

The University of New Hampshire Law Review

Volume 8
Number 2 *Pierce Law Review*

Article 6

February 2010

Controlling Patent Prosecution History

Thomas G. Field Jr.
Franklin Pierce Law Center, Concord, NH

Follow this and additional works at: https://scholars.unh.edu/unh_lr

 Part of the [Intellectual Property Law Commons](#), and the [Technology and Innovation Commons](#)

Repository Citation

Thomas G. Field, Jr. , *Controlling Patent Prosecution History*, 8 *Pierce L. Rev.* 231 (2010), available at http://scholars.unh.edu/unh_lr/vol8/iss2/6

This Comments is brought to you for free and open access by the University of New Hampshire – School of Law at University of New Hampshire Scholars' Repository. It has been accepted for inclusion in The University of New Hampshire Law Review by an authorized editor of University of New Hampshire Scholars' Repository. For more information, please contact ellen.phillips@law.unh.edu.

Controlling Patent Prosecution History

THOMAS G. FIELD, JR.*

One of the most salient effects of patent prosecution history arises in the context of the doctrine of equivalents. Under that doctrine, although patent claims may be found to be broader than their literal scope, territory surrendered during prosecution cannot be encompassed as equivalent.¹ Nor can territory forfeited by initial failure to claim be captured under the doctrine of equivalents.² Most attorneys who prosecute applications are apt to be aware of such problems and to take measures to avoid them.

But prosecution history (or the lack thereof) may cause more difficulty when prior art presented by alleged infringers was not earlier considered. One scenario is presented in *Graham v. John Deere Co. of Kansas City*.³ That opinion is the first to set out the parameters of the nonobviousness requirement first codified in 1952,⁴ but it is equally noteworthy for its treatment of prior art not considered during prosecution.

* Professor of Law, Franklin Pierce Law Center. The author appreciates the comments of Thomas G. Field III, Associate General Counsel – Intellectual Property, Saint-Gobain Corporation, concerning an earlier draft, but the views expressed here should not be attributed to him.

1. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 737, 740–41 (2002) (rejecting a rule that any change in claim language would forfeit territory but putting the burden on patentees to demonstrate otherwise).

2. *See, e.g., Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1107 (Fed. Cir. 1996) (“A patentee may not narrowly claim his invention and then, in the course of an infringement suit, argue that the doctrine of equivalents should permit a finding of infringement because the specification discloses the equivalents. Such a result would merely encourage a patent applicant to present a broad disclosure in the specification of the application and file narrow claims . . .”).

3. 383 U.S. 1 (1966). This opinion addresses the validity of two unrelated patents, each of which had been asserted against unrelated parties. *Id.* at 4–5. Although the Fifth Circuit had found Graham’s patent valid, in the opinion reviewed here, the Eighth Circuit found it invalid. *Id.* at 4. In two other consolidated cases, however, the Eighth Circuit affirmed the validity of a patent held by Cook Chemical Co. *Id.* at 5. This celebrated trilogy finds both patents invalid. *Id.* at 4–5.

4. *Id.* at 17 (construing 35 U.S.C. § 103 (2006)).

The new art at issue was “[a] spring clamp devised, manufactured and sold by Glencoe Manufacturing.”⁵ Comparing that device with Graham’s invention led the Court to say that “all of the elements in the [Graham] patent are present in the Glencoe structure.”⁶ Moreover, the Court stated that “the mechanical operation is identical [and] . . . [t]he mere shifting of the wear point . . . presents no operative mechanical distinctions, much less nonobvious differences.”⁷

With regard to the shifting of the wear point, the Court refused to consider an alleged advantage which Graham “heavily relied on in the courts” because it was not considered during prosecution.⁸ Efforts to have the Court consider the advantage were said to be reminiscent of an earlier case⁹ “where the Court called such an effort ‘an afterthought. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus, it is strange that all mention of it was omitted.’”¹⁰

Had Graham documented any purported advantage of his invention over Glencoe’s device in his specification,¹¹ possibly further supporting it with affidavits,¹² he would surely have fared better. At a minimum, he would not have been precluded from arguing the point in court.¹³

5. *Graham v. John Deere Co. of Kan. City*, 216 F. Supp. 272, 273 (W.D. Mo. 1963), *rev’d*, 333 F.2d 529 (8th Cir. 1964), *aff’d*, 383 U.S. 1 (1966).

6. *Graham*, 383 U.S. at 26.

7. *Id.*

8. *Id.* at 23.

9. *Lincoln Eng’g Co. of Ill. v. Stewart-Warner Corp.*, 303 U.S. 545, 550 (1938).

10. *Graham*, 383 U.S. at 25 (alteration in original) (quoting *Lincoln Eng’g*, 303 U.S. at 550).

11. *See id.* (stating that the alleged advantage was not “a significant feature in the patent”).

12. *See, e.g., In re Carleton*, 599 F.2d 1021, 1026 (C.C.P.A. 1979) (holding that the applicant’s “affidavits, when considered with all of the evidence, are sufficient as a matter of law to rebut the prima facie case of obviousness.”); *see also* U.S. PATENT & TRADEMARK OFFICE, U.S. DEP’T OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 716 (8th ed., rev. 7 2008) [hereinafter MPEP] (affidavits or declarations traversing rejections).

13. *See Graham*, 383 U.S. at 25.

To distinguish the Glencoe device, however, Graham needed to be aware of it.¹⁴ There is no indication that he was.¹⁵ As an applicant perhaps unsure of the value of his invention at the time of filing, he would have had less incentive to conduct an exhaustive prior-art search than did John Deere once his patent threatened exclusion from a seemingly lucrative market.

In a relatively neglected companion case, *United States v. Adams*,¹⁶ however, the patentee successfully overcame challenges based on new art.¹⁷ First, the nearly unanimous Court¹⁸ agreed that Adams's invention was nonobvious because "at the time Adams perfected his [battery,] noted experts expressed disbelief."¹⁹ It was nevertheless eventually adopted for use during World War II.²⁰

Second, although the exact basis for expert skepticism was unclear, unexpected advantages were also helpful in overcoming newly cited prior art.²¹ Perhaps the major advantage of Adams's battery is that water, alone, could serve as an electrolyte.²² In stark contrast with what is said in *Graham*,²³ the Court found:

[Adams's] present reliance upon this feature was not the afterthought of an astute patent trial lawyer. In his first contact with the Government less than a month after the patent appli-

14. *See id.* at 26.

15. *Id.*

16. 383 U.S. 39 (1966).

17. *Id.* at 40.

18. Only Justice White dissented, without opinion. *Id.* at 52. Justice Fortas did not participate. *Id.*

19. *Id.* Such evidence also overcame suggestions that the invention was actually taught in the prior art. *Id.* Unexpected results had been seen before to serve the same ends. *E.g.*, *Eibel Process Co. v. Minn. & Ont. Paper Co.*, 261 U.S. 45, 60 (1923) ("[W]hen we consider the indisputable fact that Eibel's successful experiment . . . surprised the whole paper trade, and that for a short time many held back from risking so radical a change and then all adopted it, oral evidence that some persons had discovered the source of trouble and the means of remedying it some years before Eibel is incredible.").

20. *Adams*, 383 U.S. at 44.

21. *See id.* at 48–49.

22. *Id.* at 48.

23. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 25 (1966) (quoting *Lincoln Eng'g Co. of Ill. v. Stewart-Warner Corp.*, 303 U.S. 545, 550 (1938)); *see supra* notes 8–10 and accompanying text.

cation was filed, Adams pointed out that “no acids, alkalines or any other liquid other than plain water is used in this cell. Water does not have to be distilled.”²⁴

In *Teleflex Inc. v. KSR International Co.*,²⁵ the district court stated that “if Asano had been cited to the Examiner, he would have found the combination of Asano and Smith to be obvious, just as he found [another combination] to be obvious.”²⁶

The Federal Circuit, however, objected to that approach:

[W]here the factual bases of an examiner’s decision to allow a claim have been undermined—as in other cases where prior art not before the examiner is brought to light during litigation—a court’s responsibility is not to speculate what a particular examiner would or would not have done . . . , but rather to assess independently the validity of the claim Such determination must take into account the statutory presumption of patent validity.²⁷

Apparently agreeing more with the district court than the appellate court, the Supreme Court found:

We need not reach the question whether the failure to disclose Asano during the prosecution of Engelgau voids the presumption of validity given to issued patents, for claim 4 is obvious despite the presumption. We nevertheless think it appropriate to note that the rationale underlying the presumption—that the PTO, in its expertise, has approved the claim—seems much diminished here.²⁸

In that respect, observations in the Brief for the United States are also relevant:

24. *Adams*, 383 U.S. at 49. That water need neither be pure nor added prior to use was surely an advantage on the battlefield. *See id.*

25. 298 F. Supp. 2d 581 (E.D. Mich. 2003), *vacated*, 119 F. App’x 282 (Fed. Cir. 2005), *rev’d*, 550 U.S. 398 (2007).

26. *Id.* at 595.

27. *Teleflex, Inc. v. KSR Int’l Co.*, 119 F. App’x 282, 289 (Fed. Cir. 2005) (first alteration in original) (quoting *Torpharm Inc. v. Ranbaxy Pharms., Inc.*, 336 F.3d 1322, 1329–30 (Fed. Cir. 2003)), *rev’d*, 550 U.S. 398 (2007).

28. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 426 (2007).

[T]he prior art—specifically the Asano patent, which respondents had not provided to the PTO—revealed the placement of a mechanical throttle control on an adjustable gas pedal assembly’s support bracket. . . . The district court correctly concluded a person having ordinary skill—in this case, a mechanical engineer familiar with pedal assembly design and presumed to know the prior art—would have recognized the advantage of incorporating an electronic sensor into Asano’s adjustable gas pedal assembly and placing the electronic sensor at the very same location as the mechanical linkage.²⁹

Whether Teleflex was aware of the Asano patent prior to filing the Engelgau application is unknown.³⁰ Unlike much prior art addressed for the first time in litigation,³¹ it was a U.S. patent³² as readily available as anything considered during prosecution. Despite that, however, there would have been no reason for Teleflex to distinguish the prior art in the specification absent apparent relevance in the context of the claimed invention.³³

The Asano patent was also, of course, readily available to the examiner. Were that patent seen as relevant, it should have been found, cited, and applied³⁴ in the first office action.³⁵ It seems peculiar that neither the government’s brief nor any of three court opinions reference the examiner’s fundamental duties, much less consider whether they may have, in fact, been fulfilled.³⁶

29. Brief for the United States as Amicus Curiae Supporting Petitioner at 28–29, *KSR Int’l Co.*, 550 U.S. 398 (No. 04-1350) [hereinafter Brief for the United States].

30. It is not clear whether Teleflex prosecuted the Engelgau patent, but, in line with the suggestion in the government’s amicus brief, that is assumed here. *See id.*

31. *E.g.*, *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 26 (1966) (referencing the Glencoe device); *see supra* note 5 and accompanying text.

32. U.S. Patent No. 5,010,782 (filed July 28, 1989).

33. *See United States v. Adams*, 383 U.S. 39, 49 (1966) (“[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.”).

34. *See* MPEP, *supra* note 12, § 2141.01(a).

35. *See* 35 U.S.C. §§ 132(a), 133 (2006) (indicating that an applicant has six months to respond to a notice of rejection).

36. *See, e.g.*, MPEP, *supra* note 12, § 2141.01(a) (explaining an examiner’s duties regarding analogous and nonanalogous art).

It seems ironic that the Supreme Court finds failure to disclose Asano as diminishing the presumption of validity while crediting the examiner's expertise.³⁷ This is so because a diminished presumption would seem appropriate only if, instead of positing expertise, the Court were to posit incompetence. It is likewise ironic that the government claims that "a person having ordinary skill . . . would have recognized the advantage of incorporating an electronic sensor into Asano's . . . pedal assembly and placing the electronic sensor at the very same location . . ."³⁸

Indeed, if the Court posits examiner competence, the most reasonable inference seems to be that such a person presumably "having ordinary skill"³⁹ in the art was aware of Asano and found it irrelevant—perhaps for reasons advanced by Teleflex to rebut the finding that the Asano patent rendered the claim in question obvious.⁴⁰ Absent documentation to that effect in the prosecution history, however, the Court was free to conclude that "[n]othing in the declarations proffered by Teleflex prevented the District Court from reaching the careful conclusions underlying its order for summary judgment in this case."⁴¹

It may be difficult for others to avoid being in that or a worse situation. Failure to be aware of all prior art at the time of filing, to anticipate arguments that might be advanced, and to rebut them in the specification and during prosecution diminishes the capacity to overcome arguments challenging validity based on obviousness and may entirely foreclose attempts to rebut as in *Graham*.⁴²

Surely, the most difficult task will be to identify and distinguish prior art that may be seen as relevant by persons who lack "ordinary

37. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 426 (2007).

38. Brief for the United States, *supra* note 29, at 29. Moreover, although the Solicitor General was counsel of record, General Counsel for the Department of Commerce and the Deputy General Counsel and PTO Solicitor are credited as authors. *Id.* at I.

39. *Id.* at 29.

40. *KSR Int'l Co.*, 550 U.S. at 423–24 ("In light of Teleflex's failure to raise the argument in a clear fashion, and the silence of the Court of Appeals on the issue, we take the District Court's conclusion on the point to be correct.")

41. *Id.* at 427.

42. *See Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 25–26 (1966).

skill in the art to which said subject matter pertains.”⁴³ Should that be possible, however, it will be hard for courts to find an invention obvious in light of such art and presumably impossible to resolve the issue by summary judgment.

Some firms apparently are reluctant to search lest they later be found to willfully infringe patents that might be discovered.⁴⁴ How much that potential has been diminished by *In re Seagate Technology, LLC*⁴⁵ remains to be seen, but that case signals reduced inclination to uphold findings of willful infringement. Others may regard searching as unnecessary or too expensive.

Regardless of their reasons, those who fail to conduct thorough and thoughtful searches should weigh carefully the risk of invalidity for failure to distinguish arguably relevant prior art during prosecution.

43. 35 U.S.C. § 103(a) (2006).

44. Email from Ann M. McCrackin, Director of the Patent Practice and Procedure Program, Franklin Pierce Law Center, to author (Jan. 27, 2010, 2:24 EST) (on file with Pierce Law Review).

45. 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc).