

**PRESENTATION:**

**A CASE AGAINST USING  
THE DOCTRINE OF EQUIVALENTS  
AND PROSECUTION HISTORY ESTOPPEL**

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I want to open by talking about why we should not have a prosecution history estoppel doctrine. We should not look at prosecution history at all when we interpret claims. I think we need a more fundamental look at why we even consider these preparatory documents when we interpret public instruments.

First, let's take a look at what the court repeatedly says in cases like *Markman*<sup>1</sup> and *Vitronics*.<sup>2</sup> Prosecution history is intrinsic evidence of the meaning of the claims. There are some types of favored extrinsic evidence such as learned treatises and dictionaries, the rest is disfavored extrinsic evidence. The court always has to catch itself, by saying you are supposed to look at the prosecution history as intrinsic evidence if it's of record.

In *Vitronics*, a leading case on prosecution history and claim interpretation, the court talked a lot about the prosecution history and its role in claim interpretation. Fortunately, the prosecutor used the prosecution history, which was not a record in that case. Where was the prosecution history? Where did it go? Was it lost on the way to the court? Did the Federal Circuit not have \$150 and a courier to send to Crystal City to pick it up? Was it one of that small percentage of file-wrappers that gets lost in the warehouse in Maryland? Or when a shelf cracks? What happened? I mean, how can you have intrinsic evidence that comes and goes? Would I be allowed to tear a page out of a patent and present that? Probably not. Let's face it: the prosecution history is not intrinsic evidence. It is distinct from the patent issue itself. We need to think about why we are even looking at it from the perspective of intrinsic evidence.

Let us look at the prosecution history as far as estoppel is concerned. The Federal Circuit says, again and again, that reasonable competitors are entitled to look at the prosecution history in order to interpret the scope of the claims. Obviously, that argument is entirely circular; it's self-referential.

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<sup>1</sup> *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir. 1995)

<sup>2</sup> *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576 (Fed.Cir. 1996)

If we told people that it did not influence the scope of the claims then they wouldn't look at it. I bet the argument is totally naked; there seems to be nothing there, especially when you consider the incredible burden of having to read the prosecution history. How many of us have read a very concise and carefully-drafted patent claim and thought we had to defeat the patent? We'd spend days pouring over episodic documents that seem disconnected and diverse, on a hunt for blatant limitations, somehow submerged within the prosecution history, that would make the claims mean less than what they say they do.

I wonder why we have such fascination in this topic. What is the purpose of pursuing the depths of a prosecution history? When a patent attorney examines something, you are receiving his or her view as to what the claims mean. It is simply a lawyer's opinion about the meaning of the claims. If you read cases, like *Markman* and *Vitronics*, we don't really seem to care very much about the lawyers' opinions of the claims. It is funny that the Official Gazette is published every Tuesday. So if an attorney, during prosecution, makes a statement in front of the examiner on Monday such as, "Oh, that is the source of an estoppel," that is language that is tantamount to claim language itself. But if the arguments are made on Wednesday, during litigation, it's discounted and we don't care about it. It is self-serving. I wonder what happens on Tuesday that is such a "crossing of the Rubicon" of value.

A lot of people say, "Well, I cannot read the patent without the prosecution history. It adds meaning that really helps me to figure out what is going on." Well, I guess more is better in theory, but at some point we need to have some tribute to the shortness of life at the cost of reading. It is a very onerous task and people don't have time for this sort of thing.

Also, I would say that people adding subject matter, during the course of prosecution, that is tantamount to adding claim language itself—it has the same legal effect, so we are violating at least the spirit of the new matter requirement. A new matter is being added in every office action, at least responsive office actions. That is something we have a long-standing policy against. Why are we doing it now? Just because it does not appear in the claim, it does not mean it is as good as the claim language. We are adding it on the fly, as we go. Something is a little bit amiss.

Furthermore, I think that examiners would come to rely on prosecution history. Instead of inserting language into the claims, which is what should be done, it is simply left of record, and that is supposed to be equal or as good. That is bad policy. People should be able to read the Official Gazette and have some idea whether they should go forward. That can't happen now.

Why do we call it prosecution history *estoppel*? Why is it an admission? It is not, is it? For an estoppel, as lawyers we know, you generally have to have reliance. Someone has to rely on the statement. Who is doing the reliance? Is it the accused infringer who said, "Oh wait a second, there is

a prosecution history estoppel.” Maybe if there are cases where someone actually read this and made a design decision based on all that has been said. I can see the strength of all that. But again, if we told them that they did not have to read it, they would not read it. Well, if we told them to read it and they actually did make a decision, I can see that kind of reliance for estoppel. But, of course, in most cases you are just presented it; the patent darkens your door. You are accused of infringement and you’ve designed a product and put it out long before you knew about the patent. You probably did not know anything about the file-wrapper. You probably just read it as part of the litigation, or later when the patent is issued your product pre-exists the patent. Well, how is that an estoppel? Where is the reliance? Maybe the examiners are supposed to be the ones who relied on the prosecution history.

However, we seldom really know what the examiner’s thought. Sometimes we get a reason for allowance, on the notice of allowance, but I am sure some of you know what the form looks like; it is composed of about two lines at the bottom of the form and, thanks to the patent bar, the language usually just tracks the language of the claim, or just states that “all the elements of this claim are material.” If we don’t get a reason in the notice of allowance, all we get is a reason that is like a general jury verdict, just some check bars that they are all allowed. What was relied on? We do not know. Again, just calling it an estoppel is itself improper. It is not an estoppel, it is a different or unusual doctrine.

What is really an unusual about prosecution history estoppel is that it is redundant. We do not need this doctrine to accomplish our ends. Usually, in cases of prosecution history, we are talking about prior art. These arguments apply by analogy to any patentability issue.

So I’m at the patent office and I distinguish some reference, make some comment, that is potentially the source for an estoppel? Who cares? The prior art independently acts against the scope of equivalency under our *Wilson Sporting Goods*<sup>3</sup> doctrine and the *Formstein*<sup>4</sup> principles. The prior art stands itself. We don’t need to have the subjective, possibly erroneous, statement of the applicant controlling anything.

Let us just look objectively at the prior art. Who cares what the applicant says? His opinion does not matter. We are not interested in the intentions of the applicant. What we want to know is what the instrument says, what the *content* of the prior art is. That’s what we should do, rather than taking on some burdensome work. As you can see from this discussion, we are creating wheels within wheels of elaborate doctrine to try to figure out when there is an estoppel. Is it worth it? I would say it is not, and I

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<sup>3</sup> *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677 (Fed.Cir. 1990)

<sup>4</sup> *Formstein*, [1991] RPC 597 (German Federal Supreme Court 1986)

would encourage all of us to think about this. Concentrate on the text, which is ultimately granted, versus preparatory texts of uncertain relationship to the proprietary rights that are ultimately granted.

Well, thank you very much.