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File Wrapper Estoppel

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FILE WRAPPER ESTOPPEL

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Patent law cases are rare in Washington. *Thys v. Rivard,*[1] the most recent, concerned patent infringement and turned on two important rules of patent law: the doctrine of equivalents and the doctrine of file wrapper estoppel. Although the former of these rules had confronted the court on an earlier occasion,[2] file wrapper estoppel was presented for the first time by the *Rivard* case.

File wrapper estoppel, a rule of patent construction,[3] derives its name from the Patent Office file wrapper containing the record of proceedings leading up to the grant of the letters patent. If, when the Patent Office examines the application for patent, it is found in the light of the prior art in the field that the applicant has drawn his claims too broadly for his actual invention they will be rejected. Should the rejection be made final, two alternatives are open to the applicant: appeal to the federal courts or amend the claims to meet the grounds of rejection. If the latter course is followed and the claims are narrowed to avoid conflict with the prior art cited against them, the applicant's rights under the resulting patent are limited by file wrapper estoppel. That is, a court construing the patent will not extend its claims to the point where they become equal to or greater than those originally in the application. The theory is that the patentee is estopped from asserting an interpretation of his patent claims so broad as to recapture subject matter once cancelled from the application in order to secure allowance of the patent.[4]

While file wrapper estoppel, in its foregoing aspect, operates to *restrict,* the doctrine of equivalents permits a court to extend, the coverage of a patent.[5] This doctrine is normally applied in the case of clearly meritorious inventions, to give full or maximum effect to the patent. Under this rule the patentee is entitled to the exclusive right to make, use and sell not only the thing particularly specified in the patent claims but all reasonable equivalents thereof as well. The policy

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[1] 129 Wash. Dec. 469. 189 P.(2d) 952 (1947).

[2] Osgood Panel and Veneer Co. v. Osgood, 166 Wash. 315, 6 P.(2d)661 (1932).

[3] Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940), Shepard v. Carrigan, 116 U.S. 593 (1885), Sutter v. Robinson, 119 U.S. 530 (1886), Roemer v. Peddie, 132 U.S. 313 (1889), Phoenix Caster Co. v. Spiegel, 133 U.S. 360 (1889), Hubbell v. U.S., 179 U.S. 77 (1900), Weber Electric Co. v. Freeman, 256 U.S. 668 (1920), I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 426 (1926).

[4] The Texas Company v. Anderson-Prichard Refining Co., 122 F.(2d) 829, 50 U.S.P.Q. 600 (C.C.A. 10th, 1941).

[5] Osgood Panel and Veneer Co. v. Osgood, *supra,* note 2.

of the doctrine of equivalents is in keeping with the promotional spirit of the constitutional provision.[6]

Despite its virtue, the doctrine of equivalents should be applied cautiously.[7] While inventors should be fully protected in their patent rights, certainty in the meaning of patents is of equal if not greater importance to the public. Fear of infringing patents deceivingly restricted by the usual standards of construction, yet subject to the expansive doctrines of equivalents unreasonably applied would discourage other inventors and industry alike from making new advances. Recognizing this problem, courts generally reject the doctrine of equivalents entirely in cases where the countervailing rule, file wrapper estoppel, is found applicable.[8] "The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest."[9]

In the instant case,[10] the appellants' right to recovery lay primarily in contract. This right in turn depended upon proof that respondents' hop-picking machine infringed appellants' patent. Appellants relied on the doctrine of equivalents, while respondents denied infringement and introduced in evidence the file wrapper of appellants' patent to prove file wrapper estoppel. On the second appeal, relying upon the doctrine of equivalents the court reversed, stating that the defense of file wrapper estoppel, although a complete defense to patent infringement, is an affirmative defense and, as a result, must be pleaded specially, which respondents did not do. No reference was made in the opinion of appellants' failure to plead the doctrine of equivalents.

Citing no authority for its holding, the court proceeded contrary to the usual rule, that file wrapper estoppel is inherently part of the very question of infringement and is not an affirmative defense to infringement.[11] On the question of pleading, while the federal courts require

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[6] Art I, § 8. "The Congress shall have power to promote the progress of science and useful arts, by securing to authors and inventors the exclusive right to their respective writings and discoveries."

[7] Osgood Panel and Veneer Co. v. Osgood, *supra*, note 2.

[8] Schriber-Schroth v. Cleveland Trust Co., *supra*, note 3, Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942), Smith v. Magic City Club, 282 U.S. 784 (1930), Weber Electric Co. v. Freeman, *supra*, note 3.

[9] Schriber-Schroth v. Cleveland Trust Co., *supra*, note 3.

[10] Thys v. Rivard, *supra*, note 1.

[11] Kuester v. Hoffman, 152 F.(2d) 318 (C.C.A. 7th 1935), Thomas v. Simmons Company, 126 F.(2d) 743, 53 U.S.P.Q. 88 (C.C.A. 7th 1945), Oldfield v. Nunn Brass Works, 42 F Supp. 262 (W.D.N.Y. 1941), Kohloff v. Ford Motor Co., 37 F Supp. 462, 48 U.S.P.Q. 423 (S.D.N.Y. 1941), Research Products Co. Ltd. v. The Treolite Co., 66 F.(2d) 530, 43 U.S.P.Q. 99 (C.C.A. 9th 1939).

pleading or notice of the grounds relied on in attacking the *validity* of patents, it has not been supposed that such a requirement extends to matters of patent *construction.*[12] This writer has discovered no case supporting the *Rivard* decision.

Understanding the *Rivard* case is made still more difficult because the holding excuses one party from pleading a rule of patent construction, while requiring the opposite party to plead the countervailing rule.[13] This places the second party in the difficult position of being forced to prophesy at the pleading stage what evidence will be introduced by the other party at the trial stage.

It is not surprising that this result was reached by a court inexperienced in the law of patents, because "file wrapper estoppel" is a misnomer. It lacks one of the essential elements of a true estoppel, *viz.*, a *right* possessed by one who is precluded from asserting it because of prior conduct inconsistent therewith. In a suit for patent infringement the issue is one of scope of the patent grant. Where file wrapper estoppel operates against the patentee the alleged patent right, to that extent, is simply nonexistent. In such a case, invoking an estoppel as such against the patentee is unnecessary to bar recovery

[12] Zip Mfg. Co. v. Pusch, 2 F.(2d) 828 (C.C.A. 8th 1924), Benze v. Celeste, 136 F.(2d) 845 (C.C.A. 2d 1943).

[13] The court denied respondents' petition for rehearing based upon this ground. The argument that file wrapper estoppel is not like true estoppel and is not by nature an affirmative defense was likewise rejected.