



“YOU SAID WHAT?”
A LOOK AT THE INFLUENCE OF FOREIGN PATENT PROSECUTION ON
DOMESTIC INFRINGEMENT LITIGATION

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Abstract

The current patent statutes are structured to grant unambiguous patents that give patent holders a right to exclude and provide the public with ample notice of the patented subject matter. Therefore, courts should interpret the scope of a claim using only the specification and the file history, the very tools used by the patent holder and public to define the bounds of the patent. Unfortunately, limiting statements made abroad can be allowed into evidence, creating a way for accused infringers to evade liability. By permitting judges to admit extrinsic evidence for the purpose of providing clarity to a supposedly already unambiguous patent claim, the Federal Circuit is providing defendants with one more escape route out of the courtroom and onto the streets of infringement. This comment concentrates on the use of foreign extrinsic evidence and the drastic effects it can have on domestic patent litigation.

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INTRODUCTION

Despite patent law’s consistent attempts to banish the creature of ambiguity from the judicial realm, it still manages to force its way through the courtroom doors and wreak havoc on the consistency of claim interpretation and, consequently, the reliability of United States patents.¹ Consider, as an illustration, the following:

You have successfully obtained your patent for a sundial wristwatch, which runs exclusively on solar energy. You filed your patent application with the German Patent and Trademark Office (GPTO) and the United States Patent and Trademark Office (USPTO) on the same day. The USPTO is pleased with your disclosures and finds no material prior art² nor any reason to modify your patent application and, as a result, issues you a U.S. patent. The GPTO, however, rejects your German patent application over a U.S. patent issued for a sundial wristwatch, which runs exclusively on direct rays from the sun. You argue with the GPTO that your invention was neither anticipated nor an obvious variation of the earlier sundial wristwatch because, unlike the prior art, your wristwatch keeps time accurately when there is complete cloud cover and no sun rays are available. In fact, it doesn’t function nearly as well when sun rays are available. You assert that the advantages of your sundial wristwatch operating with complete cloud cover are significant and were never taught by the earlier invention. The GPTO relents and awards the patent.

Some years later you find that a competitor is selling moonial wristwatches, which run at night when there are no sunrays. You bring an infringement suit in the U.S. against the competitor, confident that your patent is novel, nonobvious, has utility and is a fully integrated document. Before the judge makes a decision on patent ambiguity, your competitor

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¹ See *Shen Wei (USA), Inc. v. Kimberly-Clark Corp.*, 2002 WL 1998290 (N.D. Ill. Aug. 28, 2002) (explaining that claim interpretation defines the scope of the patent): see also *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 979 (Fed. Cir. 1995) (stating that claim interpretation is “a matter of law”), *aff’d*, 517 U.S. 370 (1996).

² Prior art is simply the available knowledge, including what would be obvious from it, at the time of filing, to a person having ordinary skill in the art. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1453 (Fed. Cir. 1984). All material which is reasonably pertinent to the particular problem the inventor is trying to solve comprises the scope of the prior art. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535 (Fed. Cir. 1983).

successfully enters extrinsic evidence – your invention’s German prosecution history (where you limited the scope of your claims). The court finds that the representations you made to the GPTO indicate that you intended to exclude all variations of your patented invention, including those that could be considered an equivalent because only through “complete cloud cover” would you achieve the desired results. The fact that the moon dial watch operates at night distinguishes it from your sundial watch, and therefore, it does not infringe.

How could this happen? Why not require the judge to make a preliminary determination on whether the U.S. patent is ambiguous before he views the foreign prosecution history? Why do representations to a foreign country impact your U.S. patent that was prosecuted separately from the foreign patent? How do you stop this from happening in the future?

The language of 35 U.S.C. § 112 requires a specification to provide a written description of the invention and how to make and use it in “full, clear, concise and exact terms.” The description should enable a person skilled in the art³ to make and use the invention.⁴ The statute also requires the specification to have one or more claims “particularly point out and distinctly claim”⁵ the invention. The purpose of this language is to avoid the formation of any ambiguities in the patent.⁶ Stated differently, once a patent is issued by the USPTO, no ambiguities should exist or the

³ See *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (“It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed.”); see also *Kimberly-Clark*, 745 F.2d at 1453–54 (Fed. Cir. 1984). The *Kimberly-Clark* court stated:

Since January 1, 1953, the effective date of the 1952 Patent Act, . . . courts [no longer make] use of the legal fiction that an inventor must be presumed to know the “prior art.” The inventor, for purposes of legal reasoning, has been replaced, as some courts have discovered, by the statutory hypothetical “person of ordinary skill in the art” who has been provided by 35 U.S.C. § 103 . . . What controls the patentability of the fruits of the inventor’s labors are the statutory conditions of novelty, utility, and unobviousness “to a person having ordinary skill in the art to which said subject matter pertains” as stated in § 103. It should be clear that that hypothetical person is not the inventor, but an imaginary being possessing “ordinary skill in the art” created by Congress to provide a standard of patentability, a descendant of the “ordinary mechanic acquainted with the business” of *Hotchkiss v. Greenwood*, 52 U.S. 248 (1850). Realistically, courts never have judged patentability by what the real inventor/applicant/patentee could or would do. Real inventors, as a class, vary in their capacities from ignorant geniuses to Nobel laureates; the courts have always applied a standard based on an imaginary worker of their own devising whom they have equated with the inventor.

Id.

⁴ 35 U.S.C. § 112 (2000); see also *Grant v. Raymond*, 31 U.S. 218, 247 (1833) (reasoning that a description “is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent.”).

⁵ 35 U.S.C. § 112 (2000).

⁶ *Markman*, 52 F.3d at 986 (Fed. Cir. 1995), *aff’d*; see also *E.I. Du Pont De Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988) (explaining that the specification should be used “to interpret what the patentee meant by a word or phrase in the claim, . . . [and] is not to be confused with adding an extraneous limitation appearing in the specification, which is improper”).

patent never could have been issued in the first place.⁷ Further, if the USPTO finds the claims to be sufficiently unambiguous, then a court should come to the same result later in an infringement suit. However, such is not the case. The creature of ambiguity forces its way through patent law barricades and into the judiciary and can be halted only by claim interpretation⁸ based on the specification,⁹ the file history,¹⁰ or, as a last resort, extrinsic evidence.¹¹

Statements made by a foreign associate or to a foreign patent examiner prior to the issuance of a foreign patent¹² are forms of evidence that have seldom been used in the past. In recent years, however, the importance of obtaining intellectual property protection throughout the world has become significant.¹³ As a result, the importance of statements made during prosecution of a foreign patent must be addressed. Statements made by a foreign associate to a foreign examiner pertaining

⁷ *Markman*, 52 F.3d at 986 (reasoning that if “the patent’s claims are sufficiently unambiguous for the PTO, there should exist no factual ambiguity when those same claims are later construed by a court of law in an infringement action”).

⁸ In patent law, the terms *claim construction* and *claim interpretation* mean one and the same. *Id.* at 976 n.6.

⁹ *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (explaining that “the specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it”); *see also In re Glass*, 492 F.2d 1228, 1230 (C.C.P.A. 1974) (explaining that if “the specification contains an inadequate, fatally defective disclosure in that it would not enable any person skilled in the art to practice the invention claimed,” then the claims are unsupported); *see generally In re Argoudelis*, 434 F.2d 1390, 1393 (C.C.P.A. 1970) (explaining that the description must be sufficient as of the filing date, later publications cannot act to suddenly enable the proposed invention).

¹⁰ *Vitronics*, 90 F.3d at 1582 (explaining that “the court may also consider the prosecution history of the patent, if in evidence”). The file history is a complete record of the events that took place between the USPTO and the inventor, including express representations pertaining to the scope of the claims. *Id.*

¹¹ *Id.* at 1584 (stating that “[e]xtrinsic evidence is that evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles”); *see also Markman*, 52 F.3d at 981 (explaining that extrinsic evidence may also serve to define the state of the prior art at the time of the invention).

¹² *See* Joel Weiss, *Side Bar: Foreign Prosecution*, in DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW, CASES AND MATERIALS 123–25 (2d ed. 2001).

¹³ Philippe Signore, Ph.D, *The New Provisional Right Provision*, 2000 82 J. PAT. & TRADEMARK OFF. SOC’Y 742, 759 (2000) (explaining that “[i]n an increasingly worldwide economy, worldwide protection is becoming a necessity for all inventors. Americans, being of an inventive nature, should thus benefit from worldwide patent protection”); *see also* Kenneth W. Dam, *The Growing Importance of International Protection of Intellectual Property*, 21 INT’L. LAW 627, 628 (1987)

The products and services that should be protected by intellectual property law account for a significant portion of trade, and inadequate protection today plays a major distorting role in world trade. This is all the more troublesome at a time when trade imbalances are already threatening existing open marketplaces. Let us therefore turn from the anecdotal to the quantitative.

Government and industry estimates evaluate yearly losses from counterfeiters at about six to eight billion dollars, or an amount equivalent to five percent of the U.S. merchandise trade deficit of \$175 billion. Individual industry estimates include \$200 million lost annually by the agricultural chemical industry due to inadequate patent protection, and one billion dollars a year lost in computer software revenues.

Id.

to a foreign patent can be used as evidence to limit a U.S. patent claim in a domestic patent infringement suit.¹⁴

This Comment will explore the effect of foreign statements on U.S. patent litigation. Part I provides an introduction to the forms of evidence used for claim interpretation in infringement suits. Part II considers the manner in which extrinsic evidence and, more specifically, foreign statements can be applied. Part III explores cases in which the Federal Circuit used foreign statements as extrinsic evidence to determine the meaning of the asserted claims. Part IV investigates the pitfalls of the use of foreign statements as extrinsic evidence. Part V suggests solutions to avoid these pitfalls, including eliminating the use of extrinsic evidence altogether. Finally, Part VI proposes strategies for guiding a patentee past these pitfalls and onto steady ground under the current system.

I. THE PROPER USE OF INTRINSIC AND EXTRINSIC EVIDENCE

As Judge Giles Rich stated, “[t]he name of the game is the claim.”¹⁵ A patent claim defines the boundaries of the patentee’s right to exclude.¹⁶ The patent claims do not describe the invention, but instead provide a line marking the limits of the patentee’s right to exclude others from using the “claimed” invention.¹⁷ The claimed invention must be sufficiently described in the specification and drawings of the patent application.¹⁸

The first step in a patent infringement analysis involves construing the asserted claims. In *Markman v. Westview Instruments, Inc.*, the Federal Circuit held that claim construction is a matter of law, which is reviewed de novo.¹⁹ On appeal, the United States Supreme Court affirmed and added that there is significant importance in having uniform interpretation of patents.²⁰ The court reasoned that judges are better suited than juries to consistently interpret patent claims.²¹ In determining proper claim construction, the court has several tools available for

¹⁴ *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983).

¹⁵ Giles S. Rich, *The Extent of the Protection and Interpretation of Claims – American Perspectives*, 21 INT’L REV. INDUS. PROP. & COPYRIGHT L. 497, 499–501 (1990).

¹⁶ See *Bloomer v. McQuewan*, 55 U.S. 539, 549 (1852) “The franchise which the patent grants consists altogether in the right to exclude everyone from making, using or vending the thing patented without the permission of the patentee. This is all he obtains by the patent.” *Id.*; see also *Crown Die & Tool Co. v. Nye Tool & Machine Works*, 261 U.S. 24, 35 (1923) (stating that by granting a patent, “the government is not granting the incident of exclusive ownership of that common-law right”).

¹⁷ See *SRI Int’l v. Matsuhita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (reasoning that “it is the claims that measure the invention” and “[c]laims are infringed, not specifications”). The patent code today requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 (2000).

¹⁸ The patent act requires that “[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . .” 35 U.S.C. § 112 (2000) (*emphasis added*).

¹⁹ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 988 (Fed. Cir. 1995).

²⁰ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996).

²¹ *Id.*

guidance in its evidentiary tacklebox.²² These tools come in two forms:²³ intrinsic evidence and extrinsic evidence.

Intrinsic evidence in a patent case includes the patent claims, specification and prosecution history²⁴ (also commonly referred to as the file history). In *Vitronics Corp. v. Conceptronics, Inc.*,²⁵ the Federal Circuit established that intrinsic evidence is the primary source for resolving any ambiguities in claim construction. First, the words of the claims themselves will be used to define the scope of the patented invention.²⁶ Second, the specification can be used to determine if the inventor used words inconsistent with their normally accepted meaning.²⁷ A patentee is free to be his own lexicographer and use words in a manner opposing their traditional use.²⁸ In that instance, the patentee will typically have an explicit definition of the word clearly stated in the specification.²⁹ In some instances, however, a patentee may implicitly define a term by using it in the same manner throughout the patent application.³⁰ Third, the prosecution history of the patent, if available, can be entered into evidence to discover if claim terms were limited or defined prior to the patent being issued.³¹ The prosecution history is of substantial importance in

²² *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

²³ *Id.*

²⁴ *Markman*, 52 F.3d at 979 (explaining that intrinsic evidence has “three sources: [t]he claims, the specification, and the prosecution history.”); *see also* *Trilogy Communications, Inc. v. Times Fiber Communications, Inc.*, 109 F.3d 739, 745 (Fed. Cir. 1997) (reasoning that the district court had properly relied on the claim language, the specification, and the prosecution history in construing the claims).

²⁵ *Vitronics*, 90 F.3d at 1582. The United States District Court for the District of New Hampshire was reversed after granting summary judgment. *Id.* at 1578. The Federal Circuit explained that it was improper to rely on extrinsic evidence to define the meaning of “solder reflow temperature” where the intrinsic evidence had adequately defined the term. *Id.* at 1584.

²⁶ *Vitronics*, 90 F.3d at 1582 (stating that the words of the claims, both asserted and nonasserted are used first to define the scope of the invention); *see also* *Hormone Research Foundation, Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed. Cir. 1990) (explaining that technical terms are interpreted as they would be by persons studied in the field, unless it is apparent that the patentee used the terms with a different meaning).

²⁷ *Vitronics*, 90 F.3d at 1584 (proposing that when the specification either expressly or impliedly defines the terms in the claims it functions as a dictionary). As the Federal Circuit has stated before, the claims must be read in light of the specification. *Id.*

²⁸ *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996); *see also* *Remishaw PLC v. Marposso Societa'per Azioni*, 158 F.3d 1243, 1249 n.3 (Fed. Cir. 1998) (stating that when there is a “situation where the patent applicant has elected to be his own lexicographer by providing an explicit definition in the specification for a claim term. . . any interpretation that is provided or disavowed in the prosecution history also shapes claim scope”); *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998) (explaining that when a patent applicant has made explicit statements during prosecution, those limiting statements will serve to limit the scope of the claims, even though they could be read broader independently). *But see* U.S. Patent and Trademark Office, *MANUAL OF PATENT EXAMINING PROCEDURE* § 2173.01 (8th ed. 2003) (explaining that a patent applicant can define “their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art”).

²⁹ *Bell Atlantic Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001).

³⁰ *Id.* at 1273.

³¹ *Graham v. John Deere*, 383 U.S. 1, 33 (1966).

infringement suits that rely on the doctrine of equivalents³² as a basis of the infringement claim. In doctrine of equivalents cases, prosecution history estoppel prevents patentees from trying to recover any subject matter that they were forced to relinquish in order to obtain the patent.³³ Finally, if the public record is ambiguous, the court may rely on extrinsic evidence.³⁴ Interestingly, a court is not prohibited from viewing extrinsic evidence before making a decision on claim interpretation ambiguity.³⁵

Extrinsic evidence has been classified as everything but intrinsic evidence.³⁶ This typically includes manuals, expert testimony, inventor testimony, and similar evidence, but, as recent case law dictates, excludes technical and ordinary dictionaries.³⁷ Extrinsic evidence may aid the court by explaining scientific principles, clarifying the meaning of terms of art or technical terms used in the patent, and defining the state of the art at the time of the invention's conception.³⁸ Used properly, extrinsic evidence should help a court to fully understand the meaning of the patent.³⁹ However, the Federal Circuit has stated that extrinsic

³² The doctrine of equivalents allows the courts to step beyond the literal language of the patentee's right to exclude. DONALD S. CHISUM ET AL., *PRINCIPLES OF PATENT LAW, CASES AND MATERIALS* 870, 874 (2d. ed. 2001). The doctrine of equivalents has a history of nearly 150 years and is a common law doctrine. *Id.* As Judge Learned Hand stated:

[A]fter all aids to interpretation have been exhausted, and the scope of the claims has been enlarged as far as the words can be stretched, on proper occasions courts make them cover more than their meaning will bear. If they applied the law with inexorable rigidity, they would never do this, but would remit the patentee to his remedy of re-issue, and that is exactly what they frequently do. Not always, however, for at times they resort to the "doctrine of equivalents" to temper unsparing logic and prevent an infringer from stealing the benefit of the invention. No doubt, this is, strictly speaking, an anomaly; but it is one which courts have frankly faced and accepted almost from the beginning.

Id. at 874 (quoting *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 692 (2d. Cir. 1948)).

³³ *Warner-Jenkinson Co., v. Hilton Davis Chem., Inc.*, 520 U.S. 17, 25 (1997) (reasoning that if a patent applicant relinquishes subject matter in its dealings with the USPTO so that a patent would be granted, the doctrine of equivalents cannot retrieve the lost subject matter).

³⁴ *General Elec. Co. v. Joiner*, 522 U.S. 136, 136 (1997) (explaining that the standard of review of the trial court's decision to admit or deny extrinsic evidence is reviewed on the abuse of discretion standard).

³⁵ *Texas Digital Sys., Inc. v. Telegenix, Inc.* 308 F.3d 1193, 1203 (Fed. Cir. 2002) (stating that extrinsic evidence may be consulted at any time during litigation): *see also* *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (explaining that "it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field").

³⁶ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (explaining that extrinsic evidence is "all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises").

³⁷ *See Texas Digital* 308 F.3d at 1203. "[c]ategorizing [dictionaries and scientific authorities] as "extrinsic evidence" or even a "special form of extrinsic evidence" is misplaced and does not inform the analysis." *Id.*

³⁸ *Markman* 52 F.3d at 978.

³⁹ *Id.* at 979; *see also* *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998). As stated by Judge Plager:

The effort is to understand the meaning of the terms in the claims. To the extent that involves delving into factual matters, such materials simply become part of the process of understanding. It hardly seems necessary to state that the

evidence should not be used for “the purpose of varying or contradicting the terms of the claims.”⁴⁰

II. DEFINING THE BOUNDARY BETWEEN INTRINSIC AND EXTRINSIC EVIDENCE

Intrinsic and extrinsic evidence are designed to help the court develop a complete understanding of a claim’s meaning. Ironically, the distinguishing factors between these two forms of evidence are very vague. Consider the following hypothetical as an illustration:

An inventor patents a metallic quadra-pronged nutrition supplementation device, and finds out six months later that Wer Naughtin Frinjin Co. is making an infringing item, which the company calls a fork. The inventor brings suit in the appropriate federal district court where Judge Webster presides. Judge Webster needs to construe the meaning of a metallic quadra-pronged nutrition supplementation device, and there is no definition of the item in the patent or file history. However, Judge Webster is certain that a person having ordinary skill in the art would fully understand this invention and its application. Accordingly, Judge Webster summons his clerk and asks him to obtain a dictionary that a person having ordinary skill in the art would utilize in practice. Judge Webster looks up the definition and uses it in his analysis to determine whether the patent is itself ambiguous. In this situation, what role does the dictionary play? It does not fit squarely into the definition of intrinsic evidence, but it is not extrinsic evidence either. The judge must ascertain what a person having ordinary skill in the art would have understood the term to mean, for that is the standard by which a patent’s validity is measured.

Courts usually allow dictionaries into evidence for defining and understanding technical terms.⁴¹ However, there is no precise cutoff between understanding technical terms and interpreting technical terms.⁴² As Judge Rader mentioned in *Cybor Corp. v. FAS Technologies Inc.*:

point of seeking understanding of the terms in which the claims are cast is not for the sake of understanding in the abstract, but to ensure as much as the intrinsic nature of language permits that the court’s interpretation is a correct one.

Id. at 1462.

⁴⁰ *Markman*, 52 F.3d at 981; *Vitronics*, 90 F.3d at 1583 (Fed. Cir. 1996).

⁴¹ *Texas Digital*, 308 F.3d at 1203. It is proper for judges to consult dictionaries and scientific authorities at any point during litigation and these items need not be offered into evidence by a party to the suit. *Id.* Technical and scientific authorities offer specialized meanings in the particular field of art. *Inverness Med. Switzerland GmbH v. Warner Lambert Co.* 309 F.3d 1373, 1378 (Fed. Cir. 2002). Ordinary words that have no specialized meanings can be defined using a standard dictionary. *Id.*

⁴² *Markman*, 52 F.3d at 980; see also *Pitney Bowes, Inc., v. Hewlett-Packard Co.* 182 F.3d 1298 (Fed. Cir. 1999) (reasoning that “the patent file may often be sufficient to permit the judge to interpret the technical aspects of the patent properly, consultation of extrinsic evidence is particularly appropriate to ensure that his or her understanding of the technical aspects of the patent is not entirely at variance with the understanding of one skilled in the art”).

When confronted with sophisticated technology, district court judges often seek testimony from experts to help them understand and interpret the claim. Under the guise of setting standards for claim construction, this court instructs experienced trial judges that they may use experts to understand, but not to interpret, the claim terms. As a matter of logic, this is difficult to grasp.⁴³

There is a substantial difference between using evidence solely for educational purposes and using evidence for claim construction. Unfortunately, in application, this distinction has no bright line to define its limits.

Suppose, using the facts of the previously mentioned hypothetical, that although the U.S. patent and U.S. file history didn't define the item, it is clearly defined in a foreign prosecution history that was created when Inventor sought a patent in Germany. Should the judge allow this evidence for interpretation? Should he allow it prior to making a decision on ambiguity? These questions have led courts to conduct separate pre-trial hearings commonly referred to as "claim interpretation hearings" or "*Markman* hearings."⁴⁴ There are usually no set guidelines or procedures for conducting such a hearing, and its practice varies widely throughout the nation.⁴⁵ The goal of a *Markman* hearing, which is usually held prior to trial, is to construe the claims.⁴⁶

As mentioned in the introduction, perhaps the most frequently overlooked and least used form of extrinsic evidence involves statements⁴⁷ made in the prosecution of related foreign patents. The record developed in foreign patent prosecution can be used to limit the scope of the claims of the U.S. patent.⁴⁸

⁴³ *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1474 (Fed. Cir. 1998).

⁴⁴ *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 850 (D. Del. 1995) (reasoning that the court now has an "obligation" to instruct the jury as to the words used in the claim; this could be accomplished by holding a hearing to resolve the disputes); *ATD Corp. v. Lydall, Inc.* 159 F.3d 534 (Fed. Cir. 1998); *Remington Arms Co. v. Modern Muzzleloading, Inc.*, No. 2:97CV00660, 1999 WL 236722, at *2 (M.D.N.C. Feb. 8, 1999); *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709 (Fed. Cir. 1998).

⁴⁵ See Gary Hoffman & Charles W. Saber, § 7:2.8 *Timing of Markman Hearings* (2001) (explaining that courts have wide discretion in deciding how and when to hold a Markman Hearing).

⁴⁶ See ABA INTELLECTUAL PROPERTY LAW SECTION COMMITTEE 601 ANNUAL REPORT (1997); see also *Loral Fairchild Corp. v. Victor Co. of Japan*, 911 F. Supp. 76, 79 (E.D.N.Y. 1996) (stating that with "most aspects of trial hinging on this determination . . . now strictly a question of law for the court . . . a conscientious court will generally endeavor to make this ruling before trial."); Local Rules of the United States District Court for the Northern District of California, CIVIL L.R. 16-6-16-11 (defining local rules developed to govern the timing of Markman hearings).

⁴⁷ The word "statement" encompasses representations both oral and written to foreign associates.

⁴⁸ *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983) (reasoning that although there is no authority for the "proposition that instructions to foreign counsel . . . should be considered, and the varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representation inappropriate, there is ample such authority in decisions of other courts and when such matters comprise relevant evidence they must be considered").

III. WHAT YOU SAY ABROAD CAN AND WILL BE USED AGAINST YOU

One of the first cases to address foreign representations used as evidence to limit patent claims was *Caterpillar Tractor Co. v. Berco, S.p.A.*⁴⁹ Berco, the defendant, contended that Caterpillar had made harmful statements limiting its own U.S. patent while trying to obtain foreign patents.⁵⁰ Berco further contended that Caterpillar could not invoke the doctrine of equivalents⁵¹ to reclaim lost subject matter.⁵² As the court noted, “[t]he particular instructions and representation . . . indicate that Berco’s equivalent embodiment was not contemplated.”⁵³ On appeal the Federal Circuit considered statements made by Caterpillar’s counsel to foreign associates and also a representation of a German associate to the GPTO distinguishing the patent at issue over other references.⁵⁴ The Federal Circuit acknowledged that there was a lack of authority⁵⁵ advising courts to consider statements made by foreign counsel. The court also recognized that patent procedures and prosecution differ in foreign countries. After considering the issue, however, the court reasoned that when the foreign statements contain relevant evidence⁵⁶ they must be considered.⁵⁷ The Federal Circuit affirmed the district court’s finding of infringement, but in dicta, set the tone for its more recent ruling in *Tanabe Seiyaku Co. v. U.S. International Trade Commission*.⁵⁸

In *Tanabe*, the plaintiff brought suit pursuant to 19 U.S.C. § 1337.⁵⁹ Tanabe alleged that the importation, sale for importation, and sale within the United States of diltiazem hydrochloride and diltiazem preparations, produced by a process allegedly infringing claim 1 of its patent was a violation of § 1337.⁶⁰ Tanabe sought a

⁴⁹ *Id.*

⁵⁰ *Id.* at 1116.

⁵¹ See *supra* note 36.

⁵² *Caterpillar*, 714 F.2d at 1115.

⁵³ *Id.* at 1116.

⁵⁴ *Id.* at 1116 (Fed. Cir. 1983). The court stated:

Berco and Wortham cite instructions of Caterpillar’s counsel to his foreign associate counsel describing the embodiment at the top of footnote 1, *supra*, and a representation of his German associate to the German patent office distinguishing over certain references, during Caterpillar’s prosecution of patent applications on the same invention in Great Britain and Germany.

Id.

⁵⁵ *Id.* See also *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 1538–39 (Fed. Cir. 1983) (explaining that although there is no authority cited for the proposition that instructions and representations to foreign counsel and foreign patent offices should be considered, and certain types of representations may be procedurally or substantively inappropriate, there is much authority in the decisions of other courts that when these communications comprise relevant evidence, they must be considered).

⁵⁶ “‘Relevant Evidence’ means evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.” FED. R. EVID. 401.

⁵⁷ *Caterpillar*, 714 F.2d at 1116.

⁵⁸ 109 F.3d 726 (Fed. Cir. 1997).

⁵⁹ *Id.* at 727. Section 1337 prohibits “[t]he importation into the United States . . . of articles that . . . are made, produced, processed, or mined under, or by means of, a process covered by the claims of a valid and enforceable United States patent.” 19 U.S.C. § 1337(a) (1994).

⁶⁰ *Tanabe*, 109 F.3d at 727.

permanent exclusion order⁶¹ and a permanent cease and desist order.⁶² On appeal to the Federal Circuit the plaintiff asserted that the International Trade Commission (ITC) erred by invoking estoppel against the plaintiff regarding the range of equivalents which allegedly had been partly based on irrelevant statements made to foreign counsel.⁶³ Tanabe's own statements, used in related patent matters before the EPO, Finnish patent office, and Israeli patent office, were considered by the Federal Circuit.⁶⁴

In the first claim of U.S. Patent No. 4,438,035, Tanabe specifically claimed five combinations of bases and solvents for N-alkylation, a chemical reaction, which is part of the process.⁶⁵ Tanabe alleged infringement of its patent based on the use of the base, potassium carbonate, which was claimed in four of Tanabe's five combinations.⁶⁶ However, an impediment arose because the accused process used butanone mixed with water rather than acetone.⁶⁷ Tanabe alleged infringement under the doctrine of equivalents⁶⁸ because there was no indication of literal infringement of its claimed process. The court had to determine whether the use of butanone instead of acetone was substantial or insubstantial.⁶⁹ If the difference was insubstantial, infringement under the doctrine of equivalents could be found.⁷⁰

The ITC considered statements and representations made by Tanabe to the European, Finnish and Israel patent offices.⁷¹ Each of these patent offices had rejected Tanabe's patent application over U.S. patent No. 3,075,967 ("the '967 patent").⁷² Tanabe argued to each of the three patent offices that its invention was

⁶¹ An exclusion order under 19 U.S.C. § 1337(a) (1994) would deny the continued importation and sale of the product produced by the relevant process.

⁶² *Id.* See 19 U.S.C. § 1337(d)-(f) (1994). See also DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW, CASES AND MATERIALS 870, 874 (2d. ed. 2001) (explaining that "[t]he award of an injunction against further infringement for the life of the patent has been a remedy available to courts since 1819."); Bryan A. Schwartz, *Where the Patent Trials Are How the U.S. International Trade Commission Hit the Big Time as a Patent Litigation Forum*, 20 NO. 2 INTELL. PROP. L. NEWSL. 1 (2002) (explaining that the ITC has the power to issue very broad exclusion orders).

⁶³ *Id.* at 731-33. Tanabe asserted that the ITC had erred by invoking *foreign prosecution history estoppel* to reach its holding. *Id.* at 733. Tanabe also asserted that the ITC erred in its construction of claim 1 and in its subsequent finding that the accused infringer did not infringe under the doctrine of equivalents. *Id.* at 731.

⁶⁴ *Id.* at 733.

⁶⁵ *Id.*

⁶⁶ *Id.* There were five base-solvent combination disclosed in the patent claims.

⁶⁷ *Id.* at 729.

⁶⁸ *Id.* Both parties agreed that the literal language of the claims did not encompass the base-solvent combination used by the accused infringer, specifically potassium carbonate mixed with butanone rather than acetone. *Id.*

⁶⁹ *Id.* The issue on appeal before the Federal Circuit was "whether the use of butanone in the Fermion process instead of the acetone in the patent claim constitutes a 'substantial' or 'insubstantial' difference between the accused process and the patent." *Id.* When the difference is substantial, there can be no finding of infringement under the doctrine of equivalents. *Id.* Inversely, when the difference is insubstantial, there is infringement and, consequently a violation of § 1337. *Id.*

⁷⁰ *Id.* See *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem., Inc.* 520 U.S. 17, 38 (1997) (stating that equivalence is for the jury to decide and that when a substantial difference does not exist between the patented invention and the accused infringing invention, infringement exists).

⁷¹ *Tanabe*, 109 F.3d at 733.

⁷² *Id.*

not obvious⁷³ in light of the '967 patent because its five specific base-solvent combinations gave unexpectedly better results than other combinations of bases and solvents.⁷⁴ Tanabe argued that its invention was not obvious by stating that:

Judging from the facts (i) that [the '967 patent] teaches neither the use of potassium carbonate as the base nor the use of specific base-solvent combinations to be employed in the method of the present method of the present invention; (ii) that, when condensation reaction was carried out by the use of sodium hydroxide or sodium carbonate as the base, the yield of the product was less than 10%; and (iii) that, even if potassium hydroxide or potassium carbonate was used as the base, the yield of the product was less than 30% in the case where dioxane, toluene or methanol was used, it is believed that the above mentioned advantages of the present invention have never been taught or suggested by [the '967 patent]. Thus [use of] the specific base-solvent combinations of the present invention is not obvious.⁷⁵

The ITC asserted that Tanabe intended to exclude all other bases and solvents from being used even if they could reasonably be construed as equivalents, because only the five unique base-solvent combinations claimed could produce the high yields needed.⁷⁶ On appeal, the Federal Circuit stated that the ITC did not establish any estoppel related to the prosecution of foreign counterparts to the U.S. patent.⁷⁷ However, the court also said that, in this case, the representations made to foreign patent offices are relevant to determine "whether a person skilled in the art would consider butanone or other ketones to be interchangeable with acetone in Tanabe's claimed N-alkylation reaction."⁷⁸ Stated differently, Tanabe's statements to the foreign examiner eliminated arguable equivalents from the scope in the U.S. claims.⁷⁹

Both *Caterpillar* and *Tanabe* illustrate how foreign prosecution history or representations made to foreign counsel can limit the scope of U.S. claims. To the careful patentee who has skillfully worded his claims so as to produce what appears to be a complete integral patent capable of clear unambiguous claim interpretation through intrinsic evidence, these cases would seem unimportant. Quite the contrary, the Federal Circuit has ruled that there are no specially crafted rules governing extrinsic evidence.⁸⁰ In *Pitney Bowes, Inc. v. Hewlett Packard Co.*,⁸¹ the Federal Circuit stated:

⁷³ A patent will not be granted if "the subject matter as a whole would have been obvious at the time the invention was made . . ." 35 U.S.C. § 103 (2000); see generally *Hotchkiss v. Greenwood*, 52 U.S. 248, 271 (1850) (explaining that changing a doorknob from steel to clay or porcelain is obvious and therefore not patentable).

⁷⁴ *Tanabe*, 109 F.3d at 729. Solvents dissolve reactants which then allows the reactants to chemically react. *Id.* Chemical compounds, such as butanone and acetone, are similar in that they are both ketones. *Id.* Butanone is a homolog of acetone having one more methylene group than acetone. *Id.*

⁷⁵ *Id.* at 730.

⁷⁶ *Id.* at 731.

⁷⁷ *Id.* at 733.

⁷⁸ *Id.* at 731.

⁷⁹ *Id.*

⁸⁰ *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) (explaining that "*Vitronics* does not set forth any rules regarding the admissibility of" extrinsic evidence); see

Vitronics does not prohibit courts from examining extrinsic evidence, even when the patent document is itself clear . . . it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field.⁸²

Thus, under *Pitney Bowes*, the Federal Circuit condones the submittal of extrinsic evidence for the court's review prior to the judge rendering a decision on claim ambiguity and to make sure the claim language is consistent with the technical jargon of the pertinent art.⁸³ This reasoning is confusing as it is contradictory with the idea that a patentee is free to be her own lexicographer and use words in any manner she chooses.

IV. THE EFFECT OF USING FOREIGN STATEMENTS AS EXTRINSIC EVIDENCE

The impact of the *Caterpillar* and *Tanabe* decisions should not be underestimated. Foreign statements, in the form of foreign prosecution history and representations made by foreign associates, create yet another opportunity for accused infringers to bypass the expressed claims of a patent.⁸⁴ Additionally, these forms of extrinsic evidence act to further complicate the coordination of domestic and foreign patent application processes. Moreover, foreign statements require judges to determine matters of law based on foreign patent prosecution, which may be

also Phonometrics, Inc. v. Northern Telecom, Inc., 133 F.3d 1459, 1464 (Fed. Cir. 1998) (reasoning that extrinsic evidence need not necessarily be admitted); Key Pharm. v. Hercon Labs. Corp., 161 F.3d 709 (Fed. Cir. 1998). The *Key Pharmaceuticals* court explained that "what is disapproved of is an attempt to use extrinsic evidence to arrive at a claim construction that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent." *Id.* at 716. The judgment was upheld by the Federal Circuit based in part on claim interpretation using extrinsic evidence. *Id.* at 717.

⁸¹ *Pitney Bowes*, 182 F.3d at 1308–09. Judge Rader, joined by Judge Plager, stated that the Federal Circuit should not order trial judges to engage in claim interpretation processes without allowing them to use extrinsic evidence. *Id.* at 1314–15 (Rader, J., filing additional views).

⁸² *Id.* at 1308–09 (explaining that "[a]lthough the patent file may often be sufficient to permit the judge to interpret the technical aspects of the patent properly, consultation of extrinsic evidence is particularly appropriate to ensure that his or her understanding of the technical aspects of the patent is not entirely at variance with the understanding of one skilled in the art"); *see also* Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437, 1444 (Fed. Cir. 1997) (stating that "[e]xtrinsic evidence may be particularly helpful to the court when a specific technical aspect that is potentially of dispositive weight was not discussed in the specification or explored during the patent prosecution"); U.S. Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE § 2173.01 (8th ed. 2003) (explaining that a patent applicant can define "their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art").

⁸³ *Pitney Bowes*, 182 F.3d at 1308–09.

⁸⁴ Pamela I. Banner & Mark T. Banner, *The Burden of Foreign Speech Federal Circuit Holds Patentees to Their Words, Even Those Said Abroad*, (1998) at <http://www.bannerwitcoff.com/articles/foreignspeech.pdf>

different than U.S. patent prosecution.⁸⁵ Lastly, the public notice function of the patent is severely compromised or altogether defeated when foreign statements are allowed to limit claim scope.⁸⁶

A. Foreign Statements Create Another Safe Haven for Accused Infringers to Escape Liability

The use of foreign statements provides accused infringers with another refuge where they may escape liability. Accused infringers can already assert many defenses including the doctrine of inequitable conduct,⁸⁷ the doctrine of patent misuse,⁸⁸ antitrust,⁸⁹ limitations on restrictive contractual provisions,⁹⁰ and the doctrine of implied license,⁹¹ to state a few. Through *Tanabe* and *Caterpillar*, the Federal Circuit has successfully managed to add one more link to an accused infringer's protective chain mail. Now, not only does a patentee need to be concerned with extrinsic evidence in the form of dictionaries, treatises, and experts construing the claims, but the applicant must also be extremely careful when handling foreign

⁸⁵ Often foreign patent laws are more restrictive on the scope of subject matter than can be patented. Brian G. Brunsvold and William H. Pratt, *Fundamentals of International Business Transactions* INTELLECTUAL PROPERTY RIGHTS – WHAT ARE THEY AND HOW DOES A COMPANY SECURE THEM? SB04 ALI-ABA 137, 141 (1996). Some countries do not allow patents on pharmaceutical compounds and compositions while others do not allow the patenting of medical or diagnostic procedures that operate on the human body. *Id.*

⁸⁶ The quid pro quo for awarding a patent is the creation of a public record of the invention. *Superior Fireplace Co. v. Majestic Prods. Co.* 270 F.3d 1358, 1371 (Fed. Cir. 2001). Congress uses this disclosure as a device to encourage innovation as required by the Constitution. *Id.*

⁸⁷ See Lisa A. Dolak, *The Inequitable Conduct Doctrine: Lessons From Recent Cases*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 719, 720–24 (explaining that “[i]nequitable conduct is the affirmative misrepresentation of a material fact, the failure to disclose material information, or the submission of false material information, coupled with an intent to deceive”).

⁸⁸ See *B. Braun Medical, Inc. v. Abbott Labs.*, 124 F.3d 1419, 1427 (Fed. Cir. 1997). In patent law, the equitable doctrine of unclean hands is known as patent misuse. *Id.* A court of equity will not assist in the enforcement of a patent that has been misused. *Id.* This doctrine is in place to restrict parties from drawing “anticompetitive strength from the patent right.” *Id.* See generally Morgan Chu et al., *Patent Misuse Defenses and Antitrust*, 721 PLL/PAT 831, 834–58 (2002) (addressing how “patent misuse is an affirmative defense to infringement”).

⁸⁹ See *In re Indep. Serv. Orgs. Antitrust Litig.*, 203 F.3d 1322, 1325 (Fed. Cir. 2000) (stating that “[i]ntellectual property rights do not confer a privilege to violate the antitrust laws”); see also Louis Kaplow, *The Patent-Antitrust Intersection: A Reappraisal*, 97 HARV. L. REV. 1815, 1826 (1984); *U.S. v. Microsoft Corp.*, 235 F.3d 34, 42 (D.C. Cir. 2001).

⁹⁰ See Maureen A. O'Rourke, *Striking a Delicate Balance: Intellectual Property, Antitrust, Contract, and Standardization in the Computer Industry*, 12 HARV. J.L. & TECH. 1, 7 (1998) (explaining the effect of contractual limitations on intellectual property).

⁹¹ See *Anton/Bauer, Inc. v. PAG, Ltd.*, 2002 WL 1359673, *8 (D. Conn. 2002). The doctrine of implied license has two elements. *Id.* First, the patentee must offer for sale an incomplete product which has no other use than to be completed into the patented product. *Id.* Second, the patentee must act in a manner indicating to the end user that it could buy or obtain additional components to make the product complete. *Id.* See also Steven C. Sereboff, *New Requirements in Patent Marking and Notice*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 793, 794 (1994) (explaining the Federal Circuit has determined that 35 U.S.C. § 287 applies to both express licenses and implied licenses).

patent matters.⁹² And, to further strengthen the accused infringer's judicial armor,⁹³ a judge can study all this information before he makes a decision on whether the claims are ambiguous.⁹⁴

B. Extrinsic Evidence Further Complicates the Coordination of Domestic and Foreign Patent Prosecution

The coordination of prosecution, domestic and foreign, is further complicated by the use of extrinsic evidence in infringement suits. Patent litigators hoping to enforce a patent should request any foreign prosecution histories as well as any instructions to foreign associates.⁹⁵ Litigators representing accused infringers are wise to request such documents early in the discovery process.⁹⁶ Further, for patent prosecutors, the *Tanabe* and *Caterpillar* decisions emphasize the need to coordinate foreign patents with domestic patents.⁹⁷ This becomes exceedingly difficult for managers of worldwide portfolios who will often file a patent application in numerous countries.⁹⁸ The use of foreign statements in an infringement suit may deter foreign patent holders from enforcing their rights in the U.S.

⁹² One can file directly in the patent office of any country. It is also possible for an inventor to file in regional groups such as the European Patent Office, the Eurasian Patent Office, which is composed of nine former soviet republics, the African Regional Industrial Property Organization for English-speaking African countries, and the African Intellectual Property Organization for French-speaking countries.

⁹³ See *Sage Prods. Inc. v. Devon Indus.*, 126 F.3d 1420 (Fed. Cir. 1997). The patentee has the burden of expanding his claims to be as broad as possible. *Id.* at 1424. The court explained that "it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure." *Id.* The patentee must bear the expense of protecting his invention against alleged infringers. *Id.*

⁹⁴ *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) (explaining that the trial judge is not precluded from viewing extrinsic evidence prior to making a decision on the ambiguous nature of the claims); see also *Eastman Kodak Co. v. Goodyear Tire and Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1997). The Federal Circuit upheld a ruling on claim interpretation after considering not only intrinsic evidence, but also extrinsic evidence. *Id.* Judge Lourie, in the dissent, argued that the intrinsic evidence was unambiguous and claim interpretation should have been made on that alone. *Id.* at 1562. The extrinsic evidence construing the claim was unnecessary and led the majority to an erroneous result. *Id.* at 1562–63.

⁹⁵ See generally John P. Sinnott, *Selection Strategy for Foreign Patent Application Filing*, 342 PLI/PAT 15, 64 (1992). Often times, when foreign patents are required, U.S. counsel will interact with foreign associates. *Id.* Foreign associates should have superior knowledge of the practices of that foreign patent office. *Id.*

⁹⁶ The discovery process is generally followed pursuant to Federal Rules of Civil Procedure Rule 26.

⁹⁷ Filing for a U.S. patent application first will not disallow the filing of a patent in most other countries. Pamela I. Banner & Mark T. Banner, *The Burden of Foreign Speech Federal Circuit Holds Patentees to Their Words, Even Those Said Abroad*, (1998) at <http://www.bannerwitcoff.com/articles/foreignspeech.pdf>. However, regardless of the order of the filing, consistent statements should be made to all foreign associates and foreign patent offices. *Id.*

⁹⁸ See John F. Duffy, *Harmony and Diversity in Global Patent Law*, 17 BERKELEY TECH. L.J. 685 (2002). Managers of worldwide portfolios will be required to carefully monitor what countries have pending patent applications, what was said and to whom, and lastly what limitations might be held against a broad U.S. patent claim for the same invention.

*C. Foreign Statements Require Judges to Determine Matters of Law Based on Foreign Patent Prosecution Practices Different From Those Practiced in the United States*⁹⁹

Foreign patent office systems and the procedures they maintain differ significantly from USPTO practices.¹⁰⁰ For this reason it may be unreasonable to rely on foreign prosecution history.

For example, Germany has a patent procedure distinguished by a dual system which separates questions of validity from patent infringement.¹⁰¹ Regional courts¹⁰² decide the issue of infringement and the patent court or patent office decides issues related to patent validity.¹⁰³ Further, the European Patent Office¹⁰⁴ (“EPO”) grants patent rights based on statutes different from U.S. statutes.¹⁰⁵ For example, in the United States, an invention is required to have “utility.”¹⁰⁶ Likewise, the EPO requires a similar, albeit different, limitation that an invention have “industrial

⁹⁹ See *Caterpillar Tractor Co. v. Berco S.p.A.*, 714 F.2d 1110, 1116 (Fed. Cir. 1983) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538–39 (Fed. Cir. 1983)) (explaining that the “varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representations inappropriate”).

¹⁰⁰ *Id.*

¹⁰¹ INTERNATIONAL PATENT LITIGATION, DE: 16 (Michael N. Meller ed., 2001) (explaining that, in Germany, “questions of infringement and patent validity are strictly separated”). In Germany, “patent infringement includes (1) the manufacture, offer, distribution, use, importation, or possession of a patented product without the consent of the patentee; (2) the use of a patented process or the offer of a patented process; (3) and the offer, distribution, use, importation, or possession of a product manufactured by a patented process without the consent of the patentee.” *Id.* at DE:4.

¹⁰² A regional court can only deal with infringement questions and lacks any authority to revoke a patent or alter its claims. *Id.* at DE:16.

¹⁰³ The Federal Patent Office, the European Patent Office, or the Federal Patent Court deal with restrictions on claims and any other questions of patent validity. *Id.*

¹⁰⁴ *Id.* at DE:1 (stating that “patent protection extends to German patents granted by the German Patent Office and to European patents granted by the European Office with effect in the Federal Republic of Germany in accordance with Article 64 of the European Patent Convention”).

¹⁰⁵ See Margreth Barrett, INTELLECTUAL PROPERTY, CASES AND MATERIALS, 224–31 (2d ed. 2001). One of the most important differences is that in the U.S., the first to invent has the right to file the patent, not the first to file an application, as is the case in many foreign countries. *Id.* Another difference is that the U.S. grants a “grace period” as seen in 35 U.S.C. § 102(b), while most other countries do not. *Id.*

¹⁰⁶ 35 U.S.C. § 101 (2000) (explaining that patentable inventions must be new and useful). A similar issue lies in the U.S. requirement that the “best mode” of the invention contemplated by the inventor be disclosed in the patent application. Donald S. Chisum, *Best Mode Concealment and Inequitable Conduct in Patent Procurement: A Nutshell, A Review of Recent Federal Circuit Cases and a Plea for Modest Reform*, 13 COMP. & HIGH TECH. L.J. 277, 279 (1997). There is no such requirement in most other patent granting countries including Europe and Japan. *Id.* This becomes an issue in the filing of foreign patent applications that are filed before a U.S. patent application for the same invention. *In re Gosteli*, 872 F.2d 1008, 1010–11 (Fed. Cir. 1989). To be able to use the earlier foreign filing date, the foreign patent application must satisfy all of the 35 U.S.C. § 112 disclosure requirements, including the “best mode” requirement. *Id.* Interestingly, “disclosure in the foreign application of what was known to be the best mode is sufficient even though a better mode is known by the time the applicant files the [U.S.] application.” 60 AM. JUR. 2d *Patents* § 554 (2002).

applicability.”¹⁰⁷ It is quite possible that an applicant, filing a patent application in Europe, may be required to modify patent claims to meet the “industrial applicability” standard.¹⁰⁸ When the same patent is filed in the U.S., the inventor should not be bound by his statements made abroad, which were intended simply to meet the patent laws of a foreign nation – laws which have the industrial applicability requirement rather than the utility requirement of the United States.¹⁰⁹ Prior to *Caterpillar* and *Tanabe*, the Court of Customs and Patent Appeals, now the Federal Circuit, consistently found that foreign proceedings had no relevance to United States patents.¹¹⁰

Finally, consider Israeli patent law. Israel allows prosecution history estoppel to be used as a defense in an infringement action to show that the scope of the claims was limited during prosecution.¹¹¹ However, Israeli patent law does not allow a patent to be attacked by means of statements made by the applicant to foreign patent offices.¹¹² Why then, should the U.S. court system place so much credence on these communications?

D. The Public Notice Function of the Patent is Severely Compromised Or Altogether Defeated When Foreign Statements Are Allowed to Limit Claim Scope

When extrinsic evidence is allowed in court, the purpose of public notice is frustrated.¹¹³ The public notice function is essential to the smooth operation of the patent system.¹¹⁴ Once a patent is granted, it provides a competitor with notice of (1)

¹⁰⁷ See *Proposal for a Directive of the European Parliament and of the Council on the patentability of computer-implemented inventions*, COM/2002/0092 final – COD 2002/0047*/OJ 2002 C151E/129.

¹⁰⁸ *Id.*

¹⁰⁹ See Toshiko Takenaka, Ph.D, *The Best Patent Practice or Mere Compromise? A Review of the Current Draft of the Substantive Patent Law Treaty and a Proposal for a “First-to-Invent” Exception for Domestic Applicants*, 11 TEX. INTELL. PROP. L.J. 259, 339 (2003) (explaining that Europe and Japan use the industrial applicability requirement to exclude medical methods from patentability, while the United States does not exclude them under the utility requirement).

¹¹⁰ See *In re Guinot*, 76 F.2d 134, 135–36 (C.C.P.A. 1935); *In re Dulberg*, 472 F.2d 1394, 1398 (C.C.P.A. 1973); see also *Baracuda Int’l Corp., v. F.N.D. Enter., Inc.*, 222 U.S.P.Q. 134, 135 (S.D. Fla. 1982) (reasoning that a South African courts decision was not significant for purposes of validity in the case before it); *Skil Corp. v. Lucerne Prods., Inc.*, 684 F.2d 346, 351 (6th Cir. 1982) (explaining that the district court did not err when it held that a rejection by the Canadian Patent office did not overcome the presumption of validity of a U.S. patent because of the differences in Canadian patent law and U.S. patent law).

¹¹¹ INTERNATIONAL PATENT LITIGATION, IL:9 (Michael N. Meller ed., 2001) (explaining that prosecution history or “file wrapper estoppel can also be claimed”).

¹¹² See *id.* (“Statements given by the applicant to a patent office in another country may not be used to attack a lawfully granted patent in Israel.”) *But see id.* (further explaining that some factual conclusions of foreign courts may be referred to in the Israel patent proceeding).

¹¹³ See *Litton Sys. v. Honeywell, Inc.*, 145 F.3d 1472, 1474 (Fed. Cir. 1998) (Gajarasa, J., dissenting) (explaining that the notice function is critical because it provides competitors with the necessary information upon which they can rely to shape their behavior in the marketplace).

¹¹⁴ *Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 957 (Fed. Cir. 2000) “The prosecution history constitutes a public record of the patentee’s representations concerning the scope and the meaning of the claims, and competitors are entitled to rely on those representations

the limits of the patentee's right to exclude¹¹⁵ and (2) a starting point for designing around the claimed invention.¹¹⁶ When the court allows extrinsic evidence, such as foreign prosecution history, a claim can be narrowed to accommodate the invention of the accused infringer. In essence, the court's acceptance of extrinsic evidence compromises the existing intrinsic claim limits¹¹⁷ and replaces them with gray borders that can be easily evaded if a competitor is crafty enough to unearth restricting statements made to foreign counsel. Therefore, the patent that gave the public ample notice of a protected invention is broader than the actual coverage afforded the patentee in court.¹¹⁸

V. SOLUTIONS TO THE USE OF FOREIGN STATEMENTS

Assuming that the USPTO properly granted a patent under the statutory language of 35 U.S.C. § 112,¹¹⁹ then it would stand to reason that the claims were ambiguous when issued. Building upon this assumption, it is reasonable to find that the public notice function¹²⁰ of the patent grant has been met. Therefore, extrinsic evidence would be inappropriate in infringement suits. The patent claims, specification, and file history, collectively known as intrinsic evidence, provide all the relevant information necessary for determining patent validity and patent infringement. Of course, if a judge was confused about the terminology used in a particular technology, he would be free to use an unbiased, objective dictionary to

when ascertaining the degree of lawful conduct." *Id.* The public's reliance on the public record must not be undercut. *Id.* The public record is that upon which reasonable competitors form their business strategies. *Id.*

¹¹⁵ Article I, Section 8, Clause 8 of the Constitution grants Congress the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the *exclusive* Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

¹¹⁶ See *State Indus., Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed. Cir. 1985) (reasoning that the "design around factor manifests the patent system's rule in providing incentive for designing around patented inventions, thereby creating new innovations."); see also *SRI Int'l Inc. v. Advanced Tech. Labs., Inc.*, 127 F.3d 1462, 1465 (Fed. Cir. 1997) (explaining that an attempt to design around acts to mitigate a finding of willfulness in an infringement suit); *Vitronics Corp., v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (finding that competitors are entitled to review public record[s] . . . and design around [the] claimed invention).

¹¹⁷ See Ellisen S. Turner, *Swallowing The Apple Whole: Improper Patent Use By Local Rule*, 100 MICH. L. REV. 640, 646-47 (2001).

¹¹⁸ *Id.* If patent monopolies are allowed to expand during infringement litigation, incremental innovation will be daunted because a fear of liability will deter inventors from designing around a patent that may be broader in scope than can readily be determined from the public record. *Id.*

¹¹⁹ The statutory language of 35 U.S.C. § 112 requires the inventor to provide a patent specification with sufficient information so that a person skilled in the art could make and use the invention without "undue experimentation." CHISUM, *supra* note 32, at 123-25 (2d ed. 2001). This "enablement requirement" is generally considered to be the *quid pro quo* between the government and the inventor.

¹²⁰ *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991). Designing around the expressed claims in a patent is not a wrong which is remedied by use of the doctrine of equivalents. *Id.* Rather, designing around a patent is one of the ways the patent system assists the public in promoting the progress of the useful arts, which is its constitutional purpose. *Id.*

better understand the language. This solution would create an exceptional advantage for the patent holder. In an infringement suit, a district court judge would be bound to make a decision on patent validity using only the intrinsic evidence. The burden would still be on the accused infringers to prove that the patent is indeed invalid, but they would not have the advantage of bringing extrinsic evidence into the courtroom.

Another alternative solution would be to require judges to make a decision on claim construction prior to allowing, or even viewing extrinsic evidence. Such a requirement would ensure that only when the judge has determined the patent to be ambiguous on its face would extrinsic evidence be allowed into the courtroom. The advantage to this proposal is that the judge, while interpreting the claim construction of a patent, would not be influenced by peripheral materials tending to coax him into finding the claims ambiguous.

A third alternative would be to simply prohibit the use of foreign statements and foreign prosecution history as extrinsic evidence altogether. Some forms of extrinsic evidence, for example, dictionaries¹²¹ and expert witnesses,¹²² may help resolve ambiguities in claim construction because the judge may have little knowledge in the subject field.¹²³ Considering that foreign statements and foreign prosecution history revolve about a foreign statutory sphere, they should be given no credit in defining the scope of a claim in a U.S. patent.

VI. UNTIL THEN . . .

One possible alternative under the current system for minimizing harmful foreign statements is to file a patent application under the Patent Cooperation Treaty¹²⁴ (PCT) claiming priority on a U.S. patent application.¹²⁵ The inventor and legal counsel will benefit because they could better tailor the statements made both to foreign patent offices and foreign counsel when prosecuting foreign patents.¹²⁶ As the corresponding U.S. patent application is prosecuted, limitations to the claims

¹²¹ Recently, the Federal Circuit found that a dictionary does not readily fall into the category of extrinsic evidence because it is a relatively unbiased, non-prejudicial manner of providing relevant information. *Texas Digital Sys., Inc., v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002).

¹²² See PLI/Pat 12:6.3 (explaining that technical experts can assist the judge in understanding the technical terms used in the relevant art).

¹²³ See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998) (explaining that trial courts can hear extrinsic evidence for background and education on the technology present in the claims).

¹²⁴ The EPC consists of several European states that have agreed to accept the European patent grant on an application filed in accordance with EPC provisions as if it is a patent issued from the contracting state's own patent office. Margaret A. Boulware, *Securing and Enforcing Patent Rights*, FOREIGN PATENTS, C567 ALI-ABA 103, 113 (1990). However, the EPC is not a replacement for the state's own national patent office. *Id.*

¹²⁵ Interestingly, because the U.S. government has a national security interest with all technology (including patents) exported abroad, certain patent applications can be subject to a secrecy order by the Commissioner. *Id.*

¹²⁶ Pamela I. Banner & Mark T. Banner, *The Burden of Foreign Speech Federal Circuit Holds Patentees to Their Words, Even Those Said Abroad*, (1998) at <http://www.bannerwitcoff.com/articles/foreignspeech.pdf>.

after issuance can be closely monitored and used as territorial markers defining the outer limits of the patent's scope. Consequently, foreign communications can be supervised so that they closely parallel the limiting statements made to the USPTO and, as a result, any foreign statements discovered by accused infringers will have no more value than those statements made during the U.S. phase.

If an inventor has already filed a patent application in a foreign nation, and made limiting statements to the foreign patent office, then the inventor will be in a precarious situation. If the inventor decides to file a U.S. patent application, then all prior art references cited to and by the foreign patent office must be disclosed. The end result will be that either: (1) the patent examiner will find that the invention is novel, nonobvious, and sufficiently designed around¹²⁷ the prior art; or (2) it is not, and the application will be rejected and will need to be amended.¹²⁸ Oddly enough, even though the latter scenario means that the scope of the claims may need to be narrowed, it may be the best approach. This is simply because once there is U.S. prosecution history relying on the same prior art that the foreign prosecution history relied on, the courts should, in theory, use the U.S. prosecution history first because it is intrinsic evidence. The U.S. patent prosecution history will have more authority in an infringement proceeding than the foreign prosecution history statements, even though the same prior art was cited. In other words, the foreign prosecution history will fall into the category of extrinsic evidence.

VII. CONCLUSION

The current patent statutes have been structured to grant a patent holder a right to exclude and to provide the public with ample notice. Because of this, courts should interpret the scope of a claim using only the specification and the file history. Unfortunately, by allowing limiting statements made abroad into evidence, as in *Caterpillar* and *Tanabe*, the Federal Circuit has created a way for accused infringers to escape liability. By permitting judges to admit extrinsic evidence for the purpose of providing clarity to a supposedly already unambiguous patent claim, the Federal Circuit is providing defendants with one more escape route out of the courtroom and onto the streets of infringement. Until this problem is remedied, inventors should be encouraged to first file a U.S. patent application, and only then file a PCT application for all countries where additional protection is desired.

¹²⁷ See *Senior Indus., Inc. v. Thomas & Betts Corp.*, 2002 WL 31180745, at *16 (N.D. Ill. Sept. 30, 2002) (explaining that an inventor may draft claims around a prior patent). The parties associated with the filing of a patent application also have a duty of good faith and candor before the patent office which includes disclosure of all information that is material to the patentability of the relevant invention. 37 C.F.R. § 1.56 (a) (2000).

¹²⁸ Kurt M. Kjelland, *Still Not The Same As It Ever Was . . . Proving Infringement After The Supreme Court's Festo Decision*, 721 PLI/PAT 253, 306 (2002).