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ARTICLES

PATENTLY IRRELEVANT? USE OF FOREIGN PROSECUTION HISTORY AS EXTRINSIC EVIDENCE DURING LITIGATION OF A COUNTERPART U.S. PATENT

*Elizabeth Cowan Wright**

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“It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.”¹

I. INTRODUCTION

It is a well-known proposition that foreign decisions relating to patentability have no bearing on U.S. patentability. For this reason, the prosecution history of a foreign patent may not be relevant to a patent infringement suit of a counterpart U.S. patent. Despite its potential irrelevance, some courts will admit evidence from a foreign prosecution history during litigation of a counterpart U.S. patent. Courts generally admit evidence from a foreign prosecution history in one of two contexts. Such evidence is either admitted during claim construction or when a court is considering the scope of equivalents available to a patentee.

This Article summarizes decisions in which the admissibility of evidence from a foreign prosecution history was at issue during litigation of a counterpart U.S. patent. Subsequently, it then discusses when the use of a foreign prosecution history is appropriate during claim construction and when it is appropriate during analysis under the doctrine of equivalents, what components of the foreign prosecution history should be used, and how much weight the evidence should be given. Specifically, this Article discusses how evidence from a foreign prosecution history can properly be used as extrinsic evidence, when necessary, during claim construction and infringement analysis under the doctrine of equivalents.

II. BACKGROUND

Patents are generally territorial in nature in that a sovereign state grants a patent and enforces that patent within the state's boundaries.² The legal standards of patentability vary from country to country, which means an invention may be patentable in one country but not in another.³ These

1. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983).

2. See 35 U.S.C. § 271(a) (2004) (“[W]hoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”); Christopher D. DeCluitt, *International Patent Prosecution, Litigation and Enforcement*, 5 TULSA J. COMP. & INT'L L. 135, 136 (1997).

3. While all patent systems require novelty, obviousness or inventiveness, and utility or industrial applicability, these requirements are defined differently from country to country.

varying legal standards of patentability are typically referenced by U.S. courts when finding that a judgment of patent validity in a foreign country is irrelevant to the validity of a counterpart U.S. patent.⁴

These varying legal standards are also referenced in support of the proposition that the prosecution history of a foreign patent should not be admissible when litigating its counterpart U.S. patent under the doctrine of equivalents or during claim construction.⁵ The reasoning behind this argument is that the varying legal standards of patentability may make the foreign prosecution history irrelevant to litigation of the U.S. patent because the representations and amendments may have been made for a reason irrelevant to U.S. patentability.⁶ The statements may therefore be prejudicial.⁷

Despite these concerns, courts have found it appropriate to admit foreign prosecution histories for a variety of reasons. The cases generally fall into one of two categories: a court allows the use of foreign prosecution history during claim construction⁸ or a court allows the use of foreign prosecution history to estop a patentee from relying on the doctrine of equivalents.⁹ In all of these cases, the evidence considered from the

DeCluitt, *supra* note 2, at 138. For example, some countries require absolute novelty while others require relative novelty. *Id.* at 139.

4. See, e.g., *Medtronic, Inc. v. Daig Corp.*, 789 F.2d 903, 907-08 (Fed. Cir. 1986); *In re Dulberg*, 472 F.2d 1394, 1398 (C.C.P.A. 1973); *In re Guinot*, 76 F.2d 134, 135-36 (C.C.P.A. 1935).

5. See, e.g., *TI Group Auto. Sys., Inc. v. VDO N. Am., L.L.C.*, 375 F.3d 1126, 1136 (Fed. Cir. 2004); *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983); Mary S. Consalvi, *Objective Indicia of Equivalence and Nonequivalence—An Update*, 573 PLI/PAT 171, 208 (1999); John R. Thomas, *Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement*, 27 LAW & POL'Y INT'L BUS. 277, 310 (1996).

6. See Consalvi, *supra* note 5, at 208-09.

7. See *id.*

8. See generally, e.g., *AK Steel Corp. v. Sollac & Ugine*, 234 F. Supp. 2d 711, 770 (S.D. Ohio 2002); *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, No. 94 CIV. 6296 (WHP), 2002 WL 10479, at *9 (S.D.N.Y. Jan. 3, 2002); *Liposome Co. v. Vestar, Inc.*, CIV.A.92-332-RRM, 1994 WL 738952 (D. Del. Dec. 20, 1994).

9. See generally, e.g., *Tanabe Seiyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 733 (Fed. Cir.), *cert. denied*, 522 U.S. 1027 (1997); *Caterpillar Tractor Co.*, 714 F.2d at 1116; *Merck & Co., Inc. v. Mylan Pharm., Inc.*, 19 F. Supp. 2d 334, 344 n.17 (E.D. Pa. 1998); see also *Rixon, Inc. v. Racal-Milgo, Inc.*, 551 F. Supp. 163, 179 (D. Del. 1982) (noting that patentee was precluded from resorting to an equivalent disclaimed in a communication to the German Patent Office during an earlier patent suit in Kansas, but declining to hold the patent unenforceable for this conduct). One court compelled production of a defendant's abandoned Dutch application in a patent infringement suit despite the fact that the abandoned application would normally be confidential. *Ares-Serono, Inc. v. Organon Int'l B.V.*, 160 F.R.D. 1, *4 (D. Mass. 1994). The abandoned application was directed to the same biologically active human fertility follicle stimulating hormone that was at issue in the U.S. patent infringement suit. *Id.* at *3-*4. The district court found that the

foreign prosecution history was limited to representations made by the patentee to the foreign patent office. Claim amendments made during foreign patent prosecution have not been considered in either context.

Although courts allow such evidence, the effect of its admission is limited by the existing U.S. law regarding claim construction and prosecution history estoppel. While representations made to foreign patent offices have been admitted and even considered by courts, they have not been used to contradict the ordinary meaning of a claim term during claim construction, nor used as the sole basis for limiting the scope of equivalents available to a patentee. To date, no patent infringement case has turned upon the use of a counterpart patent's foreign prosecution history.

III. USE OF FOREIGN PROSECUTION HISTORY DURING U.S. LITIGATION

A. *Foreign Prosecution History and Claim Construction*

Several courts have allowed the use of representations made during prosecution of a foreign patent to aid in the claim construction of a counterpart U.S. patent. The use of these representations is usually justified because the representations provide insight into how a person of ordinary skill in the art would view the claim term at issue.

1. Claim Construction

Determining whether a patent is infringed is a two-step process.¹⁰ The first step is claim construction, or determining the meaning and scope of the patent claims.¹¹ Claim construction is a matter of law.¹² The second step is comparing the properly construed claims to the device accused of infringement.¹³ This is a question of fact for the jury.¹⁴

Dutch application was "arguably relevant." *Id.* at *4. It applied a balancing test and found that the necessity for disclosure outweighed the desirability of maintaining the secrecy of the material in the prosecution history, particularly given the protective order existing in the case. *Id.* However, the fact that the defendants waived confidentiality by allowing the plaintiffs to view the document was more critical than the relevance of the application. *Id.*

10. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

11. *Id.*

12. *Id.* at 384, 391.

13. *Id.* at 384.

14. *Id.*

Claim construction begins with an examination of the words of the claims.¹⁵ There is a strong presumption that the claim terms maintain their ordinary meaning as viewed by one of ordinary skill in the art.¹⁶ Dictionary definitions may be consulted to establish a claim term's ordinary meaning.¹⁷ Words in a claim maintain their ordinary meaning unless a patentee chooses to be her own lexicographer and uses the terms in a manner other than their ordinary meaning.¹⁸ In this case, the definition of the term must be clearly stated in the patent specification or in the prosecution history.¹⁹ Not only is the specification used to determine whether the patentee assigned a meaning to a term other than its ordinary meaning, but it is also relevant to the claim construction analysis.²⁰ The prosecution history may also be used to aid in claim construction after consideration of ordinary meaning and specification.²¹

A court may consider extrinsic evidence in addition to the intrinsic evidence of the claims, specification, and prosecution history.²² It is appropriate, and sometimes "preferable," for a court to consult reliable extrinsic evidence to determine whether a potential claim construction is veering away from "clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field."²³ Extrinsic evidence may be useful to aid the judge in interpreting the claims from the viewpoint of one skilled in the art.²⁴ Reliance on extrinsic evidence, however, is improper unless the meaning of the claim terms remains ambiguous after consideration of the intrinsic evidence.²⁵ If the meaning of the terms is clear and unambiguous, extrinsic evidence may not be used to vary or contradict that clear meaning.²⁶

Thus, there is a clear order to the claim construction process that prioritizes intrinsic evidence. First, the words of the claims are given their ordinary meaning as viewed by one of ordinary skill in the art, unless the patentee has otherwise clearly defined the terms in the specification or

15. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

16. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).

17. *Id.*

18. *Vitronics*, 90 F.3d at 1582.

19. *Id.*

20. *Id.*

21. *Id.*

22. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999).

23. *Id.* at 1309.

24. *Id.*

25. *Vitronics*, 90 F.3d at 1583.

26. *Id.*

prosecution history.²⁷ The specification must be considered for this analysis.²⁸ The prosecution history may also be considered after the specification.²⁹ Finally, extrinsic evidence may be considered to determine if the proposed claim construction is consistent with the understanding of one of skill in the art.³⁰ The extrinsic evidence may not vary the meaning unless the meaning is ambiguous after considering the intrinsic evidence.³¹

2. Decisions in Which Evidence from a Foreign Prosecution History was Admitted to Aid in Claim Construction

In *Liposome Co. v. Vestar, Inc.*, the District of Delaware allowed the use of representations made to a foreign patent office during claim construction.³² The Liposome Co. (TLC) sued Vestar, Inc. (Vestar) for infringement of U.S. Patent No. 4,880,365, a process for the dehydration of a colloidal dispersion of liposomes.³³ One of the claim terms at issue during claim construction was “mixing a hydrophilic compound with the colloidal dispersion of the liposomes.”³⁴ Vestar asserted that it did not infringe the patent because it did not mix a hydrophilic solution with liposomes but rather mixed a hydrophilic compound with lipids and amphotericin B at the time it formed the liposomes.³⁵ During the claim construction phase, TLC argued that “mixing” should be construed as including adding liposomes to a hydrophilic compound, or adding a hydrophilic compound to liposomes, or making liposomes in a hydrophilic compound, as long as there was a mixture prior to dehydration.³⁶

Vestar sought a claim construction of the word “mixing” that meant the hydrophilic compound was mixed with liposomes by adding the

27. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).

28. *Vitronics*, 90 F.3d at 1582.

29. *Id.*

30. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999).

31. *Id.* While the order and method of consideration of the intrinsic evidence may be altered by the Federal Circuit’s eventual decision in *Phillips v. AWH Corp.*, petition to rehear *en banc* granted in 376 F.3d 1382 (Fed. Cir. 2004), it is probable that extrinsic evidence will remain a last resort during claim construction. When a patent issues, the public is on notice as to the claims, and the intrinsic evidence is fixed and available to the public, whereas extrinsic evidence may not be available. *Texas Digital*, 308 F.3d at 1202-03.

32. See *Liposome Co. v. Vestar, Inc.*, CIV.A.92-332-RRM, 1994 WL 738952, at *9-*10 (D. Del. Dec. 20, 1994). A liposome is a microscopic sphere or vesicle in which the membrane surrounds an aqueous solution. *Id.* at *1.

33. *Id.* at *1.

34. *Id.* at *13.

35. *Id.* at *12.

36. *Id.*

hydrophilic compound to a colloidal dispersion of liposomes.³⁷ According to Vestar, this would result in the hydrophilic compound existing only on the outside of the liposomes.³⁸ Vestar argued that while prosecuting a European counterpart to U.S. Patent No. 4,880,635, directed at the same technology as the patent at issue, TLC read the claim language as meaning adding the hydrophilic compound to liposomes.³⁹ Based on these inconsistent statements, Vestar sought to have TLC judicially estopped from obtaining relief in the infringement suit.⁴⁰

The district court rejected the notion that the inconsistent statements could be used under the doctrine of judicial estoppel to prevent TLC from arguing a construction of “mixing” that excluded “adding” because Vestar could show no reliance on the statements made to the European Patent Office (EPO).⁴¹ The district court instead found that these statements to the EPO provided some evidence of how one skilled in the art would read the words of the patent.⁴² The district court also agreed that the statements could be relevant to show how TLC read the words of the claim at issue when TLC was not seeking to enforce the claim in a court of law.⁴³ It found that the claim term described a compound that was mixed with existing liposomes, not with lipids that formed liposomes.⁴⁴ The district court based its decision primarily on the ordinary meaning of the “simple and straight-forward” words in the claim, finding the prior statements describing the claim “provid[ed] further evidence.”⁴⁵

The Southern District of New York also admitted statements made to a foreign patent office during claim construction in a patent infringement case involving U.S. Patent No. 4,135,202 for broadcasting systems with

37. *Liposome Co.*, 1994 WL 738952, at *12.

38. *Id.* at *13.

39. *Id.* at *14.

40. *Id.*

41. *Id.* (citing *Allen v. Zurich Ins. Co.*, 667 F.2d 1162, 1166 (4th Cir. 1982); *Hybritech Inc. v. Abbott Lab.*, 849 F.2d 1446, 1453-54 (Fed. Cir. 1988)); *but see Gallant v. Telebrands Corp.*, 35 F. Supp. 2d 378 (D.N.J. 1998). The *Gallant* court refused to let a patentee take a position in a U.S. patent infringement suit that was contrary to a position taken before the EPO, reasoning, “[t]he Plaintiffs, through their admissions to the European Patent Office, conceded the irrelevance of the Quadraflex as prior art to Telebrands. The Plaintiffs cannot now assume a contrary position.” *Id.* at 400 (citing *Tanabe Seiyaku Co. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 733 (Fed. Cir.), *cert. denied*, 522 U.S. 1027 (1997); *Merck & Co. v. Mylan Pharm., Inc.*, 19 F. Supp. 2d 334, 344 n.17 (E.D. Pa. 1998); *Glaxo Wellcome, Inc. v. Pharmadyne Corp.*, 32 F. Supp. 2d 265, 290 (D. Md. 1998)).

42. *Liposome Co.*, 1994 WL 738952, at *14.

43. *Id.*

44. *Id.* at *15.

45. *Id.*

fiber optic transmission lines.⁴⁶ One term at issue during claim construction was “high frequency.”⁴⁷ Defendants, UA-Columbia Cablevision of Westchester, Inc. and Tele-Communications, Inc. (collectively UA), asserted that “high frequency” must be limited to a range of 2 to 30 MHz.⁴⁸ One of their arguments in support of this assertion was that the inventor told the Canadian Patent Office (CPO) during prosecution of a Canadian counterpart patent that “high frequency” was limited to this range.⁴⁹ Plaintiff, Intellectual Property Development, Inc. (IPDI), argued that “high frequency” should be construed as a range between 54 to 216 MHz.⁵⁰

The defendants’ expert testified during claim construction that at the time of the patent application, no conventional television receivers in the United States operated in the range of 2 to 30 MHz.⁵¹ Other evidence suggested that the standard frequency for television receivers in the United States operated in the VHF range of 30 to 300 MHz.⁵² Judge Sotomayor found the use of the term “conventional television receiver” in the claim gave context and meaning to the term “high frequency,” and therefore she construed it as operating at least in a range of 54 to 216 MHz.⁵³ She noted that statements in foreign counterpart prosecution histories may be relevant to the state of the art at the time of patent application, but could not be used to change a natural reading and understanding of a claim in a patent.⁵⁴

After the *Markman* hearing, the case was reassigned to another judge after Judge Sotomayor was elevated to the U.S. Court of Appeals for the Second Circuit.⁵⁵ The action was transferred to a multi-district litigation

46. *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, No. 94 CIV. 6296 (SS), 1998 WL 142346 (S.D.N.Y. Mar. 26, 1998).

47. *Id.* at *3-4.

48. *Id.* at *5.

49. *Id.* The other reason was that the inventor’s employer, Rediffusion Companies (Rediffusion), treated the patent as limited to this range. *Id.*

50. *Id.* This range falls within the Very High Frequency range (VHF) of 30 to 300 MHz. *Id.* at *8.

51. *Intellectual Prop. Dev.*, 1998 WL 142346, at *8.

52. *Id.*

53. *Id.*

54. *Id.* at *10 (citing *Tanabe Seiyaku Co. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726 (Fed. Cir.), *cert. denied*, 522 U.S. 1027 (1997); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980-81 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370 (1996)). Even though Rediffusion acted as though the patent covered the 3 to 30 MHz range, and Cutler informed the CPO that 3 to 30 MHz was the range meant by “high frequency,” Judge Sotomayor found that the meaning assigned to the term by those of ordinary skill in the art controlled. *Id.* at *8.

55. *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, No. 94 CIV. 6296 (WHP), 2002 WL 10479, at *1 (S.D.N.Y. Jan. 3, 2002)

consolidation in the Central District of California and then remanded back to the Southern District of New York.⁵⁶ After the remand, UA moved for reconsideration of the *Markman* hearing in light of the discovery of new documents relevant to the prosecution history and the Federal Circuit's decisions in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabuskiki Co.* and *Pitney Bowes, Inc. v. Hewlett-Packard Co.*⁵⁷ The district court granted the motion, noting that the claim construction had occurred before the parties completed their discovery.⁵⁸

The district court reversed the original construction of the term "high frequency."⁵⁹ The patentee had amended its first claim to include a range of 40 to 300 MHz, but was forced to retract the amendment because the specification could not support it.⁶⁰ Furthermore, new extrinsic evidence showed that the patentee had told its British patent agent that the range was 3 to 30 MHz.⁶¹ The patentee had also distinguished its patent from the prior art based on a frequency range of 3 to 30 MHz.⁶² The district court found that "high frequency" meant a range of 3 to 30 MHz, after considering these factors in light of the Federal Circuit decision in *Pitney Bowes*.⁶³

In *AK Steel Corp. v. Sollac & Ugine*,⁶⁴ the Southern District of Ohio considered whether statements to the EPO defining the term "consisting essentially of aluminum" during patent prosecution should apply to the claim construction of the same term in counterpart U.S. Patent No. 4,765,214 for a method of coating stainless steel. In the statements to the EPO, the patentee defined the term as permitting "the presence of certain elements or impurities in the coating metal of the aluminum bath such as up to 2% iron but on the other hand, silicon contents in the coating metal should not exceed about .5% by weight."⁶⁵ While noting that the term "consisting essentially of" has a special meaning in U.S. claim drafting, which made the European interpretation of the term "of little relevance," the district court agreed that the representations to the EPO should be

56. *Id.*

57. *Id.* at *4.

58. *See id.* at *5.

59. *Id.* at *13.

60. *Intellectual Prop. Dev.*, 2002 WL 10479, at *11.

61. *Id.* at *12.

62. *Id.* at *10.

63. *Id.* at *10-13. The district court did not consider the Federal Circuit's decision in *Festo* to be relevant to this analysis, since *Festo* dealt with prosecution history estoppel, not claim construction. *Id.* at *6.

64. 234 F. Supp. 2d 711 (S.D. Ohio 2002).

65. *Id.* at 770.

considered when “they comprise relevant evidence and are relevant to claim construction of United States patents.”⁶⁶

Judges have also denied motions to exclude evidence from foreign prosecution histories during patent infringement litigations. In *In re Certain Sortation Systems*, the Administrative Law Judge (ALJ) denied a motion to exclude the prosecution history of a European patent that was a counterpart to U.S. Patent No. 5,127,510 for a modular diverter shoe and slat construction, during the initial determination phase of a U.S. International Trade Commission (Commission) investigation.⁶⁷ The patent assignee, Rapistan Systems, and exclusive licensee, Siemens Dematic, (collectively Complainants) alleged Vanderlande Industries Nederland BV and Vanderlande Industries (collectively Respondents) infringed the patent by their manufacture and importation of certain sortation systems.⁶⁸

The Complainants moved to exclude the prosecution history of a counterpart European patent as irrelevant because it was not prior art to the U.S. patent at issue.⁶⁹ The Respondents argued that statements to the EPO during prosecution of this European counterpart were relevant to the obviousness of the system and to the development timing of the sortation system.⁷⁰ The Commission Investigative Staff argued that the statements to the EPO were relevant to claim construction of the U.S. patent.⁷¹ The ALJ denied the motion to exclude the foreign prosecution history, agreeing with the Staff and the Respondents that the prosecution history was relevant to the validity and the claim construction of the patent at issue.⁷² The ALJ noted that the Federal Circuit had not yet ruled on the issue of using foreign prosecution histories for claim construction, but had approved of their use when they comprise relevant evidence for analysis under the doctrine of equivalents.⁷³

66. *Id.* at 769-70 (citing *Tanabe Seiyaku Co. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 933 (Fed. Cir. 1997); *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983)). The representation to the EPO agreed with the special meaning assigned to the term by U.S. patent practice. *Id.* at 770.

67. *In re Certain Sortation Sys.*, U.S.I.T.C. Inv. No. 337-TA-460, 2002 WL 1492633, Admin. Law Judge Order No. 36 (June 3, 2002).

68. *In re Certain Sortation Sys.*, U.S.I.T.C., Inv. No. 337-TA-460, 2002 WL 1492665, Notice of Violation (Mar. 2003).

69. *Certain Sortation Sys.*, 2002 WL 1492633.

70. *Id.*

71. *Id.*

72. *Id.*

73. *Id.* (citing *Tanabe Seiyaku Co. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 933 (Fed. Cir. 1997); *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983)). In 2004, the Federal Circuit cautioned that the varying legal standards of patentability from country to country might make consideration of certain representations inappropriate, but did not rule out use of these

The Northern District of Illinois compelled production of communications to foreign patent agents in *Baxter Travenol Laboratories, Inc. v. Abbot Laboratories*.⁷⁴ Even if the communications themselves were inadmissible as protected by the attorney-client privilege, the district court compelled production because the communications might lead to the production of admissible evidence relevant to the claim construction or the validity of the U.S. patent.⁷⁵ The district court noted that the varying standards of patentability from country to country meant the granting of a foreign patent was not evidence of non-obviousness, but held that when such instructions to foreign patent agents and representations to foreign patent offices are relevant to the construction or validity of a U.S. patent, they must be considered.⁷⁶

3. Decisions in Which Evidence from a Foreign Prosecution History was not Used to Aid in Claim Construction

Not all courts wholeheartedly approve of using foreign prosecution histories during claim construction. For example, the Federal Circuit noted in *TI Group Automotive Systems v. VDO North America, L.L.C.* that “the varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representations inappropriate’ for consideration in a claim construction analysis of a United States counterpart.”⁷⁷ The Federal Circuit based its affirmation of the district court’s claim construction on the dictionary definitions of the term, and declined to comment on the alleged infringer’s arguments that statements made by the patentee during prosecution of the Japanese counterpart supported the district court’s construction.⁷⁸ The Federal Circuit did not, however, completely rule out using representations made to foreign patent offices in the claim construction context.⁷⁹

representations. *TI Group Auto. Sys. v. VDO N. Am.*, 375 F.3d 1126, 1136 (Fed. Cir. 2004); see *infra* Part III.A.3.

74. *Baxter Travenol Labs., Inc. v. Abbot Labs.*, No. 84 C 5103, 1987 WL 12919 (N.D. Ill. June 19, 1987).

75. *Id.* at *7.

76. *Id.* (citing *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983); FED. R. CIV. P. 26(b)(1)). Whether the documents were protected by the attorney client privilege depended on the laws of the foreign country. *Id.* at *8.

77. *TI Group Auto. Sys.*, 375 F.3d at 1136 (quoting *Caterpillar Tractor Co.*, 714 F.2d at 1116).

78. *Id.*

79. *Id.*

The Southern District of New York ruled in *Astra Aktiebolag v. Andrx Pharmaceuticals, Inc.*⁸⁰ that foreign prosecution histories were inadmissible during claim construction. The district court rejected the use of foreign prosecution histories during claim construction for two reasons.⁸¹ First, the defendants had “not even tried to lay a foundation for its argument that foreign prosecutions should be considered on an issue of United States law. . . .”⁸² Furthermore, while conceding that a foreign prosecution history might be relevant to an infringement analysis under the doctrine of equivalents, the district court distinguished claim construction from such an analysis because the doctrine of equivalents is a question of fact and claim construction is a matter of law.⁸³

4. Proper Use of a Foreign Prosecution History During Claim Construction of a Counterpart U.S. Patent

The claim construction process allows consideration of extrinsic evidence to ensure a potential claim construction is consistent with the understanding of one of skill in the art.⁸⁴ Extrinsic evidence may only be relied upon if the meaning of the claims is still ambiguous after consideration of all intrinsic evidence, including the words of the claims themselves, the specification and the prosecution history.⁸⁵ If extrinsic evidence must be considered to resolve the meanings of the claim terms, it is reasonable to consider representations made to foreign patent offices as extrinsic evidence, in addition to other extrinsic evidence such as expert testimony. As many courts have noted, these representations can give insight not only into the inventor’s meaning of the claim terms at the time of application but, more importantly, insight into how a person of ordinary skill in the art would view the terms.⁸⁶ If made prior to the patent litigation

80. 222 F. Supp. 2d 423, 466 (S.D.N.Y. 2002).

81. *Id.*

82. *Id.* (citing *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods. Inc.*, 21 F.3d 1068, 1072 n.2 (Fed. Cir. 1994); *Medtronic, Inc. v. Daig Corp.*, 789 F.2d 903, 907-08 (Fed. Cir. 1986)).

83. *Id.* (citing *Tanabe Seiyaku Co. v. U.S. Int’l Trade Comm’n*, 109 F.3d 726, 933 (Fed. Cir. 1997); *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983)). *See infra* Part III.B (discussing the use of foreign prosecution histories during an infringement analysis under the doctrine of equivalents). The district court also noted that the representations to foreign patent offices failed to support the defendant’s position. *Astra Aktiebolag*, 222 F. Supp. 2d at 466.

84. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999).

85. *Vitronics Corp. v. Conceptronc, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

86. *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, No. 94 CIV. 6296 (WHP), 2002 WL 10479 (S.D.N.Y. Jan. 3, 2002); *Liposome Co., Inc. v. Vestar, Inc.*, CIV.A.92-332-RRM, 1994 WL 738952 (D. Del. Dec. 20, 1994).

and during the time period of the U.S. application, the statements made during foreign patent prosecution may even provide a more balanced view of the state of the art than expert testimony at trial.

One question that remains is what aspects of the foreign prosecution history should be considered during litigation of a counterpart U.S. patent. To date, courts have only used representations from a foreign prosecution history. This trend should continue. Representations made to foreign patent offices during patent prosecution are more easily interpreted by a court than amendments made during the foreign prosecution process. Furthermore, an inquiry into a response from a foreign examiner may be less related to a foreign standard of patentability than an amendment to satisfy the foreign standards of patentability. For this reason, while representations made by the patentee could be considered during claim construction of a counterpart U.S. patent, foreign amendments should rarely, if ever, be considered.

Courts have not allowed representations made to foreign patent offices to override the clear and unambiguous meaning of a claim term. Rather, they have been treated as yet another piece of extrinsic evidence. If the proper claim construction process is followed, representations made to foreign patent offices can be used as extrinsic evidence to verify a claim construction. They can also be used as extrinsic evidence (in addition to other extrinsic evidence such as expert testimony) when the claim terms are still ambiguous. As long as a court keeps in mind that the representations made to a foreign patent office may be unrelated to the patentability of the invention in the United States, the representations may aid in claim construction.

B. Foreign Prosecution History and Prosecution History Estoppel

Representations made to foreign patent offices during foreign patent prosecution have also been used to estop a patentee from relying on the doctrine of equivalents during litigation of a counterpart U.S. patent.

1. The Doctrine of Equivalents and Prosecution History Estoppel

The doctrine of equivalents is a judicially created doctrine providing that the scope of a patent is not limited to its literal terms, but instead embraces all equivalents to the claims.⁸⁷ The purpose of the doctrine of equivalents is to protect a patent holder against copyists attempting to

87. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002) (citing *Winans v. Denmead*, 56 U.S. (15 How.) 330, 347 (1854)).

escape liability for infringement by making only insubstantial changes to a patented invention.⁸⁸ The premise underlying the doctrine is that it is impossible for language to capture every nuance of a patent or describe its scope with complete precision.⁸⁹

Because the doctrine of equivalents renders the scope of a patent less clear than the literal scope of the patent, courts use the doctrine of prosecution history estoppel as a check on the doctrine of equivalents.⁹⁰ Prosecution history estoppel, or file wrapper estoppel, is the requirement that claims of a patent be interpreted in light of the proceedings in the U.S. Patent and Trademark Office (USPTO) during the application process.⁹¹ The doctrine prevents a patentee from recapturing subject matter surrendered during patent prosecution in a subsequent litigation proceeding.⁹² It prevents a patentee who narrowed the scope of her coverage during patent prosecution from reclaiming the disclaimed subject matter as an equivalent.⁹³ Whether prosecution history applies to an equivalent is a matter of law.⁹⁴

If the patentee makes a narrowing amendment to satisfy any provision of the Patent Act, a presumption arises that the patentee surrendered all territory between the original claim limitation and the amended claim limitation.⁹⁵ The patentee may rebut this presumption of complete surrender by showing it did not surrender the particular equivalent in question in one of three ways.⁹⁶ The patentee may show that the equivalent was unforeseeable at the time of the amendment, that the reason for the amendment was only tangentially related to the equivalent in question, or that for "some other reason," the patentee could not have described the

88. *Festo*, 535 U.S. at 726.

89. *Id.* at 731.

90. *Id.* at 727, 733-34; AM. JUR. *Patents* § 789 (2004) ("File wrapper or prosecution history estoppel, if established, supersedes or limits a patentee's reliance on the doctrine of equivalents. Thus, prosecution history estoppel is a legal limitation on the doctrine of equivalents."). The doctrine of equivalents, by expanding the coverage of the patent beyond its literal claims, makes it difficult for competitors to determine what will infringe an invention and what is a non-infringing alternative. *Festo*, 535 U.S. at 727.

91. *Festo*, 535 U.S. at 733.

92. *Id.* at 734.

93. *Id.*

94. *Smithkline Beecham Corp. v. Excel Pharm., Inc.*, 356 F.3d 1357 (Fed. Cir. 2004).

95. *Festo*, 535 U.S. at 736-38; *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1365 (Fed. Cir. 2003).

96. *Festo*, 535 U.S. at 740-41.

equivalent in question.⁹⁷ If the patentee can rebut this presumption, then prosecution history will not apply to the equivalent.⁹⁸

When determining whether an alleged equivalent was unforeseeable, a court may consider expert testimony and extrinsic evidence.⁹⁹ Proof of a tangential relationship between the reason for amendment and the alleged equivalent is restricted to the prosecution history, except when expert testimony from those skilled in the art is required to interpret that record.¹⁰⁰ Determination of whether there is some other reason why the equivalent could not be described should be restricted to the prosecution history “[w]hen at all possible.”¹⁰¹

2. Decisions in Which Evidence from a Foreign Prosecution History was Used to Limit the Scope of Equivalents

The Federal Circuit first considered the effect of representations made to a foreign patent office on the scope of equivalents available to a patentee in *Caterpillar Tractor Corp. v. Berco, S.p.A.* Caterpillar Tractor Corp. (Caterpillar) held U.S. Patent No. 3,841,718 for a crescent seal for tractors.¹⁰² There was no literal infringement, so Caterpillar had to rely upon the doctrine of equivalents to prove infringement.¹⁰³ Berco S.p.A. (Berco), the alleged infringer, cited representations made by Caterpillar to the Great Britain and German patent offices and to Caterpillar’s foreign associates when prosecuting counterpart applications, as evidence that the equivalent embodiment was not contemplated by Caterpillar.¹⁰⁴

The Federal Circuit noted that no authority was cited for the proposition that instructions to foreign patent counsel and representations to foreign patent offices should be considered.¹⁰⁵ The court also acknowledged that varying legal and procedural requirements for obtaining patents in foreign countries may render consideration of certain types of representations inappropriate.¹⁰⁶ Despite these caveats, the Federal Circuit held that when such matters “comprise relevant evidence they must

97. *Id.*

98. *Id.*

99. *Festo*, 344 F.3d at 1369.

100. *Id.* at 1369-70.

101. *Id.* at 1370.

102. *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1111-12 (Fed. Cir. 1983).

103. *Id.* at 1115.

104. *Id.* at 1116.

105. *Id.*

106. *Id.*

be considered."¹⁰⁷ Even though the representations showed that the equivalent embodiment had not been considered at the time the application was filed, this was not a basis for denying application of the doctrine of equivalents.¹⁰⁸

The U.S. International Trade Commission considered representations made to foreign patent offices in a later case involving infringement of U.S. Patent No. 4,438,035 for a process for producing diltiazem hydrochloride held by Tanabe Seiyaku Co. (Tanabe).¹⁰⁹ The patent recited a chemical reaction known as an "N-alkylation" reaction to be performed in the presence of a base-solvent combination.¹¹⁰ Five specific base-solvent combinations were disclosed in the patent and recited in the claim at issue.¹¹¹ The alleged infringer was using a solvent not recited in the patent, forcing Tanabe to rely upon the doctrine of equivalents at trial.¹¹²

During the application process before the USPTO, Tanabe had distinguished its patent from the prior art by claiming that the five base-solvent combinations provided high yields under safe and economical conditions.¹¹³ When prosecuting counterparts to the patent in Finland, Israel, and before the EPO, Tanabe also argued that its process was patentable because the five base-solvent combinations gave unexpectedly better results than other combinations.¹¹⁴ Based on the claim language and the statements to foreign patent offices, the Commission found no infringement under the doctrine of equivalents because Tanabe intended to exclude all bases and solvents except those that were particularly claimed, including those that would normally be equivalents.¹¹⁵

On appeal to the Federal Circuit, Tanabe argued that the Commission had erroneously invoked an estoppel against Tanabe regarding the proper range of equivalents based in part upon the statements to the foreign patent

107. *Caterpillar Tractor Co.*, 714 F.2d at 1116 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983)). The *Stratoflex* court said, "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included," when considering evidence of secondary considerations of obviousness. *Stratoflex*, 713 F.2d at 1538.

108. *Caterpillar Tractor Co.*, 714 F.2d at 1116.

109. *Tanabe Seiyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 727 (Fed. Cir. 1997).

110. *Id.* at 729.

111. *Id.*

112. *Id.*

113. *Id.* at 730.

114. *Tanabe Seiyaku Co.*, 109 F.3d at 730.

115. *Id.* at 731.

offices.¹¹⁶ Relying on the decision in *Caterpillar Tractor Co.*, the Federal Circuit held that in evaluating infringement under the doctrine of equivalents, representations to foreign patent offices should be considered when they offer relevant evidence.¹¹⁷ The statements to foreign patent offices that specific combinations of bases and solvents produced better results and distinguishing the prior art based on these results were relevant to the determination of whether a person skilled in the art would consider another solvent interchangeable with the claimed solvents in Tanabe's claimed process.¹¹⁸ In affirming the Commission's finding, the Federal Circuit relied upon the claim language, the U.S. prosecution history, and the statements made to the foreign patent offices.¹¹⁹

In *Merck & Co. v. Mylan Pharmaceuticals, Inc.*, the Eastern District of Pennsylvania found instructions given by Merck & Co. (Merck) to the New Zealand Patent Office during prosecution of a foreign counterpart patent to be "instructive" during analysis under the doctrine of equivalents.¹²⁰ Merck brought an action against Mylan Pharmaceuticals (Mylan) for infringement of two patents for a drug used to treat Parkinson's disease.¹²¹ In response to Merck's infringement action, Mylan argued that the prosecution history of Merck's patents precluded Merck from obtaining coverage of Mylan's generic formulation.¹²² Merck's hypothetical claim,¹²³ developed as the first step in analyzing an asserted limitation on use of the doctrine of equivalents through the prior art, included the element that the claimed oral dosing tablet was nonfloating.¹²⁴ Merck needed the nonfloating element to avoid a prior art restriction on equivalency because the tablets shown in the prior art floated and neither Merck's nor Mylan's formulations floated.¹²⁵

116. *Id.* The court rejected Tanabe's argument that use of such statements constituted a "foreign prosecution [history] estoppel" to limit the application of the doctrine of equivalents. *Id.* at 733.

117. *Id.*

118. *Id.*

119. *Tanabe Seiyaku Co.*, 109 F.3d at 731.

120. *Merck & Co., Inc. v. Mylan Pharm., Inc.*, 19 F. Supp. 2d 334, 344 n.17 (E.D. Pa. 1998).

121. *Id.* at 336.

122. *Id.* at 340-41.

123. *Id.* at 342-43. ("[T]he first step in analyzing an asserted limitation on use of the doctrine of equivalents through the prior art is development of a proper hypothetical claim. Such a hypothetical should be structured to be similar to the patentee's claims, but broad enough to literally cover the accused's device." (citing *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 685 (Fed. Cir. 1990))).

124. *Id.* at 343.

125. *Merck & Co.*, 19 F. Supp. 2d at 341 (citations omitted) ("The prior art restricts the scope of equivalency that the party alleging infringement under the doctrine of equivalents can assert.").

In response, Mylan argued that because neither the Merck nor Mylan formulations placed a limitation on the ability of the tablet to float, the hypothetical claim could not contain a nonfloating limitation.¹²⁶ Merck's prosecution history revealed that Merck never attempted to distinguish prior art by using a floating/nonfloating distinction but instead distinguished the prior art based on the polymers.¹²⁷ Although Merck's statements to the New Zealand Patent Office that distinguished the prior art were not preclusive, the district court considered them "instructive" with regard to the floating/nonfloating limitation and declined to include a nonfloating limitation based on the U.S. prosecution history, the prior art, and the statements made to the New Zealand Patent Office.¹²⁸

3. Proper use of a Foreign Prosecution History During Analysis Under the Doctrine of Equivalents of a Counterpart U.S. Patent

Evidence from the foreign prosecution history can be used in several ways to determine whether prosecution history estoppel applies to the equivalent in question. First, it can be used to determine whether an equivalent was foreseeable at the time of narrowing amendment.¹²⁹ For example, if the patentee seeks to recapture an equivalent that was discussed during foreign patent prosecution, the foreign prosecution history could be used to show that the equivalent was foreseeable at the time of the amendment to the U.S. application.

Presently, the patentee may resort only to the U.S. prosecution history to show that the amendment to the U.S. application was made for a reason only tangentially related to the equivalent in question.¹³⁰ The rationale for this limitation is that the patent itself and its prosecution history, both available to the public, have a public notice function.¹³¹ It would be unfair to allow the public to rely on this available information and then allow the

126. *Id.*

127. *Id.*

128. *Id.* at 244 n.17. Merck did tell the New Zealand Patent Office that the Sheth formulation was designed to float on gastric fluids while their contents were slowly released and that the mechanism that resulted in floating was very different than the Merck mechanism. *Id.* However, Merck chose to restrict the claims by limiting the polymers used and not basing them on the floating/nonfloating distinction. *Id.* The district court found this decision suggested that the nonfloating characteristic was not a restriction on the invention. *Id.* at 345.

129. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1369 (Fed. Cir. 2003) (holding that extrinsic evidence may be considered when determining whether an alleged equivalent was unforeseeable). The time at which the representation was made to the foreign patent office is clearly relevant to this determination.

130. *Id.*

131. *Id.*

patentee to recapture an equivalent by using information not available to the public.¹³²

Expert testimony is allowed, if necessary, to aid in the interpretation of the prosecution history.¹³³ It is also possible that the foreign prosecution history could aid in that interpretation. After all, the use of foreign prosecution history during claim construction has been justified on the grounds that it aids in understanding how a person of ordinary skill in the art would view a claim term.¹³⁴ On the other hand, given the fact that the reason for amendment is likely found in the context which the amendment was made (the U.S. prosecution history), the foreign prosecution history would probably be of little value in this analysis.¹³⁵

Finally, the foreign prosecution history could be used to determine if there was “some other reason” the equivalent could not have been described. While the evidence used in this determination is restricted to the U.S. prosecution history “[w]hen at all possible,” the Federal Circuit has not ruled out the use of other evidence.¹³⁶ As with the issue of foreseeability, the foreign prosecution history could be used to show that the “some other reason” does not exist for the equivalent in question.

There are several reasons why courts should continue to restrict use of a foreign prosecution history to representations made to the foreign patent office when determining the scope of equivalents available to a patentee. First, as in claim construction, clear representations made to foreign patent offices during patent prosecution are more easily interpreted for the purposes of determining the scope of equivalents available than amendments made during the foreign prosecution process.

Claim amendments made in response to a foreign patentability requirement also may not be relevant to the equivalent at issue. It is certainly a more daunting proposition to evaluate amendments made to foreign patent applications and determine if the amendment was made for a reason related to the foreign standard of patentability, a U.S. standard of patentability, or the standards of both countries, compared to evaluating a statement by a patentee. Even if the reason for amendment was applicable to a U.S. standard of patentability, should the patentee still lose access to that equivalent if the amendment was not made to obtain the U.S.

132. *Id.*

133. *Id.*

134. *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 2002 WL 10479 (S.D.N.Y. Jan. 3, 2002); *Liposome Co. v. Vestar, Inc.*, 1994 WL 738952 (D. Del. Dec. 20, 1994).

135. *Festo*, 344 F.3d at 1369.

136. *Id.*

patent? Such an analysis could give rise to a doctrine of foreign prosecution history estoppel rejected by the Federal Circuit in *Tanabe Seiyaku Co.*¹³⁷ For these reasons, amendments to foreign patent applications should rarely, if ever, be considered when determining the scope of equivalents available to a patentee.

IV. CONCLUSION

Concerns about the varying standards of patentability from country to country have prevented some courts from admitting evidence from a foreign patent's prosecution history during the litigation of a counterpart U.S. patent. These concerns, while valid, should not result in a wholesale refusal to admit such evidence. Representations made by the patentee during the application process can be relevant to the issues of claim construction of the U.S. patent and the scope of equivalents available to the patentee. Amendments made to the foreign patent, however, should be used cautiously, if ever, because they are not as clear than statements made by the patentee to the foreign patent office. Amendments may also be more likely to have been made in response to a foreign standard of patentability. Furthermore, use of such amendments runs close to a doctrine of "foreign prosecution estoppel" rejected by the Federal Circuit.

Representations made to foreign patent offices can be used as extrinsic evidence during claim construction. When these representations are restricted to their proper place as extrinsic evidence, they can aid in claim construction. They can be used to ensure the proposed construction is consistent with the understanding of one skilled in the art. The representations (and other extrinsic evidence) should only be relied upon when the patent's intrinsic evidence leaves the meaning of the claim terms ambiguous. The representations to foreign patent offices can also be used to determine the scope of equivalents available to a patentee. Such representations may aid a court in determining whether the equivalent at issue was foreseeable at the time of amendment to the U.S. patent, or if there was some other reason the equivalent could not have been described at the time of amendment.

Representations to foreign patent offices during patent prosecution can play a critical role during the claim construction or infringement analysis under the doctrine of equivalents of a counterpart U.S. patent. Courts should consider such representations when they are relevant to the litigation and in a manner consistent with the existing laws of claim

137. *Tanabe Seiyaku Co.*, 109 F.3d 726, 733 (Fed. Cir. 1997).

construction and prosecution history estoppel. By considering representations to foreign patent offices, courts can consider all of the available and relevant evidence to make their determinations.

