

Keywords: Prosecution History Estoppel; Reasons for Allowance; Silence/No Comments

General: Unilateral statements by patent examiner in explaining reasons for allowance of claim do not create disavowal of claim scope by applicant giving rise to prosecution history estoppel, since applicant's silence, without more, cannot amount to clear and unmistakable disavowal of claim scope.

Salazar v. Procter & Gamble Co.
75 U.S.P.Q.2d 1369 (Fed. Cir. 2005)
Decided July 8, 2005

I. Facts

Salazar owns U.S. Patent No. 5,535,474, which relates to a toothbrush having polishing rods that clean and polish the teeth and stimulator rods that stimulate the gums during brushing. During prosecution, the examiner rejected independent claim 1 and objected to claims 2 and 3 as allowable subject matter dependent upon a rejected base claim. In response, the applicant cancelled claims 1 and 3 and added new claim 7 based on the allowable subject matter of claim 3. The examiner allowed the new claim 7 and included a statement of reasons for allowance along with the notice of allowance. Specifically, the statement of reasons for allowance stated:

Claim 7 now incorporates previously held allowable subject matter....Although the patent to Clemens appears to have the recited structure, Clemens' "rods" 22 are made of nylon, which is not considered "elastic". Obviously the "rods" of Clemens are flexible, but not considered to be "elastic" as recited by the claim.

The applicant did not respond to the examiner's statement of reasons for allowance, and the '474 patent subsequently issued with claim 7 renumbered as claim 1.

Salazar sued Procter & Gamble, alleging infringement of the '474 patent. Procter & Gamble filed a motion for summary judgment of no infringement, asserting that the stimulator and polishing rods in its products are not "elastic" as required by claim 1. The district court construed the term "elastic" as any material other than nylon, capable of returning to an initial state or form after deformation. The district court based this claim construction on the examiner's statement of reasons for allowance, which the district court found to *amend* the "elastic" element of the claim to exclude nylon. As a result, the district court granted summary judgment of no infringement.

II. Issue

Does an applicant's silence to an examiner's statement of reasons for allowance amount to a clear and unambiguous disavowal of claim scope and prosecution history estoppel?

III. Discussion

No. The present court held that an examiner's *unilateral* remarks alone do not affect the scope of the claim, let alone show a surrender of claimed subject matter that cannot be recaptured under the doctrine of equivalents.

The present court explained that the prosecution history does not contain any discussion of the "elastic" claim limitation by either the examiner or the applicant *other than* the examiner's

statement of reasons for allowance. In other words, the applicant did not expressly take any position regarding the “elastic” claim limitation.

In reaching its decision, the present court quoted the regulations, i.e., 37 C.F.R., in force during prosecution of the ‘474 patent, as follows:

The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. *Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.*¹

The present court also quoted *3M Innovative Props. Co.*, stating that the court should consider “the prosecution history to determine whether the applicant clearly and unambiguously disclaimed or disavowed any interpretation during prosecution in order to obtain claim allowance” and also stating that prosecution history “cannot be used to limit the scope of a claim unless the applicant took a position before the PTO.”

Procter & Gamble Co. also cited a number of cases to support its position that the applicant’s *silence* to the examiner’s statement of reasons for allowance amounts to a disavowal of claim scope. However, the present court indicated that Procter & Gamble either cited to dicta or to cases addressing issues different from the present case.

Again, the present court found that *unilateral* statements by an examiner do not give rise to a clear disavowal of claim scope by an applicant. Further, the present court suggested that statements about claim terms made by an examiner during prosecution of an application may be evidence of how one of skill in the art understood the term at the time of filing the application. Thus, the examiner’s statement of reasons for allowance may still be pertinent to claim construction.

The present court vacated the district court’s claim construction that excluded nylon from the scope of the “elastic” claim element, and affirmed the remaining portion of the district court’s claim construction of “elastic.” Accordingly, the present court vacated the district court’s grant of summary judgment, and remanded the case to the district court.

IV. Conclusion

Unilateral statements by the examiner do not *amend* the claims (as asserted by the district court) or create prosecution history estoppel. However, the examiner’s statement of reasons for allowance should be carefully reviewed for possible limiting affects on the claims, and comments should be filed to at least reduce the likelihood of undesirable claim construction during litigation.

¹ Note that the *current* 37 C.F.R. § 1.104(e) states that the “applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. *Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.*” Thus, the portion cited and italicized in the present case has been replaced with the portion italicized in the current Section 1.104(e).