

The Role of Foreign Prosecution History in Patent Infringement Actions

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I. Introduction

A United States patent may have a number of foreign counterparts that are filed in various countries and regional patent offices. The prosecution of each of these foreign counterparts may result in a fairly extensive foreign prosecution history, as searches are performed and rejections are applied against the invention in each of the various patent offices.

U.S. patent practitioners are well aware of the role that a patent's prosecution history can play in patent infringement actions. Thus, in responding to an examiner's rejections, U.S. patent practitioners are careful to avoid unnecessary arguments and amendments that will needlessly limit the scope of the claims. Foreign patent practitioners, however, may have little or no exposure to U.S. patent litigation. These practitioners are primarily concerned with obtaining allowance of the patent application. The possibility that any statements made during the prosecution of the patent may some day have an adverse effect on U.S. litigation involving a U.S. counterpart patent is probably not of great concern to most foreign patent practitioners. Due to differences between U.S. and foreign patent laws, a patent may issue in the U.S. with little or no substantive amendments. However, its foreign counterparts may have been allowed only after lengthy prosecution involving extensive arguments and claim amendments. In some cases, the foreign counterparts are abandoned, but only after many years of prosecution involving many rounds of amendments and arguments to the various foreign patent offices.

A patent's prosecution history can play an important part in a patent infringement action. The prosecution history before the U.S. Patent and Trademark Office (PTO) of the patent-in-suit is intrinsic evidence¹ which plays a significant role in claim construction.² In contrast, the foreign prosecution history of a foreign counterpart to the patent-in-suit is extrinsic evidence³ that plays a less significant role than the intrinsic evidence in determining the meaning of disputed claim language.⁴

Another use of the prosecution history, separate from its use in claim interpretation, is in determining the applicability of prosecution history estoppel.⁵ Prosecution history estoppel is a

¹ *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573, 1576 (Fed. Cir. 1996) (The intrinsic evidence includes the claims, the specification and the prosecution history.).

² *Id.* at 1582, 39 U.S.P.Q.2d at 1577 (“[T]he record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.”).

³ *Tanabe Seiyaku Co. v. United States Int’l Trade Comm’n*, 109 F.3d 726, 732, 41 U.S.P.Q.2d 1976, 1981 (Fed. Cir. 1997) (Evidence outside of the record before the U.S. PTO is extrinsic evidence.).

⁴ *C.R. Bard Inc. v. United States Surgical Corp.*, 388 F.3d 858, 862, 73 U.S.P.Q.2d 1011, 1014 (Fed. Cir. 2004).

⁵ *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1438, 7 U.S.P.Q.2d 1129, 1135 (Fed. Cir. 1988) (Use of prosecution history in ascertaining the meaning of the

limitation to the doctrine of equivalents that precludes a patent owner from obtaining a claim construction that would resurrect subject matter surrendered during the prosecution of the patent.⁶

The prosecution history is also significant because it includes the prior art cited during prosecution of the patent application. The foreign prosecution history is of particular importance in the context of the duty of disclosure. While the U.S. prosecution history necessarily contains all prior art found by the U.S. examiner, relevant prior art found in searches performed by other patent offices during the pendency of the U.S. prosecution must be affirmatively brought to the attention of the U.S. patent examiner.⁷

Although it is “jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case,”⁸ the courts have typically been reluctant to base their decisions on statements contained in a foreign prosecution history. In a number of cases in which a foreign prosecution history was raised, the courts have simply declined to address the issue.⁹ Courts that have addressed the issue have generally cautioned against placing too much weight on the foreign prosecution history.¹⁰

II. Claim Construction

Claim construction begins with the words of the claims.¹¹ Words in a claim are generally given their ordinary meaning as understood by a person of ordinary skill in the art.¹² However, a patentee is free to be his own lexicographer and may give claim terms a meaning different from their ordinary meaning.¹³ Thus, a review of the specification is required to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.¹⁴

claims “is different from prosecution history estoppel, which is applied as a limitation upon the doctrine of equivalents after the claims have been properly interpreted.”)

⁶ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 733 (2002).

⁷ M.P.E.P. § 2001.06(a) (8th ed., rev. 2, May 2004).

⁸ *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 U.S.P.Q.2d 871, 879 (Fed. Cir. 1983).

⁹ See, e.g., *C.R. Bard Inc. v. United States Surgical Corp.*, 388 F.3d 858, 73 U.S.P.Q.2d 1011 (Fed. Cir. 2004); *TI Group Auto. Sys. (N. Am.) Inc. v. VDO N. Am. L.L.C.*, 375 F.3d 1126, 71 U.S.P.Q.2d 1328 (Fed. Cir. 2004); *Bausch & Lomb Inc. v. Alcon Labs. Inc.*, 79 F.Supp. 2d 243, 53 U.S.P.Q.2d 1353 (W.D.N.Y. 1999).

¹⁰ *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods. Inc.*, 21 F.3d 1068, 1072, 30 U.S.P.Q.2d 1377, 1379 n.2 (Fed. Cir. 1994) (“[T]heories and laws of patentability vary from country to country, as do examination practices.”).

¹¹ *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573, 1576 (Fed. Cir. 1996) (“First, we look to the words of the claims themselves”).

¹² *Id.*

¹³ *Id.*

¹⁴ *Id.* at 1582, 39 U.S.P.Q.2d at 1577.

The prosecution history of the patent “contains a complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims.”¹⁵ Thus, the prosecution history is often of critical significance in determining the meaning of the claims.¹⁶ The prosecution history limits the scope of the claims by excluding interpretations that were disclaimed during prosecution.¹⁷ Further, “applicant’s express acquiescence with or distinction of the prior art” can also provide an indication of the scope of the claims.¹⁸

Unlike the prosecution history before the PTO, the foreign prosecution history is extrinsic evidence.¹⁹ If ambiguities remain after a review of the intrinsic evidence, extrinsic evidence may be used to resolve the scope and meaning of a claim term.²⁰ Additionally, “consultation of extrinsic evidence is particularly appropriate to ensure [the court] 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.”²¹ However, extrinsic evidence may not be used to define a claim term in a way that contradicts the claim language. Nor can extrinsic evidence be used to import limitations from the specification into the claims.²²

Although certain types of extrinsic evidence are routinely considered for claim construction purposes, when the extrinsic evidence is a foreign prosecution history, the courts have been more reluctant to do so. In *C.R. Bard Inc. v. United States Surgical Corp.*,²³ the defendant raised the issue of whether statements made by the applicants during prosecution of foreign counterpart patent applications limited the claims of the patent-in-suit. The Federal Circuit based its decision on the intrinsic evidence and concluded that it need not reach the issue of foreign prosecution history.²⁴

¹⁵ *Id.*

¹⁶ *Id.*, citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 U.S.P.Q.2d 1321, 1330 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370, 38 U.S.P.Q.2d 1461 (1996).

¹⁷ *Omega Eng’g Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323, 67 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 2003) (“The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.”).

¹⁸ *Rhodia Chimie v. PPG Indus. Inc.*, 402 F.3d 1371, 1377, 74 U.S.P.Q.2d 1321, 1325 (Fed. Cir. 2005).

¹⁹ *Tanabe Seiyaku Co. v. United States Int’l Trade Comm’n*, 109 F.3d 726, 732, 41 U.S.P.Q.2d 1976, 1981 (Fed. Cir. 1997) (Evidence outside of the record before the U.S. PTO is extrinsic evidence.).

²⁰ *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1583, 39 U.S.P.Q.2d 1573, 1577 (Fed. Cir. 1996).

²¹ *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309, 51 U.S.P.Q.2d 1161, 1168 (Fed. Cir. 1999).

²² *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1584, 39 U.S.P.Q.2d 1573, 1578 (Fed. Cir. 1996).

²³ 388 F.3d 858, 73 U.S.P.Q.2d 1011, (Fed. Cir. 2004).

²⁴ *Id.* at 870, 73 U.S.P.Q.2d at 1020, n.6.

In another decision decided the same year, *TI Group Automotive Systems (North America) Inc. v. VDO North America L.L.C.*,²⁵ defendant VDO raised arguments based on statements made by the patentee during foreign prosecution. The Federal Circuit again “declined to comment” noting that “the varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representations inappropriate’ for consideration in a claim construction analysis of a United States counterpart.”²⁶

III. Prosecution History Estoppel and the Doctrine of Equivalents

“The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes.”²⁷ Prosecution history estoppel is a limitation to the doctrine of equivalents that “precludes a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent.”²⁸ The narrowing of a patent claim during prosecution is “presumed to be a general disclaimer of the territory between the original claim and the amended claim.”²⁹ Even if a patent issues without amendment, it may have one or more foreign counterparts that are allowed only after lengthy prosecution involving extensive arguments and claim amendments.

The effect of statements and representations made during the prosecution of a foreign patent on prosecution history estoppel was addressed in *Caterpillar Tractor v. Berco*.³⁰ Caterpillar had prosecuted patent applications for the same invention in the U.S., Great Britain and Germany.³¹ Caterpillar asserted its U.S. patent against defendants Berco S.p.A. and Wortham Machinery Co. The defendants introduced into evidence instructions from Caterpillar’s counsel to foreign counsel describing an embodiment of the invention and a representation by Caterpillar’s German counsel to the German patent office distinguishing over certain references. Defendants claimed that the instructions and representation estopped Caterpillar from relying on the doctrine of equivalents.³² Directly addressing the issue of the foreign prosecution history, the Federal Circuit stated:

Though no authority is cited for the proposition that instructions to foreign counsel and a representation to foreign patent offices should be considered, and the varying legal and procedural requirements for obtaining patent protection in foreign countries might render consideration of certain types of representations

²⁵ 375 F.3d 1126, 71 U.S.P.Q.2d 1328 (Fed. Cir. 2004).

²⁶ *Id.* at 1136, 71 U.S.P.Q.2d at 1336, quoting *Caterpillar Tractor Co. v. Berco, S.p.A.*, 714 F.2d 1110, 1116, 219 U.S.P.Q.2d 185, 188 (Fed. Cir. 1983).

²⁷ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 733 (2002).

²⁸ *Id.* at 734, quoting *Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc.*, 103 F.3d 1571, 1577-1578, 41 U.S.P.Q.2d 1263, 1269 (Fed. Cir. 1997).

²⁹ *Id.* at 740.

³⁰ 714 F.2d 1110, 219 U.S.P.Q.2d 185 (Fed. Cir. 1983).

³¹ *Id.* at 1116, 219 U.S.P.Q.2d at 188.

³² *Id.*

*inappropriate, there is ample such authority in decisions of other courts and when such matters comprise relevant evidence they must be considered.*³³

Additionally, the court cited to *Stratoflex, Inc. v. Aeroquip Corp.* for the proposition that “[i]t is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.”³⁴ However, despite its position that relevant evidence must be considered, the Federal Circuit ultimately concluded that the cited instructions and representation contained in the foreign prosecution history were insufficient to overcome the “clearly erroneous” standard required for reversal of the district court’s findings on infringement.³⁵

The issue of prosecution history estoppel based on a foreign prosecution history was raised again in *Tanabe Seiyaku Co. v. United States International Trade Commission*.³⁶ Tanabe had appealed from an unfavorable ruling that certain respondents did not infringe Tanabe’s patent.³⁷ Tanabe argued that the Commission erred in considering the foreign prosecution history and in applying prosecution history estoppel to limit the application of the doctrine of equivalents.³⁸

The Federal Circuit cited to its earlier decision in *Caterpillar* for the proposition that representations to foreign patent offices should be considered in evaluating infringement under the doctrine of equivalents.³⁹ Despite this position, the court again avoided the issue of foreign prosecution history estoppel, concluding instead that the Commission’s decision was not based on foreign prosecution history estoppel.⁴⁰

The Federal Circuit did find, however, that “representations made to foreign patent offices are relevant to determine whether a person skilled in the art would consider [an element] to be interchangeable with [another element] in Tanabe’s claimed [invention].”⁴¹ Thus, while the court was clearly reluctant to address the issue of whether a foreign prosecution history could be used as the basis for prosecution history estoppel, it was more willing to use the foreign prosecution history to resolve factual issues, such as determining the knowledge of a person of skill in the art.

IV. The Duty of Disclosure

Applicants and their representatives are required by 37 C.F.R. § 1.56 to disclose “all information known to that individual to be material to patentability.”⁴² This includes, of course,

³³ *Id.* (emphasis added).

³⁴ 713 F.2d 1530, 1538, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983).

³⁵ *Caterpillar*, 714 F.2d at 1116, 219 U.S.P.Q.2d at 188.

³⁶ 109 F.3d 726, 41 U.S.P.Q.2d 1976 (Fed. Cir. 1997).

³⁷ *Id.* at 727, 41 U.S.P.Q.2d at 1978.

³⁸ *Id.* at 733, 41 U.S.P.Q.2d at 1982.

³⁹ *Id.* at 733, 41 U.S.P.Q.2d at 1982-1983.

⁴⁰ *Id.* at 733, 41 U.S.P.Q.2d at 1982.

⁴¹ *Id.* at 733, 41 U.S.P.Q.2d at 1983.

⁴² 37 C.F.R. § 1.56 (2004).

prior art cited during prosecution of a foreign counterpart patent application for the same invention or a related invention. Further, section 2001.06(a) of the Manual of Patent Examining Procedure states:

Applicants ... have a duty to bring to the attention of the Office any material prior art or other information cited or brought to their attention in any related foreign application. The inference that such prior art or other information is material is especially strong where it has been used in rejecting the same or similar claims in the foreign application or where it has been identified in some manner as particularly relevant.”⁴³

Thus, according to the PTO, references used in rejecting a foreign counterpart application should be brought to the attention of the patent examiner. Further, a reference cited in a search report, for example, as an X or Y reference should be brought to the attention of the patent examiner regardless of whether it is ultimately used in rejecting the foreign counterpart application.⁴⁴ Failure to disclose a material reference to the PTO, coupled with the intent to mislead or deceive the examiner into granting the patent, results in a finding of inequitable conduct which may render the patent unenforceable.⁴⁵

The effect of foreign prosecution on the duty of disclosure was addressed in *J.P. Stevens & Co., Inc. et al. v. Lex Tex Ltd., Inc.*⁴⁶ Lex Tex’s predecessor in interest had originally filed the ‘912 patent in the United States.⁴⁷ While the application which resulted in the ‘912 patent was still pending, counterpart applications were filed in Japan, Germany and Great Britain.⁴⁸ The Weiss reference was used in rejecting the Japanese, German and British applications.⁴⁹ The Japanese application was eventually abandoned, while the British application was allowed over the Weiss reference.⁵⁰ Although the Weiss reference was cited against all three foreign counterparts of the ‘912 patent, the applicants never disclosed the Weiss reference to the PTO.⁵¹

The Federal Circuit acknowledged that differences in foreign patent laws may be important in some situations. However, the court held that such differences are not relevant in

⁴³ M.P.E.P. § 2001.06(a) (8th ed., rev. 2, May 2004).

⁴⁴ The European Patent Office classifies documents cited in a search report by category.

Category X represents documents that are “particularly relevant if taken alone.” Category Y represents documents that are “particularly relevant if combined with another document of the same category.”

⁴⁵ *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 872, 9 U.S.P.Q.2d 1384, 1389 (Fed. Cir. 1988).

⁴⁶ 747 F.2d 1553, 223 U.S.P.Q. 1089 (Fed. Cir. 1984).

⁴⁷ *Id.* at 1556, 223 U.S.P.Q. at 1089.

⁴⁸ *Id.* at 1566, 223 U.S.P.Q. at 1097.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.* at 1557, 223 U.S.P.Q. at 1090.

determining the intent underlying a failure to disclose material prior art to the PTO.⁵² The court explained that the applicants' intent to mislead the PTO was unrelated to any of the rules regarding disclosure and patentability that may exist in a foreign jurisdiction. That is, whether the rules of a foreign jurisdiction would have required Weiss to be disclosed in that jurisdiction "has no controlling effect on whether it should have been disclosed to the PTO."⁵³

The court acknowledged that the rules do not require applicants to disclose *all* references cited against a foreign counterpart application. However, a reasonable applicant would have recognized that Weiss was a material reference from the fact that (1) Weiss cited as prior art in Japan, Germany and Great Britain, and (2) that Weiss was used by the examiners in each of these countries to reject the claims of foreign counterparts to the '912 patent.⁵⁴ Thus, the court inferred intent to mislead based on the applicants' failure to cite Weiss to the PTO despite the fact that Weiss was cited and applied against the foreign counterparts of the '912 patent.⁵⁵

The Federal Circuit again considered the issue of failure to disclose material prior art in *Molins PLC v. Textron Inc.*⁵⁶ Molins had appealed from a district court decision holding that Molins' patents were unenforceable due to inequitable conduct.⁵⁷ The district court, following the Federal Circuit's decision in *J.P. Stevens & Co., Inc. et al. v. Lex Tex Ltd., Inc.*,⁵⁸ relied on the foreign prosecution histories of counterpart applications to the patents-in-suit in determining that the withheld references were material.⁵⁹

Molins had filed U.S. and foreign patent applications directed to "batch process" and "system 24."⁶⁰ While the U.S. applications were pending, Molins became aware of the Wagenseil reference.⁶¹ Concluding that the Wagenseil reference anticipated the batch process invention, Molins immediately abandoned all foreign patent applications directed to the batch process.⁶² Eventually, the remaining foreign patent applications directed to system 24 were also abandoned based on the Wagenseil reference.⁶³ However, the Wagenseil reference was not disclosed to the PTO during the prosecution of the U.S. applications.⁶⁴

⁵² *J.P. Stevens & Co., Inc. et al. v. Lex Tex Ltd., Inc.*, 747 F.2d 1553, 1566, 223 U.S.P.Q. 1089, 1097 (Fed. Cir. 1984).

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ 48 F.3d 1172, 33 U.S.P.Q.2d 1823 (Fed. Cir. 1995).

⁵⁷ *Id.* at 1175, 33 U.S.P.Q.2d at 1824.

⁵⁸ *J.P. Stevens*, 747 F.2d 1553, 223 U.S.P.Q. 1089 (Fed. Cir. 1984).

⁵⁹ *Molins PLC v. Textron Inc.*, 821 F.Supp. 1551, 1565, 26 U.S.P.Q.2d 1889, 1898 (D. Del. 1992).

⁶⁰ *Id.* at 1558, 26 U.S.P.Q.2d at 1892.

⁶¹ *Id.* at 1561, 26 U.S.P.Q.2d at 1894-5.

⁶² *Id.*

⁶³ *Id.* at 1561, 6 U.S.P.Q.2d at 1895.

⁶⁴ *Id.* at 1563, 6 U.S.P.Q.2d at 1896.

The district court reviewed the foreign prosecution histories of the foreign system 24 counterpart applications, stating:

The Court is persuaded that the most telling evidence in the case on the issue of materiality of Wagenseil in the prosecution of the System 24 claims is Whitson's response to a request from the German Patent Office for Whitson to disclose all prior art cited in other countries. The German request prompted Whitson to indicate that Wagenseil was the most relevant disclosure to the System 24 application of which he was aware. Benziger, Whitson's subordinate, made a similar statement in 1975. In a letter to Whitson's Japanese associate, Benziger stated that Wagenseil was the *closest prior art* of which Molins was aware out of *all* the art references appearing in *all* corresponding applications. At least two foreign patent examiners agreed with Whitson and Benziger that Wagenseil was highly material to the System 24 applications. On June 12, 1974, a Dutch patent examiner issued an Office Action which suggested that he regarded Wagenseil as the closest prior art to the System 24 application. Likewise, a Japanese patent examiner rejected the System 24 application because of disclosures taught by a combination of Wagenseil with Lemelson patent '247.⁶⁵

Although the district court realized that caution must be exercised when relying on foreign prosecution history, it followed the Federal Circuit's holding in *J.P. Stevens & Co.* that, despite differences in foreign patent laws, the patentee's "actions in foreign prosecution may prove relevant to domestic prosecution of a patent."⁶⁶ Thus, the district court concluded that the Wagenseil reference was material because (1) Molins' represented to the German Patent Office that Wagenseil was "the most relevant disclosure," (2) Molin's stated to Japanese counsel that Wagenseil was "the closest prior art," and (3) both the Dutch and Japanese patent examiners cited Wagenseil in rejecting the respective counterpart applications.⁶⁷

On appeal, the Federal Circuit acknowledged that the district court had based its decision of materiality on the foreign prosecution histories of the counterpart applications.⁶⁸ Although the Federal Circuit did not find that the district court committed clear error in deciding the issue of materiality, the Federal Circuit did not endorse the district court's reliance on the foreign prosecution history. Instead, the Federal Circuit quoted section 2001.06(a) of the MPEP, which imposes a duty upon applicants "to bring to the attention of the Office any material prior art or other information cited or brought to their attention in any related foreign application."⁶⁹ The MPEP further explains that a reference is likely to be material "where it has been used in

⁶⁵ *Molins PLC v. Textron Inc.*, 821 F.Supp. 1551,1565, 26 U.S.P.Q.2d 1889, 1898 (D. Del. 1992).

⁶⁶ *Id.*, citing *J.P. Stevens & Co., Inc. et al. v. Lex Tex Ltd., Inc.*, 747 F.2d 1553, 1566, 223 U.S.P.Q. 1089, 1097 (Fed. Cir. 1984).

⁶⁷ *Id.* at 1565, 26 U.S.P.Q.2d at 1898.

⁶⁸ *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 1180, 33 U.S.P.Q.2d 1823, 1828 (Fed. Cir. 1995).

⁶⁹ *Id.* at 1180, 33 U.S.P.Q.2d at 1828, quoting Manual of Patent Examining Procedure (MPEP), § 2001.06(a) (4th ed., rev. 8, Oct. 1981).

rejecting the claims in the foreign application.”⁷⁰ The Federal Circuit held that “[o]n the evidence presented, *even that independent of the admissions in the foreign prosecution*, we cannot say that the court clearly erred in finding that a reasonable examiner would have considered Wagenseil important in deciding the patentability of the pending system 24 claims in the U.S. application.”⁷¹ Thus, the Federal Circuit again showed its reluctance in basing a decision on the foreign prosecution history.

V. Microsoft v. Multi-Tech

Although the Federal Circuit has generally been reluctant to base its decisions on foreign prosecution history, a recent case indicates that the prosecution history of counterpart applications may have increasing relevance. In *Microsoft Corp. v. Multi-Tech Sys., Inc.*,⁷² the Federal Circuit held that statements made during prosecution of one patent application are relevant to other related patents stemming from the same parent application, including a patent that had issued prior to the making of the statement.⁷³

Multi-Tech asserted three patents against Microsoft, the ‘649 patent, the ‘627 patent, and the ‘532 patent. All three patents are derived from the same parent and shared the same specification.⁷⁴ Of the three patents, the ‘649 patent issued first.⁷⁵ After the issuance of the ‘649, but before the issuance of the ‘532, Multi-Tech filed arguments and an amendment in the PTO in response to the examiner’s rejection of the application for the ‘627 patent.⁷⁶ Multi-Tech’s arguments were “expressly directed to the ‘communications system’ disclosed in the specification.”⁷⁷ Since the specification was identical for all three patents, the Federal Circuit held that “Multi-Tech’s statement to the PTO was thus not limited to the invention disclosed in the ‘627 patent, but was a representation of its own understanding of the inventions disclosed in all three patents.”⁷⁸ Thus, the court concluded that these statements were relevant to interpreting the claims of not only the ‘627 patent and the later issued ‘532 patent, but also to the earlier issued ‘649 patent.⁷⁹ The court justified its conclusions by stating that, particularly in official proceedings, the patentee has “every incentive to exercise care in characterizing the scope of its invention.”

A foreign-filed patent application typically shares a specification with its U.S. counterpart. Although the foreign-filed application may be in a different language, translations are performed with care, such that new matter is not added. Further, most if not all of the

⁷⁰ *Id.*

⁷¹ *Id.* at 1180, 33 U.S.P.Q.2d at 1828 (emphasis added).

⁷² 357 F.3d 1340, 69 U.S.P.Q.2d 1815 (Fed. Cir. 2004).

⁷³ *Id.* at 1350, 69 U.S.P.Q.2d at 1824.

⁷⁴ *Id.* at 1342, 69 U.S.P.Q.2d at 1817.

⁷⁵ *Id.* at 1344, 69 U.S.P.Q.2d at 1818-1819 n.1.

⁷⁶ *Id.* at 1344, 69 U.S.P.Q.2d at 1818.

⁷⁷ *Id.* at 1349, 69 U.S.P.Q.2d at 1823.

⁷⁸ *Id.* at 1350, 69 U.S.P.Q.2d at 1823.

⁷⁹ *Id.*

documents in a foreign prosecution history are either official communications to or from a foreign patent office, or relate to official communications to or from the foreign patent office.

VI. Conclusion

The available case law indicates that the Federal Circuit has generally been reluctant to place much weight on the foreign prosecution history of a counterpart patent. However, the recent decision in *Multi-Tech* may indicate an increasing willingness on behalf of the Federal Circuit to hold the patentee to statements made in official proceedings, whether in the PTO or otherwise.

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