hanson v. Alpine Valley Ski Area, Inc.*, 611 F.2d 156 (6th Cir. 1979); *Speed Shore Corp. v. Denda*, 605 F.2d 469, 472 n.6 (9th Cir. 1979); *Nationwide Chem. Corp. v. Wright*, 584 F.2d 714, 718 (5th

examiner, the original claims, and the claims as amended after the prior art rejection are routinely considered in determining what was surrendered.⁴⁹ In addition, arguments made in conjunction with amendments to persuade the examiner of patentability over prior art are also considered.⁵⁰

ESTOPPEL BY ADMISSION

Traditionally, the patent application was regarded as a completely integrated document.⁵¹ As such, the parol evidence rule was applied and, therefore, statements made by the parties during prosecution were regarded as extrinsic to the application and would not be considered in an infringement suit.⁵² An increasing

Cir. 1978); *Cohn v. Coleco Indus., Inc.*, 558 F.2d 53, 58 (2d Cir. 1977); *Burger Train Sys., Inc. v. Ballard*, 552 F.2d 1377, 1384 (10th Cir.), *cert. denied*, 434 U.S. 860 (1977); *Christopher J. Foster, Inc. v. Newport News Shipbldg. & Dry Dock Co.*, 531 F.2d 1243, 1246 (4th Cir. 1975); *Kaiser Indus. Corp. v. McLouth Steel Corp.*, 400 F.2d 36, 54 (6th Cir. 1968), *cert. denied*, 393 U.S. 1119 (1969); *Taylor-Reed Corp. v. Mennen Food Prods., Inc.*, 324 F.2d 108, 113 (7th Cir. 1963).

⁴⁹ See *Keystone Driller Co. v. Northwest Eng'r Corp.*, 294 U.S. 42, 48 (1935); *Smith v. Magic City Kennel Club*, 282 U.S. 784, 788-89 (1931); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 436-39 (1926); *Royer v. Coupe*, 146 U.S. 524, 530-31 (1892). The *Royer* Court held that an amended claim could not be construed as if the limitations were not in it. *Id.* at 532. Recently, the Ninth Circuit Court of Appeals echoed this precedent, finding that claims must be interpreted with reference to the rejected claims and not read to cover what was eliminated by the applicant's own limiting amendments. *Norwood v. Ehrenreich Photo-Optical Indus., Inc.*, 529 F.2d 3, 9-10 (9th Cir. 1975).

⁵⁰ See *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 133-34 (1942); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 437 (1926); *Lehigh Valley R.R. v. Kearney*, 158 U.S. 461, 469 (1895). The *Lehigh* Court restricted a claim to the exact device described where the applicant agreed with the rejection and narrowed the claims by amendment, and where the elements restricting the claims were mentioned specifically in reference letters. 158 U.S. at 469; *accord*, *Haliczer v. United States*, 356 F.2d 541, 544 n.1 (Ct. Cl. 1966) (*per curiam*); *cf.* *Firestone Tire & Rubber Co. v. United States Rubber Co.*, 79 F.R.D. 948, 955 (6th Cir. 1935), *cert. denied*, 298 U.S. 679 (1936) (arguments do not create estoppel, but often assist in understanding the differences between the original and issued claims).

⁵¹ See, e.g., *Smith v. Mid-Continent Inv. Co.*, 106 F.2d 622, 624 (8th Cir. 1939); *Denominational Envelope Co. v. Duplex Envelope Co.*, 80 F.2d 186, 192-93 (4th Cir. 1935); *Catalin Corp. v. Catalazuli Mfg. Co.*, 79 F.2d 593, 594 (2d Cir. 1935); *Barrel Fitting & Seal Corp. v. American Flange & Mfg. Co.*, 74 F.2d 569, 571 (7th Cir. 1935). In *Catalin Corp.*, Judge Learned Hand proclaimed that "if . . . 'integration' of a written instrument has any basis at all, . . . it should apply to . . . a patent." 79 F.2d at 594. Today, even the Second Circuit, which long held that amendments were the sole evidence of abandonment, see note 61 *infra*, admits arguments made in conjunction with amendments in its application of classic file wrapper estoppel. See, e.g., *Capri Jewelry, Inc. v. Hattie Carnegie Jewelry Enterprises, Ltd.*, 539 F.2d 846 (2d Cir. 1976); *Moore Business Forms, Inc. v. Minnesota Mining & Mfg. Co.*, 521 F.2d 1178, 1184 (2d Cir. 1975).

⁵² *Catalin Corp. v. Catalazuli Mfg. Co.*, 79 F.2d 593, 594 (2d Cir. 1935).

number of courts, however, have acknowledged, explicitly or implicitly, the appropriateness of the application of estoppel by admission in cases where an argument or other statement made on behalf of the applicant during prosecution is the critical evidence of narrowing or abandonment of the applicant's claims.⁵³ Such statements, the courts have reasoned, are reliable indicators of the scope of the invention because they illuminate the applicant's understanding of his discovery as well as the terms on which the examiner was willing to withdraw his prior art rejection.⁵⁴

Estoppel by admission is well illustrated by *Quikey Manufacturing Co. v. City Products Corp.*⁵⁵ In the *Quikey* case, the court denied that "periphery to periphery" slits claimed in a patent for a squeeze-type coin purse were equivalent to foreshortened slits in an allegedly infringing purse.⁵⁶ The court reasoned that since the applicant had convinced the examiner to withdraw his prior art rejection by asserting that his invention was patentable over the prior art because of the uniqueness of the periphery to periphery slits, he should be estopped from claiming that his device was equivalent to a purportedly infringing purse having shortened slits.⁵⁷ Additionally, the court observed that if the patented device

⁵³ See, e.g., *Arvin Indus., Inc. v. Berns Air King Corp.*, 525 F.2d 182, 184, 185-86 (7th Cir. 1975); *Quikey Mfg. Co. v. City Prods. Corp.*, 409 F.2d 876, 878-79 (6th Cir. 1969); *Doran Coffee Roasting Co. v. Wyott Mfg. Co.*, 267 F.2d 200, 203 (10th Cir. 1959); *Duplan Corp. v. Deering Milliken, Inc.*, 379 F. Supp. 388, 392 (D.S.C. 1974); *M.O.S. Corp. v. John I. Haas, Inc.*, 248 F. Supp. 211, 214 (E.D. Wash. 1965), *modified on other grounds*, 375 F.2d 614 (9th Cir. 1967); *Interdent Corp. v. United States*, 531 F.2d 547, 551-52 (Ct. Cl. 1976) (*per curiam*).

⁵⁴ See, e.g., *Interdent Corp. v. United States*, 531 F.2d 547, 552 (Ct. Cl. 1976) (*per curiam*). The allegedly infringed device in *Interdent* was an electrically-powered irrigating mechanism used primarily for dental purposes. *Id.* at 549. During the prosecution of the patent, the claim at issue was rejected as reading on the prior art. *Id.* at 551. The applicant argued that the prior art did not disclose his unique combination of a flexible valve and switch mechanism. *Id.* The examiner withdrew his objection, and the claim was allowed as originally written. *Id.* The court determined that the claim thereafter must be construed in light of the convincing representations of the applicant. *Id.* at 552. *But see* *Colourpicture Publishers, Inc. v. Mike Roberts Color Prod., Inc.*, 272 F. Supp. 280, 281 (D. Mass. 1967), *vacated on other grounds*, 394 F.2d 431 (1st Cir.), *cert. denied*, 393 U.S. 848 (1968). The *Colourpicture* court, discussing the validity of a patent, found that remarks made by patent counsel which apparently persuaded the examiner of the patentability of the invention, did not shed "any light on what invention was contained" in the trivial amendment despite the semantic dexterity of the arguments. 272 F. Supp. at 281.

⁵⁵ 409 F.2d 876 (6th Cir. 1969).

⁵⁶ *Id.* at 878-79.

⁵⁷ *Id.* at 878. The *Quikey* court's examination of the file wrapper revealed that the examiner had rejected the applicant's invention based on prior art purses which had less than "full periphery to periphery slits." *Id.* at 878. Subsequently, the applicant argued that

was held to be equivalent to purses which opened by means other than periphery to periphery slits, the patentable novelty over the prior art would be obliterated, rendering the patent void and totally unenforceable.⁵⁸

The Court of Customs and Patent Appeals, recognizing that it was "enunciating a rule broader than traditional 'file wrapper estoppel,'" recently held that estoppel by admission is properly applied where an alleged infringer demonstrates that the applicant's remarks were the sole or critical factor in establishing the novelty or unobviousness of his invention over the prior art.⁵⁹ It is suggested that such an application is proper since the arguments in the Patent Office specifically address the distinctions between the applicant's invention and the prior art, and ultimately convince the examiner that the precise meaning of the claim is not within the scope of the prior art.⁶⁰

The Second Circuit, which traditionally had rejected arguments made before the Patent Office during prosecution as inadmissible parol evidence,⁶¹ recently has modified its position, and in

lengthening the slits was an important patentable improvement over the prior art cited by the examiner. *Id.* The examiner agreed to reconsider the application, and thereafter allowed the claims as originally written. *Id.* Affirming the district court, the Sixth Circuit in *Quikey* concluded that arguments made by the inventor during prosecution compelled narrow construction of the patent. *Id.*

⁵⁸ *Id.* at 879.

⁵⁹ *Coleco Indus., Inc. v. United States Int'l Trade Comm'n*, 573 F.2d 1247, 1257-58, (C.C.P.A. 1978). At issue in *Coleco* was whether the patentee was estopped from expanding the scope of his claims by arguments in which he voluntarily cited and acknowledged a copending application as prior art. *Id.* For a discussion of problems attendant to prior art statements filed by an applicant, see WALTERSCHEID, *Meeting the Duty of Candor Without Making an Admission Against Interest*, 60 J. PAT. OFF. SOC'Y 717 (1978). See generally *In re Nomiya*, 509 F.2d 566 (C.C.P.A. 1975); *In re Hellsund*, 474 F.2d 1307 (C.C.P.A. 1973).

The *Coleco* court proclaimed that having urged a narrow construction of his claims during prosecution, a patentee is precluded from asserting an expansive reading after issuance. 573 F.2d at 1257. Moreover, the court concluded that whenever a patentholder seeks to broaden his claims through the doctrine of equivalents, his case would be open to rebuttal premised on any statements made on his behalf during solicitation. *Id.* at 1258. This suggests that, on a case by case basis, the Court of Customs and Patent Appeals will apply estoppel to non-art rejections.

⁶⁰ See *id.* at 1257-58.

⁶¹ See, e.g., *Katz v. Horni Signal Mfg. Corp.*, 145 F.2d 961, 963 (2d Cir. 1944), cert. denied, 324 U.S. 882 (1945); *Catalin Corp. v. Catalazuli Mfg. Co.*, 79 F.2d 593, 594 (2d Cir. 1935); *A.G. Spalding & Bros. v. John Wanamaker*, 256 F. 530 (2d Cir. 1919); *Zenith Radio Corp. v. Lehman*, 121 F. Supp. 69 (S.D.N.Y. 1954), *aff'd*, 217 F.2d 954 (2d Cir. 1955); *Mount Hope Finishing Co. v. Seneca Textile Corp.*, 39 F. Supp. 994, 996 (S.D.N.Y. 1941), *aff'd*, 137 F.2d 133 (2d Cir. 1943). Declining to examine the attorney's arguments during prosecution, the *Spalding* court declared the only purpose of the doctrine of file wrapper estoppel was to

Capri Jewelry, Inc. v. Hattie Carnegie Jewelry Enterprises, Ltd.,⁶² routinely considered such statements on the issue of the applicability of file wrapper estoppel.⁶³ At issue in *Capri Jewelry* was a claim which had been rejected as reading on the prior art.⁶⁴ The file wrapper indicated that during prosecution, the applicant's patent attorney had interpreted the claim narrowly to avoid a prior art rejection.⁶⁵ Invoking the doctrine of file wrapper estoppel, the court concluded that the patentee was precluded from applying the principles of equivalence to recapture matter which he had acknowledged was the invention of another.⁶⁶ Although the applicant had amended the claim, converting it from a dependent to an independent claim,⁶⁷ the critical distinctions between the patented de-

ascertain which claims were rejected. 256 F.2d at 533. Notably, however, the court found the doctrine "too well settled for us to disturb" though it is "somewhat anomalous at best," since it entails scrutinizing the "preliminary negotiations in the interpretation of a formal document intended to be the final memorial of the parties' intentions." *Id.* at 533-34.

⁶² 539 F.2d 846 (2d Cir. 1976).

⁶³ *Id.* at 851. Prior to *Capri Jewelry*, the Second Circuit had given some weight to remarks made during prosecution. See *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.*, 372 F.2d 263, 270 (2d Cir. 1967); *Mastini v. American Tel. & Tel. Co.*, 369 F.2d 378, 379 (2d Cir. 1966), *cert. denied*, 387 U.S. 933 (1967); *Stiegele v. J. M. Moore Import-Export Co.*, 312 F.2d 588, 593 (2d Cir. 1963); *Eastern Elec. Inc. v. Seeburg Corp.*, 310 F. Supp. 1126, 1130-31 (S.D.N.Y. 1969), *aff'd*, 427 F.2d 23 (2d Cir. 1970).

⁶⁴ 539 F.2d at 851.

⁶⁵ *Id.* The prior art cited by the examiner claimed "'a laminated product wherein an encapsulated liquid-crystal member is bonded to, and embedded between an opaque backing . . . and a transparent upper body member . . .'" *Id.* The applicant's attorney had argued that the claim "clearly specifies . . . [a] transparent body . . . provided with a peripheral flange defining a recess within the body. Nowhere does [the prior art] disclose or suggest such a peripheral flange or recess" *Id.* The allegedly infringing product at issue in *Capri Jewelry* had neither a recess nor a peripheral flange. *Id.* at 850. The court concluded, therefore, that since the applicant's attorney had succeeded in convincing the Patent Office that the applicant had overcome the charge of obviousness based on the very elements omitted from the allegedly infringing devices, file wrapper estoppel barred the application of the doctrine of equivalents. *Id.* at 852.

⁶⁶ *Id.* at 852; see note 65 *supra*. The patent holder in *Capri Jewelry* also argued that the examiner had erred when he rejected the original claims as obvious in light of the prior art. 539 F.2d at 852. The court dismissed this argument, reminding the patent holder that even if the examiner had been incorrect in his rejection, an applicant who "elects to acquiesce in it rather than pursue his other remedies" is not relieved of the bar of file wrapper estoppel. *Id.* (citing *International Latex Corp. v. Warner Bros. Co.*, 276 F.2d 557, 565 (2d Cir.), *cert. denied*, 364 U.S. 816 (1960)).

⁶⁷ 539 F.2d at 851. A dependent claim refers to and narrows a single preceding parent claim which can itself be either dependent or independent. 35 U.S.C. § 112 (1976); see MPEP, *supra* note 4, at § 608.01(k); J. LANDIS, *supra* note 4, at 159, 521. While incorporating the parent claim by reference, a dependent claim can expand, limit, or describe elements of its parent claim. J. LANDIS, *supra* note 4, at 160; see 35 U.S.C. § 112 (1976). In contrast, an independent claim provides a description of the subject matter without reference to

vice and the prior art were not contained within those amendments⁶⁸ but, rather, were evidenced by the arguments made before the Patent Office.⁶⁹ Consequently, the court was forced to rely primarily on the arguments made by the applicant's representative which convinced the examiner to withdraw his objections.⁷⁰ It appears, therefore, that the Second Circuit, while not officially adopting estoppel by admission, has applied its principles in *Capri Jewelry* by relying substantially on arguments made during prosecution.⁷¹

Other courts, although adopting estoppel by admission, have applied it under varying circumstances.⁷² A district court in the Seventh Circuit has extended the concept of estoppel by admission to include judicial admissions made subsequent to the issuance of the patent.⁷³ A district court in the Ninth Circuit, while acknowl-

other claims. J. LANDIS, *supra* note 4, at 526. In *Arvin*, the plaintiff alleged that his patent claiming a heater with a "generally planar reflective surface" was infringed by the defendant's heat reflecting element. 525 F.2d at 183. The plaintiff urged an expansive interpretation of "generally planar" to include the defendant's curved device. *Id.* at 185. Documentation within the file wrapper demonstrated that the applicant had insisted in arguments before the Patent Office that his "generally planar" reflector was patentable over the curvilinear prior art. *Id.* at 186. The court concluded that the defendant's device did not infringe the plaintiff's patent since it was substantially equivalent to the prior art reflector disclaimed by the plaintiff's assignor in his arguments to the examiner. *Id.* Although the file wrapper indicated that amendments had been made by the applicant during prosecution, *Arvin* is most reflective of estoppel by admission because the court found that "the applicant's conduct . . . preclude[d] any resort whatsoever to the doctrine of equivalents." *Id.* at 185-86.

Significantly, if the *Arvin* court had found that the patented heating device and the allegedly infringing one were equivalent, the court would have had to face the dilemma described by the *Quikey* court, *see* note 58 and accompanying text *supra*. It is suggested that in that event, the *Arvin* court would have been required to find the plaintiff's patent indistinguishable from prior art and, therefore, invalid and unenforceable. *See Quikey Mfg. Co. v. City Prods. Corp.*, 409 F.2d 876, 879 (6th Cir. 1969).

⁶⁸ 539 F.2d at 851; *see* note 65 and accompanying text *supra*.

⁶⁹ 539 F.2d at 851.

⁷⁰ *Id.*

⁷¹ *See generally id.*

⁷² *See, e.g., Arvin Indus. Inc. v. Berns Air King Corp.*, 525 F.2d 182, 185 (7th Cir. 1975); *International Harvester Co. v. John Deere & Co.*, 478 F. Supp. 411, 417 (C.D. Ill. 1979); *Jack Winter, Inc. v. Koratron Co.*, 375 F. Supp. 1, 20 (N.D. Cal. 1974).

⁷³ *International Harvester Co. v. John Deere & Co.*, 478 F. Supp. 411, 417 (C.D. Ill. 1979). The *International Harvester* decision was based on prior judicial admissions and not on admissions made in the Patent Office. Therefore, it is not a true case of file wrapper estoppel. *International Harvester* brought an action for declaratory judgment, alleging that its "corn head," composed of three separate gears which drove four mobile components, did not infringe Deere's patented "corn head," which used one gear to drive the total unit. *Id.* at 417. In a prior infringement action between the same litigants, Deere had maintained that the critical element of the patent at issue in the declaratory judgment action was "the lat-

edging that the preamble is not an element of the claim, extended estoppel by admission principles to the preamble where it was shown that the applicant had convinced the examiner that the preamble made his invention patentable over the prior art.⁷⁴

It is suggested that the judicial trend to employ estoppel by admission aids in effectuating the equitable construction of the scope of a patent. Clearly, if the courts do not construe the doctrine of file wrapper estoppel to include estoppel by admission, an applicant who vigorously argues a narrow construction of his patent before the examiner could, in a subsequent infringement action, successfully expand it by invoking equivalence, thereby circumventing the expertise of the Patent Office,⁷⁵ and conceivably, incorporating the prior art into his monopoly.⁷⁶ The *Quikey* court recognized this dilemma when it suggested that if a court were to read the allegedly infringed patent so broadly as to be equivalent to the prior art, then it must declare the patent invalid and totally unenforceable.⁷⁷ Indeed, it is obvious that claims cannot be interpreted narrowly to determine validity and broadly to find infringement.⁷⁸

NON-ART ESTOPPEL

Non-art estoppel is applied by some courts where an applicant attempts to reassert a claim, or its equivalent, which had been

eral compactness . . . achieved by . . . a single drive gear" *Id.* at 414. Additionally, in the prior suit, Deere had distinguished its patent from prior art having multiple drive trains by stressing the unique qualities of its single drive element. *Id.* The court determined that there was no literal infringement because International Harvester's device used three separate driving gears, *id.* at 415, and that Deere was estopped by its admissions in a previous infringement suit from using equivalence to expand its monopoly. *Id.* at 417. A district court in the Fourth Circuit has also applied estoppel to prior judicial admissions to prevent application of the doctrine of equivalents. See *Marston v. J.C. Penney, Inc.*, 324 F. Supp. 889, 894-95 (E.D. Va. 1971), *aff'd per curiam*, 469 F.2d 694 (4th Cir. 1972).

⁷⁴ *Jack Winter, Inc. v. Koratron Co.*, 375 F. Supp. 1, 20 (N.D. Cal. 1974).

⁷⁵ See generally *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942).

⁷⁶ See *Quikey Mfg. Co. v. City Prods. Corp.*, 409 F.2d 876 (6th Cir. 1969).

⁷⁷ *Id.* at 879; see notes 57 & 58 and accompanying text *supra*.

⁷⁸ *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp.*, 149 U.S.P.Q. 168, 195-96 (E.D.N.Y. 1966), *aff'd*, 372 F.2d 263 (2d Cir. 1967); see *Paramount Indus., Inc. v. Solar Prods. Corp.*, 186 F.2d 999, 1001 (2d Cir. 1951). In *Paramount Industries*, the patentee suggested a narrow reading of the prior art to insure the validity of his patent but urged the court to read his own claims broadly. *Id.* Rejecting the suggested approach as inconsistent, the court declared that the alleged infringers were correct in stating that, "[i]f the claims in suit are to be held not anticipated they must be given an (sic) construction under which the defendants do not infringe." *Id.* (quoting brief of defendant).

amended or abandoned during prosecution to avoid rejection for reasons other than unpatentability over prior art.⁷⁹ Although stating that it was inapplicable on the facts, the First Circuit endorsed non-art estoppel in *Borg-Warner Corp. v. Paragon Gear Works, Inc.*⁸⁰

Involved in *Borg-Warner* was a pump for a hydraulic motor boat transmission, which the patentee claimed was novel because oil fluid direction could be changed merely by reversing certain parts in the pump.⁸¹ To obtain this result, the patentee had designed a seal plate with two "obversely symmetrical apertures," each spanning 180 degrees.⁸² The alleged infringing pump was identical to the patentee's except that its ports were asymmetrical.⁸³

Initially determining that there was no literal infringement,⁸⁴ the court addressed the patentee's claim of equivalence. Three of the patentholder's four original claims asserted only "functional alignment" of the apertures;⁸⁵ the fourth provided for semicircular

⁷⁹ See, e.g., *Teledyne Mid-American Corp. v. International Tel. & Tel. Corp.*, 449 F.2d 502, 504 (1st Cir. 1971); *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F.2d 400, 406 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935 (1966); *H.M. Chase Corp. v. Idaho Potato Processors*, 96 Idaho 398, 409, 529 P.2d 1270, 1281 (1974). Non-art or formal rejections are those premised on the form of the claim rather than on encroachment on the prior art. See MPEP, *supra* note 4, at § 706.03(a); LANDIS, *supra* note 4, at 183-206. Non-art rejections may be based on, among other things, undue breadth, incompleteness, vagueness and indefiniteness, and new matter. See note 12 *supra*. Although the MANUAL OF PATENT EXAMINING PROCEDURE directs that claims be allowed if they "define . . . patentable novelty with a reasonable degree of particularity and distinctness." MPEP, *supra* note 4, at § 706.03(d) (emphasis in original), some latitude in the manner of expression is allowable. *Id.* Generally, non-chemical claims may "be drawn as broadly as permitted by the prior art." *Id.* In contrast, the manual suggests that claims be rejected as incomplete where essential steps, elements or "necessary structural cooperative relationship of elements" are omitted. *Id.* at § 706.03(f).

⁸⁰ 355 F.2d 400, 406 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935 (1966). The First Circuit appears to be the only federal appellate court to have specifically endorsed non-art estoppel. The Court of Customs and Patent Appeals, however, has indicated its willingness to consider the principles of file wrapper estoppel whenever the patent holder invokes the doctrine of equivalents to expand his claims. *Coleco Indus., Inc. v. United States Int'l Trade Comm'n*, 573 F.2d 1247, 1258 (C.C.P.A. 1978); see notes 59 & 60 and accompanying text *supra*. It is suggested, therefore, that given the proper factual situation, that court would apply estoppel where the patentee had surrendered his claim after a non-art rejection.

⁸¹ 355 F.2d at 401.

⁸² *Id.* at 402.

⁸³ *Id.* at 402-03.

⁸⁴ *Id.* at 403.

⁸⁵ *Id.* at 405.

openings.⁸⁶ After a prior art rejection, several slight amendments were made; these were rejected and cancelled, however, as anticipated by the prior art, indefinite, incomplete, and functional.⁸⁷ On the subsequent submission of three new claims, the examiner allowed the two claiming apertures "extending substantially 180°."⁸⁸

In support of his allegation of equivalence, the patentee argued that amendments to make claims more definite should never give rise to an estoppel.⁸⁹ The *Borg-Warner* court disagreed, concluding that file wrapper estoppel was applicable, since a person examining the file wrapper to ascertain the scope of the patent, and finding something affirmatively disclaimed, should be able to rely on that disclaimer regardless of the reason for which it was made.⁹⁰ Indeed, since a patent is equally invalid whether the description is inadequate, or whether it anticipates prior art, the court reasoned that an applicant should be estopped from asserting matter in any rejected claim notwithstanding the particular objection raised by the examiner.⁹¹

Increasingly, courts are beginning to recognize the applicability of file wrapper estoppel to non-art amendments.⁹² Notably, while the Third Circuit traditionally applied only classic file wrap-

⁸⁶ *Id.*

⁸⁷ *Id.* at 405 n.8. See note 79 *supra*. A claim is rejected as "functional" where it either "contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of the functional language in the claim," or "recites only a single means, and thus, encompasses all possible means for performing a desired function." MPEP, *supra* note 4, at § 706.03(c).

⁸⁸ 355 F.2d at 405.

⁸⁹ *Id.* at 406. The patentee urged the court not to apply file wrapper estoppel because he had not changed the scope of his invention by altering the preamble, drawings or specifications. *Id.* at 405.

⁹⁰ *Id.* at 406.

⁹¹ *Id.* (citing *Standard Brands, Inc. v. National Grain Yeast Corp.*, 308 U.S. 34 (1939); *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364 (1938); *H.C. Baxter & Bro. v. Great Atl. & Pac. Tea Co.*, 236 F. Supp. 601 (D. Me. 1964), *aff'd*, 352 F.2d 87 (1st Cir. 1965), *cert. denied*, 384 U.S. 905 (1966)).

⁹² See, e.g., *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972); *Schmidinger v. Welsh*, 383 F.2d 455 (3d Cir. 1967), *cert. denied*, 390 U.S. 946 (1968); *Chemical Constr. Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367 (3d Cir. 1962). The original claim of the applicant in *Trio Process* had been rejected as "misdescriptive in view of the specification," and not for prior art reasons. 461 F.2d at 75. In a subsequent infringement action, the court held that the principles of estoppel were inapplicable because the applicant had amended after a rejection on a "technical matter" having no relationship to patentability. *Id.* The Tenth Circuit has also refused to apply file wrapper estoppel where the applicant has amended claims to overcome an objection based on misdescription. *Eimco Corp. v. Peterson Filters & Eng'r Corp.*, 406 F.2d 431, 438 (10th Cir. 1968), *cert. denied*, 395 U.S. 963 (1969).

per estoppel, at least two district courts within that circuit have indicated recently that non-art rejections would provide an acceptable basis for invoking file wrapper estoppel.⁹³ The Second Circuit, however, has not adopted the principles of non-art estoppel.⁹⁴ Recently, a district court within the Second Circuit reiterated this position, finding file wrapper estoppel inapplicable where the claims had been rejected as indefinite or unstatutory.⁹⁵ The Fifth,⁹⁶ Sev-

⁹³ See *Johnson & Johnson v. W.L. Gore & Assocs.*, 436 F. Supp. 704 (D. Del. 1977); *Systematic Tool & Mach. Co. v. Walter Kidde & Co.*, 409 F. Supp. 511, 514 (E.D. Pa. 1976), *rev'd on other grounds*, 555 F.2d 342 (3d Cir.), *cert. denied*, 434 U.S. 857 (1977). The *Johnson & Johnson* court stated that "[i]f a patentee narrows his claims in order to avoid a rejection based on prior art or *indefiniteness*, the claims cannot later be expanded, under the doctrine of equivalents . . ." 436 F. Supp. at 730 (emphasis added) (citing *Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972); *Borg-Warner Corp. v. Paragon Gear Works*, 355 F.2d 400 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935 (1966)). Similarly, although it rejected the application of estoppel to amendments which merely clarify and do not narrow the claims, the *Systematic Tool* court, employing language evocative of *Borg-Warner*, stated that where an inventor narrows his claims to distinguish them from the prior art, or "to eliminate unpatentable claims . . . [r]egardless of the reason, the effect of such abandonment . . . is to estop . . . later us[e] [of] the doctrine of equivalents." 409 F. Supp. at 514-15. Cf. *Levin v. Ripple Twist Mills Inc.*, 416 F. Supp. 876, 884 n.16 (E.D. Pa. 1976), *appeal dismissed*, 549 F.2d 795 (3d Cir. 1977) (narrowing of claims "in response to patent office action" gives rise to estoppel). Notwithstanding the *Johnson & Johnson* and *Systematic Tool* decisions, however, it is suggested that *Trio Process*, from which the two district courts purported to distill the controlling precedent, advocated only classic estoppel. In *Trio Process*, the Third Circuit stated, without further elaboration, that for file wrapper estoppel to be applicable "it is necessary, at the least, that a claim have been narrowed to avoid the prior art. 461 F.2d at 75 (emphasis added). Indeed, notwithstanding *Johnson & Johnson* and *Systematic Tool*, other Third Circuit courts continue to adhere to the traditional approach of applying estoppel only where there has been a prior art rejection. See, e.g., *International Election Sys. Corp. v. Shoup*, 452 F. Supp. 684 (E.D. Pa. 1978), *aff'd mem.*, 595 F.2d 1212 (3d Cir. 1979); *Clopay Corp. v. Blessings Corp.*, 422 F. Supp. 1312 (D. Del. 1976).

Although cases prior to *Trio Process* contain language suggesting that file wrapper estoppel might be applicable to amendments made other than in response to prior art rejections, no case explicitly so held. See, e.g., *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429 (1926); *Shepard v. Carri-gan*, 116 U.S. 593 (1886); *Bishman Mfg. Co. v. Stewart-Warner Corp.*, 380 F.2d 336 (7th Cir.), *cert. denied*, 389 U.S. 897 (1967). Indeed, notwithstanding sweeping language suggestive of a liberal interpretation of the doctrine, the *Bishman* case, on which express reliance was placed in *Trio Process*, held file wrapper estoppel inapplicable where the claim had been amended "simply [to] adher[e] to the most descriptive recitation of the structure." *Id.* at 340.

⁹⁴ See, e.g., *Cohn v. Coleco Indus., Inc.*, 558 F.2d 53, 59 (2d Cir. 1977); *Koppers Co. v. S & S Corrugated Paper Mach. Co.*, 517 F.2d 1182, 1185 (2d Cir. 1975).

⁹⁵ *Schimizzi v. Chrysler Corp.*, 462 F. Supp. 630 (S.D.N.Y. 1978). At issue in *Schimizzi* was the validity and the infringement of an anti-theft device for an automobile trunk. *Id.* at 631. Despite finding the patent invalid because of obviousness to persons skilled in the art, *id.* at 639, the court discussed the applicability of file wrapper estoppel, *id.* at 634. The court advised that application of the doctrine was appropriate not only where claims which had

enth,⁹⁷ and Tenth⁹⁸ Circuits have adopted similar positions, declining to apply the doctrine to restrict the interpretation of claims where the file wrapper indicated that amendment was predicated on non-art rejections.⁹⁹

Although there appears little reason to limit the applicability of file wrapper estoppel to claims surrendered to overcome a prior art rejection,¹⁰⁰ it is not suggested that every amendment should give rise to an estoppel. Changes which are not essential to the scope of the invention are, it is submitted, inappropriate matter for the application of file wrapper estoppel and, hence, should not

been rejected on prior art grounds are cancelled or narrowed, but also where elements or limitations were added to the original claims after prior art rejection. Additionally, the court indicated that the elements or limitations appearing in the amended claims should be treated as "critical to patentability." *Id.* The court stood firm, however, in the position that changes precipitated by indefiniteness or unstatutory rejections were inappropriate predicates for the application of estoppel. *See id.*

⁹⁶ *See, e.g.,* Ziegler v. Phillips Petroleum Co., 483 F.2d 858, 870-71 (5th Cir.), *cert. denied*, 414 U.S. 1079 (1973); Hunt Tool Co. v. Lawrence, 242 F.2d 347, 353-54 (5th Cir.), *cert. denied*, 354 U.S. 910 (1957). *But see* Laitram Corp. v. DeepSouth Packing Co., 443 F.2d 928, 934 (5th Cir. 1971); Strahle v. Dillard's Dep't Stores, 459 F. Supp. 396, 398 (W.D. Tex. 1978).

⁹⁷ *See, e.g.,* Laser Alignment, Inc. v. Woodruff & Sons, Inc., 491 F.2d 866, 876 (7th Cir.), *cert. denied*, 419 U.S. 874 (1974); Ellipse Corp. v. Ford Motor Co., 452 F.2d 163, 168 (7th Cir. 1971), *cert. denied*, 406 U.S. 948 (1972); Coulter Elec. Inc. v. J.T. Baker Chem. Co., 487 F. Supp. 1172, 1175 (N.D. Ill. 1980); Matherson-Selig Co. v. Carl Gorr Color Card, Inc., 301 F. Supp. 336, 350-51 (N.D. Ill. 1967). The *Laser Alignment* court held that notwithstanding the assertion that the applicant surrendered something during his arduous efforts to obtain his patent, the doctrine of file wrapper estoppel would not preclude application of the principles of equivalence where the claims of the issued patent were "basically a re-phrasing" of the rejected claims. 491 F.2d at 876. The court concluded that the alleged infringer could not rely on amendments made to overcome difficulties in wording or indefiniteness to negate equivalents otherwise available to expand the monopoly. *Id.*

⁹⁸ *See, e.g.,* Burger Train Sys., Inc. v. Ballard, 552 F.2d 1377, 1384 (10th Cir.), *cert. denied*, 434 U.S. 860 (1977); Eimco Corp. v. Peterson Filter & Eng'r Corp., 406 F.2d 431 (10th Cir. 1968), *cert. denied*, 395 U.S. 963 (1969); McCullough Tool Co. v. Well Surveys, Inc., 343 F.2d 381, 403 (10th Cir. 1965), *cert. denied*, 383 U.S. 933 (1966).

⁹⁹ The position of the Ninth Circuit regarding non-art estoppel is unclear. In *Speed Shore Corp. v. Denda*, 605 F.2d 469 (9th Cir. 1979), the court of appeals affirmed, as not clearly erroneous, the district court's refusal to apply file wrapper estoppel where amendments were made only to clarify claims, *id.* at 472 n.6. The court did not, however, address the application of the doctrine to other non-art rejections. *See* *Norwood v. Ehrenreich Photo-Optical Indus., Inc.*, 322 F. Supp. 898, 904 (C.D. Cal. 1970), *aff'd*, 529 F.2d 3, 9 (9th Cir. 1975). In *Norwood*, the district court specified that "[n]o limitation which a patentee puts into his claim may be ignored, whether or not the limitation was necessary to validate the claim." *Id.* at 904.

¹⁰⁰ *Coleco Indus., Inc. v. United States Int'l Trade Comm'n*, 573 F.2d 1247, 1257-58; *see* note 59 *supra*.

preclude application of the doctrine of equivalents.¹⁰¹ In contrast, where changes in terms essential to the invention's scope are mandated by vagueness, or necessitated by overclaiming, application of file wrapper estoppel would seem appropriate.¹⁰² This is especially true because an applicant disagreeing with the examiner's rejection has remedies within the Patent Office and the courts during the prosecution period; he need not amend his claims without protest.¹⁰³ Indeed, if an applicant agrees to a narrow construction of an essential term to overcome a non-art rejection, equitable application of the doctrine of file wrapper estoppel demands that he be precluded from circumventing the patent procedure by resubjecting the exact matter denied him by the Patent Office.¹⁰⁴

The decision in *H.M. Chase Corp. v. Idaho Potato Processors, Inc.*,¹⁰⁵ illustrates that courts do not look kindly on attempts to revive claims surrendered to satisfy the examiner. In *Chase*, the court was asked to uphold the contractual rights of a patent holder who maintained that his steam blanching potato process was equivalent to the hot water blanching process used by his licensee.¹⁰⁶ The file wrapper showed that during prosecution the applicant had attempted to amend his original claim of a steam process to include hot water, but had received a non-art rejection.¹⁰⁷ After several subsequent amendments were likewise rejected for non-art reasons,¹⁰⁸ the applicant retreated without protest and reclaimed his original steam blanching process.¹⁰⁹ In light of the unsuccessful attempts at amendment, the *Chase* court determined that the ap-

¹⁰¹ See *Graver Tank & Mfg. Co. v. Linde Air Prods.*, 339 U.S. 605, 608 (1950). See generally notes 27-29 and accompanying text *supra*.

¹⁰² See *Borg-Warner Corp. v. Paragon Gear Works, Inc.*, 355 F.2d 400, 406 (1st Cir. 1965), *cert. dismissed*, 384 U.S. 935 (1966); *H.M. Chase Corp., v. Idaho Potato Processors Inc.*, 96 Idaho 398, 409, 529 P.2d 1270, 1281 (1974).

¹⁰³ See 35 U.S.C. §§ 131-135, 141-146 (1976); note 87 *supra*.

¹⁰⁴ *Cf. Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942) (patentee may not reclaim that which he surrendered by acquiescing in strict construction of his claim). *But see Trio Process Corp. v. L. Goldstein's Sons*, 461 F.2d 66, 75 (3d Cir.), *cert. denied*, 409 U.S. 997 (1972) (formalistic rules of Patent Office should not deprive patentee of full measure of his invention).

¹⁰⁵ 96 Idaho 398, 529 P.2d 1270 (1974).

¹⁰⁶ *Id.* at 406, 529 P.2d at 1278.

¹⁰⁷ *Id.* at 407, 529 P.2d at 1279. The examiner based the rejection on the introduction of new material. *Id.* A new matter rejection is derived from the last sentence of 35 U.S.C. § 132 (1976) which prohibits such additions to the patent claims. 35 U.S.C. § 132 (1976); 37 C.F.R. § 1.118 (1979); see MPEP, *supra* note 4, §§ 608.04-.04(c), 706.03(o).

¹⁰⁸ 96 Idaho at 407, 529 P.2d at 1279.

¹⁰⁹ *Id.*

plicant knew that the examiner viewed hot water and steam blanching as non-equivalent, and that the applicant had acquiesced in the examiner's finding in order to assure issuance of his patent.¹¹⁰ The *Chase* court thus applied non-art estoppel to prevent the patentee from expanding his monopoly to include those very matters abandoned or denied during prosecution.¹¹¹

A determination of immateriality with respect to a non-art amendment should not be equated, however, with a finding of irrelevancy. Although admittedly, the only changes mandated by non-art rejections which are proper subject matter for estoppel are those which affect the scope of the invention,¹¹² it is suggested that all amendments made subsequent to non-art rejections have a valid place before the court. Indeed, while amendments which are based on a non-art rejection of matter not essential to the invention's scope should not prevent use of the principles of equivalency,¹¹³ it is submitted that general evidentiary principles dictate that altered claims nevertheless should be admitted in infringement actions as some evidence of the true scope of the invention.¹¹⁴

CONCLUSION

The doctrine of file wrapper estoppel was developed to counterbalance the broad construction of patents obtainable through the employment of principles of equivalency. In its classical form, the doctrine has been uniformly accepted and applied to prevent the recapture of claims surrendered or abandoned by amendment to overcome prior art rejection. Recently, however, courts have begun to expand the scope of the doctrine by eliminating the requirement that a claim be relinquished by amendment. Indeed, an increasing number of courts currently hold that file wrapper estoppel is applicable to admissions made by or on behalf of the patentee which concern the parameters of his invention. A few courts, more-

¹¹⁰ *Id.* at 409-10, 529 P.2d at 1281-82.

¹¹¹ *Id.* at 410, 529 P.2d at 1282.

¹¹² See *Systematic Tool & Mach. Co. v. Walter Kidde & Co.*, 409 F. Supp. 511, 514-15 (E.D. Pa. 1976), *rev'd on other grounds*, 555 F.2d 342 (3d Cir.), *cert. denied*, 434 U.S. 857 (1977); *H.M. Chase Corp. v. Idaho Potato Processors, Inc.*, 96 Idaho 398, 409, 529 P.2d 1270, 1281 (1974).

¹¹³ See notes 26-29 and accompanying text *supra*.

¹¹⁴ It is suggested that changes agreed to by the applicant be examined under the ordinary rules of evidence to ascertain whether an admission has been made. See McCORMICK, EVIDENCE §§ 262, 267 (2d ed. 1972 & Supp. 1978); 4 WIGMORE, EVIDENCE §§ 1048-1059 (3d ed. 1940 & 1970 Supp.).

over, while not necessarily dispensing with the requirement of amendment, have further expanded classic file wrapper estoppel by employing the doctrine to preclude reassertion of *any* essential claim previously relinquished. As this Note has attempted to demonstrate, such expansions are consonant with the theory and purpose of file wrapper estoppel. Indeed, it is fundamental that a patentholder should be precluded from circumventing the expertise of the examiner by attempting to expand the scope of his monopoly beyond that which was granted. Estoppel by admission and non-art estoppel, although not uniformly credited, recognize the utility of certain representations made by an applicant to determine his conception of the invention. It is urged, therefore, that courts scrutinize admissions made by or on behalf of an applicant as well as essential non-art amendments in order to more equitably ascertain the true scope of a patent.

Carole F. Barrett