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When Sippy-Cups Go Bad: Making Sense of Hakim v. Cannon Avent

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ABSTRACT

The *Hakim* patent infringement case created a considerable confusion as patent practitioners struggle to understand the CAFC holding and the potential impact on their clients and practice. *Hakim* articulated limits on the inventor's ability to broaden the scope of an invention through continuation applications. A thorough analysis of the confusing *Hakim* opinion reveals various potential approaches that confirm the CAFC's analysis. The court focused on a prosecution disclaimer and did not address other well established laws surrounding claim construction, the written description requirement, or continuation practice support that could have invalidated the patent. As a result of *Hakim*, many issued patents may be invalidated in court if prosecution history reveals insufficiently clear rescissions of patent scope disclaimers in parent applications. The *Hakim* opinion should not surprise practitioners as it remains another, in a stream of recent cases, which weaken the United States patent system by imposing costly and onerous patent prosecution requirements on inventors and practitioners.

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INTRODUCTION

The United Sates Constitution allows for the creation of patents so an inventor may secure the right to exclude others from making, using, or selling the patented invention.[3] Federal statutes, regulations, and procedures allow the United States Patent and Trademark Office (USPTO) to prosecute the creation of patent documents through the use of professional patent examiners.[4] The patent examiner prosecutes the patent by assessing the patentability of the claimed invention through examination of prior art and application of statutory requirements.[5] The patent's claims, viewed in light of the patent's specification and prior prosecution arguments between the examiner and the inventor (or attorney or agent), define the meets and bounds of the protected invention.[6] After meeting all the statutory requirements, a patent is issued to the inventor so that he may defend the claimed technology against potential infringers.[7]

Since 1838, patent attorneys utilized the practice of filing continuation patent applications to enhance the value of their client's invention.[8] Under U.S. patent rules, various types of continuation applications are available to allow broad invention protection.[9] Typically, the

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[3] U.S. Const. art. I, § 8, cl. 8 ("Congress shall have 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.").

[4] U.S. Patent Act of 1952, 35 U.S.C. §§ 1-376 (1999) (codified as Title 35 of the United States Code, entitled "Patents"); Consolidated Patent Rules 37 C.F.R . §§ 1.1-150.1 (2007); The Manual of Patent Examining Procedure (8th ed. 2001, rev. 2006) [hereinafter MPEP].

[5] 35 U.S.C. § 131 (Examination of application).

[6] Alza Corporation v. Mylan Laboratories Inc. et al, 391 F.3d 1365, 1370 (Fed. Cir. 2004).

[7] 35 U.S.C. § 154(a)(1) (Contents and term of patent; provisional rights).

[8] MPEP 901.04 (U.S. Patents) ("From 1838 to 1861, patents covering an inventor's improvements on his or her own patented device were given a separate series of numbers preceded by "A.I." to indicated Additional Improvement.").

[9] P. J. Federico, Commentary on the New Patent Act, 75 J. Pat. & Trademark Off. Soc'y 161, 192, 194 (1993) (reprinting the commentary from 35 U.S.C.A. (1954) (The commentary published with the Patent Act of 1952

inventor files a continuation patent to obtain the same filing date as the original application.[10] Continuation applications are useful when the patent owner wants to initiate the easier, narrow invention as quickly as possible but wants to delay the filing of broader, more complicated claims.[11] Continuation practice allows the inventor to achieve the broadest possible patent protection from the earliest date available.

An inventor may add additional subject matter by filing a continuation-in-part (CIP) application and claim additional material as long as there is priority claim to a prior non-provisional application.[12] The divisional application is also available if the inventor must separate different inventions within the same application.[13] Within two years from the grant of the original patent, an inventor may also file a reissue application and attempt to enlarge the scope of the original claims so he may include disclosed but previously unclaimed subject matter.[14] An inventor may not, however, add new subject matter through the amendment

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recognized that "continuing applications are utilized in a number of different situations." The commentary, however, is silent as to whether an applicant is entitled to file an unlimited number of continuing applications.; 37 C.F.R. § 114 (Request for continued examination); 37 C.F.R. § 1.53(d) (Continued Application Filing Requirements – Continued prosecution (nonprovisional) application); 37 C.F.R. § 1.53(b)(2) ("Continuation-in-part . . . must be filed under this paragraph"); 37 C.F.R. §§ 1.141-146 (Different inventions in one national application).

[10] 35 U.S.C. § 120 (Benefit of earlier filing date in the United States).

[11] 37 C.F.R. § 1.53(b)(2).

[12] *Id.*; MPEP 201.08.

[13] 35 U.S.C. § 121; 37 C.F.R. §§ 1.141-146.

[14] 35 U.S.C. § 251; 37 C.F.R. §§ 1.171-1.179.

process.[15] The inventor may only amend claims to capture broader claims if the technology was previously disclosed in the application.[16]

If a continuation patent is filed in place of the original patent, the original application is referred to as the "parent" to the one or more "child" applications, known as continuation applications. Continuation applications must be filed while the parent application is pending, that is, before the prosecution of the parent application in the USPTO has been terminated, either by abandonment of the application or by issuance of the application into a patent.[17] The familial patent lineage can remain in prosecution for years creating opportunities for unscrupulous inventors to use the continuation process to surprise competitors with infringement cases.[18] Recent cases and congressional patent reform efforts have attempted to curtail continuation practice.[19]

Infringement occurs when the accused device fits within the patented claims. [20] In a typical infringement suit, the claim language is interpreted before the facts of an infringement are assessed.[21] Once interpreted, the claimed invention is compared to the accused device to

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[15] 35 U.S.C. § 251.

[16] 37 C.F.R. § 1.121.

[17] 37 C.F.R. § 1.53.

[18] Symbol Technologies, Inc. v. Lemelson, 277 F.3d 1361 (Fed. Cir. 2002) (upholding the equitable defense of laches in a patent infringement suit).

[19] *Id.*; See Patent Reform Act of 2005, H.R. 2795, 109th Cong. (2005); Patent Reform Act of 2007 H.R. 1908, S. 1145, 110th Cong. (2007); Patent Bill includes, among other things, first-inventor-to-file, post-grant opposition procedure provisions.

[20] 35 U.S.C. § 271(a) (Infringement of patent); Merrill v. Yeomans, 94 U.S. 578 (1877).

[21] Markman v. Westview Instruments, Inc., 52 F.3d 967, 970, 976, (Fed. Cir. 1995) (*Markman I*) *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996) (*Markman II*) ("An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the

determine if infringement exists.[22] Defense to infringement usually comes in the form of an attempt to invalidate the patent at issue through a declaratory judgment.[23]

Mr. Nouri E. Hakim, (Hakim) an inventor and part owner of Luv N' Care Ltd., sued his rival Cannon Avent Group, PLC, (Avent) for infringement of his patented sippy-cup technology.[24] The court interpreted the claimed invention to determine whether Mr. Hakim's patent was infringed by Avent.[25] Avent argued that Hakim's patents were not infringed due to arguments made during the prosecution of the patents that limited the patented invention such that Avent did not infringe.[26] Avent was successful in defending their product and the injunction Hakim petitioned for was denied.[27]

The confusing Court of Appeals of the Federal Circuit (CAFC) *Hakim* opinion left considerable room for interpretation and presented the possibility that many issued patents will be invalidated due to insufficiently clear arguments made during the prosecution of a continuation patent.[28] On the surface, the *Hakim* seemed to ignore various challenges to the validity of the patent at issue while creating new patentability rules contrary to allowable

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properly construed claims to the device accused of infringing. It is the first step, commonly known as claim construction or interpretation, that is at issue in this appeal.").

[22] *Id.*

[23] Declaratory Judgment Act 28 U.S.C. § 2201 (2000); MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007) (Stating that standing for a declaratory judgment to invalidate a patent only requires that the interests of the parties be adverse.).

[24] Hakim v. Cannon Avent Group, 479 F.3d 1313 (Fed. Cir. 2007).

[25] *Hakim*, 479 F.3d 1313.

[26] *Id*. at 1317.

[27] *Id*. at 1318.

[28] *Id.* (Stating "the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, the prior art that it was made to avoid, may need to be revisited.").

statutory rules.[29] Following precedent, the CAFC stated that the inventor may not broaden his invention claims if the inventor did not, with *sufficient clarity*, rescind previously disclaimed aspects of the invention during prosecution.[30] A detailed reading and analysis of the patent, statues, and precedent provides the reader with the understanding that the CAFC holding was correct and did not create a new rule but should have invalidated the patent entirely. *Hakim* makes clear that practitioners must clearly articulate any attempt to recapture disclaimed subject matter, especially during continuation applications. Practitioner should also review existing patents derived from such applications to assess any associated risks.[31]

THE TECHNOLOGY OF THE SIPPY-CUP IS EXTREMELY SIMPLE[32]

Mr. Hakim sued Avent in the United States District Court for the Western District of Louisiana, asserting infringement of his United States Patents No. 6,321,931 (the '931 patent) and No. 6,357,620 (the '620 patent), by Avent's leak-resistant drinking cups.[33] The patented technology defined in the '931 patent defines drinking cups for children that prevent spilling even when the cup is tipped over.[34] Mr. Hakim's patented cups incorporate a valve through

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[29] *Hakim*, 479 F.3d 1313; Hakim v. Cannon Avent Group, 2005 U.S. Dist. LEXIS 16830 (W.D. La. May 3, 2005) (citing Hakim v. Cannon Avent Group, 2005 U.S. Dist. LEXIS 16827 (W.D. La. Feb. 2, 2005) (Kirk, J., Magistrate Opinion)).

[30] *Hakim*, 479 F.3d at 1318 (citing Springs Window Fashions L.P. v. Novo Indus., *L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003) ("The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent.")).

[31] *Hakim*, 479 F.3d at 1318.

[32] *Hakim*, 2005 U.S. Dist. LEXIS 16830 (citing *Hakim*, 2005 U.S. Dist. LEXIS 16827, *19 ("The 'technology' involved in the devices at issue is extremely simple . . .")).

[33] *Hakim*, 479 F.3d 1313; No-Spill Drinking Cup Apparatus, U.S. Patent No. 6,321,931 (filed Aug. 22, 1998); No-Spill Drinking Cup Apparatus, U.S. Patent No. 6,357,620 (filed Mar. 18, 1999).

[34] '931 Patent col.1 l.18.

which fluid can pass when the user draws on the drinking spout.[35] The valve incorporated a central "slit" type passage in a flexible diaphragm.[36] When a child creates a vacuum by sucking on the spout, the diaphragm moves off the blocking element and stretches, the slit opens, and the valve allows fluid to flow to the child.[37]

When not in use, in its relaxed state, the slit closes and rests against a flat surface on a blocking element.[38] The closure of the slit as it rests on the blocking element closes (seals) the valve to prevent accidental spilling.[39] The interaction between the diaphragm and the blocking element in conjunction with the closing of the slit provides a robust, redundant sealing mechanism in the valve.[40]

The '931 patent claimed a centrally located valve in a flexible diaphragm, but just before the patent was issued, the term slit was replaced with the broader term "opening".[41] The change came about when the original application was abandoned and the '931 continued patent application ('931 CPA) was initiated.[42] Upon filing the '931 CPA, a letter to the examiner expressly declared Mr. Hakim's intent to "broaden" claims one and two by using the term

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[35] *Id.* at col.9 l.43.

[36] *Id.* at col.1 l.60.

[37] *Id.* at col.1 l.56.

[38] *Id*. at col.1 l.63.

[39] U.S. Patent No. 6,321,931 col.2 l.8 (filed Aug. 22, 1998).

[40] *Id*.

[41] *Hakim,* 479 F.3d at 1316.

[42] *Id.*

opening in lieu of the term slit.[43] The examiner acquiesced; no new patentability arguments were presented and no further examination was conducted to analyze the broader claims.[44] The '931 patent was issued with the broadened claim term, opening, in place of a slit.[45] This article focuses primarily on the '931 patent and the confusing opinion surrounding it.

Although not discussed in detail here, the valve in Hakim's subsequent Continuation-In-Part ('620 CIP) patent also utilizes a centrally located valve which incorporates a flexible diaphragm.[46] However, the cup included an opening in the form of a circular hole.[47] In the closed position, the hole in the diaphragm rests around a plastic conical head that seals the hole to prevent fluid flow.[48] Perhaps coincidentally, Avent's accused drinking cup also has a centrally located valve in a flexible diaphragm and a hole in the diaphragm identical to the '620 patent.[49] From the initial Hakim Patent application, to the final '620 patent, Hakim's Luv N' Care® Sippy-Cup patents progressed to totally cover the Avent sippy-cup design. Ultimately, the '620 patent was held as invalid as anticipated by a prior Italian patent.[50]

THE COURTS NARROWED THE HAKIM SIPPY-CUP INVENTION AND FOUND NO INFRINGEMENT BY AVENT

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[43] *Id*.

[44] *Id*.

[45] *Id*.

[46] U.S. Patent No. 6,357,620 col.1 l.51-64 (filed Mar. 18, 1999).

[47] *Id*.

[48] *Id*.

[49] *Id*.

[50] '620 Patent; *Hakim*, 479 F.3d at 1320.

Both the district court and the CAFC found common ground in granting Avent's motion for summary judgment and non infringement of the '931 patent.[51] Understanding their holdings requires a discussion on the prosecution of the '931 patent and the logic the courts used to find for Avent. Clarity is only obtained by decoding Hakim's disclaimer in terms of the language in the claimed '931 invention.[52]

After filing suit, the district court denied Hakim's request for a *Markman* claim construction hearing and referred Avent's request for summary judgment to a U.S. Magistrate Judge for a claim construction ruling and recommendation.[53] Magistrate Judge James Kirk noted that, during prosecution, the U.S. Patent Office rejected Hakim's first abandoned patent application that claimed slits.[54] In response, Hakim differentiated his technology from four known prior art patents by highlighting his two-mechanism design which ultimately became the '931 patent through a continued prosecution application (CPA).[55]

The district court acknowledged Hakim's differentiating design as a claim limiting statement to the '931 patent that arose out of the abandoned parent application prosecution arguments: "The prosecution history makes perfectly clear that Hakim specifically distinguished his invention from the prior art *by limiting it to* an apparatus with both (1) *a slit w*hich closes when suction is not applied, and (2) a second closure consisting of a blocking element which the

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[51] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *19; *Hakim*, 479 F3d at 1318.

[52] U.S. Patent No. 6,321,931 (filed Aug. 22, 1998).

[53] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *20; See generally, *Markman,* 52 F.3d at 976 (Fed. Cir. 1995) (A pre-trial hearing where a judge hears testimony from both parties on the appropriate meanings of the relevant key words used in the patent's claim language. The outcome yields definitions for use in related infringement cases.)

[54] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *13.

[55] *Id.*; 37 C.F.R. § 1.53(d) (Continued Application Filing Requirements – Continued prosecution (nonprovisional) application).

slit rests against."[56] In support of Hakim's two-mechanism valve design, the '931 patent described a "blocking element" and the internal mating surfaces of a slit, "X-shaped slot", or "T-shaped slot" in the diaphragm for sealing off the liquid.[57] Hakim countered that he was not limited by the two-mechanism disclaimer due to the letter to the examiner in the CPA of the '931 patent which expressly broadened slit to opening in the claimed invention.[58]

The district court declared "Whether the valve flow area is considered 'slits' or just 'openings' was beside the point."[59] The district court saw that Avent's valve design utilized a hole (an opening) in a flexible diaphragm that seals around a conical protrusion and since the hole never closes and seals off liquid, by itself, the design incorporated only a single sealing mechanism.[60] By implication, a single-mechanism valve utilizes an opening or a hole in the valve diaphragm and a two-mechanism valve design incorporates a slit, cross, or T. If the '931 two-mechanism sippy-cup valve apparatus utilized a hole or opening instead of a slit, the valve is transformed into a single-mechanism design and the Avent design would infringe. Logically, if the '931valve was interpreted as a single-mechanism design it must therefore have an opening or hole instead of a slit and, as the district court articulated, the Hakim patent would be anticipated under §102 by at least four other patents.[61] The use of an opening or a slit was dictated by the inventor's selection, by disclaimer, of the single-mechanism valve design. Thus, the use of a

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[56] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *12.

[57] '931 Patent col.9 l.6.

[58] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *15.

[59] *Id.* at *14.

[60] *Id.* at *17-18.

[61] *Id*.

two-mechanism valve design is not mutually exclusive of the slit and cannot be isolated or disclaimed separately and the use of an opening or slit is immaterial.

The district court did not expressly describe this logic but ultimately used it to conclude that Avent's invention did not infringe on the '931 patent.[62] Since Avent valve design used only single-mechanism to prevent sippy-cup spillage and the '931 was limited to a two-mechanism design, the Avent design does not fall within the bounds of the '931 claim language.[63] The district court granted Avent's motion for summary judgment and dismissed Hakim's complaint with prejudice and Hakim appealed.[64]

The CAFC agreed with the district court claim construction analysis and the distinguishable valve designs as described during the prior art arguments.[65] The CAFC also chose to address Hakim's proffered rebuttal that the broader claims created in the '931 CPA effectively erased the disclaimer in the abandoned parent application.[66] However, in analyzing the claims of the '931 patent, the CAFC also limited the '931valve to slit in the diaphragm and distinct from all United States and foreign patents.[67] The CAFC stated: "Because Hakim did not retract any of his arguments distinguishing the prior art, he is held to the restrictive claim construction he argued during prosecution of the patent."[68]

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[62] *Id*.

[63] *Id.*

[64] *Hakim*, 2005 U.S. Dist. LEXIS 16830, *15.

[65] *Hakim*, 479 F.3d at 1318.

[66] *Hakim*, 479 F.3d at 1315.

[67] *Id*. at 1316.

[68] *Id*.

To counter, Hakim once again argued that he informed the examiner that the new claims in the continuation were broader than those previously allowed through a letter to the examiner and should be presumed valid.[69] The CAFC disagreed and affirmed the district court's ruling of no infringement based on the disclaimer.[70] The CAFC also stated that Hakim had the right to re-file the application and attempt to broaden the claims.[71] However an applicant cannot recapture claim scope that was surrendered or disclaimed in his original patent application.[72] Hakim's disclaimer could have been rescinded to recapture the disclaimed feature. However, the prosecution history must be "*sufficiently clear"* to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited**.**[73] Thus, the letter to the examiner was not sufficiently clear to reclaim the disclaimed broader language once present in the parent application and the term opening was summarily limited to a slit.[74]

The CAFC ruled that the district court did not err in holding that the examiner's allowance of the '931 continuation claims was based on the prosecution argument and that no

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[69] *Id*. at 1317.

[70] *Id*. at 1318.

[71] *Hakim,* 479 F.3d at 1318 (citing Symbol Technologies, Inc. v. Lemelson, 277 F.3d 1361 (Fed. Cir. 2002)).

[72] *Hakim*, 479 F.3d at 1317 (citing Omega Engineering, Inc. v. Raytek Corp*.,* 334 F.3d 1314, 1324 (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.").

[73] *Hakim*, 479 F.3d at 1318 (citing Springs Window Fashions L.P. v. Novo Indus*., L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003) ("The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent.").

[74] *Hakim*, 479 F.3d at 1318.

further prosecution was necessary.[75] The CAFC also held that the district court properly construed and limited the term opening to mean a valve mechanism in the form of a slit in the diaphragm.[76]

The logic behind the *Hakim* infringement analysis provides a basis to understand other arguments that support ruling for Avent.[77] Other arguments described below also provide justification for invalidating the '931 patent entirely.

MANY PROBLEMS WITH THE *HAKIM* OPINION

Hakim is widely viewed among patent attorneys as a devastating restriction of the applicant's right to pursue broader claim scope through conventional continuation practices.[78] This article suggests that the *Hakim* ruling was correct but the CAFC's incomplete analysis was unnecessarily confusing.[79] Although the logic was not clearly articulated and incomplete, the CAFC court correctly applied the rules set forth in precedent.[80] The case highlights the need to make very clear rescissions of prior disclaimers and spotlighted onerous patent prosecution

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[75] *Id.*

[76] *Id.*

[77] *Hakim*, 479 F.3d. at 1318.

[78] See Patently O Patent Law Blog, Recapture: Disclaimer in Parent Must be Rescinded in Continuation, http://www.patentlyo.com/patent/2007/02/recapture_discl.html (7/28/2008 2:15:30 PM); also see Patent Docs Biotech & Pharma Patent Law & News Blog, http://www.patentdocs.net/patent_docs/2007/02/narrowing_the_s.html (7/28/2008 2:23:31 PM); also see FedCirc.us http://www.fedcirc.us/case-reviews/hakim-v.-cannon-avent-group-plc-et-al-3.html (7/28/2008 2:20:26 PM); 37 CFR 1.53 (d) Application Filing Requirements – Continued Prosecution (nonprovisional) application.

[79] *Hakim*, 479 F.3d at 1318 (Fed. Cir. 2007).

[80] *Hakim* 479 F.3d (citing *Omega*, 334 F.3d 1314 and *Springs*, 323 F.3d 989).

requirements.[81] Patent lawyers also justifiably fear that long forgotten prosecution arguments may rise up to challenge many issued patents in court.[82]

At the heart of confusion is the general belief that the broader claim term opening should have been allowed through normal continuation practices in place of the term slit.[83] *Hakim* did not clearly explain the application of prosecution history disclaimer doctrine to continuation applications, particularly, where the purported disclaimed element was a broader element.[84] Also, the CAFC's opinion failed to clearly articulate why Hakim's argument that his broader CPA claims requested in his letter to the examiner did not overcome the narrowing disclaimer in the parent application.[85]

The CAFC's holding becomes clearer through a detailed discussion on claim construction, disclaimer rescissions, and use of prosecution disclaimer in familial patent applications. However, the holding is not supported when the case is analyzed in view of statutory written description requirements and the USPTO rules surrounding a CPA when seeking to broaden claims. The arguments contrary to the court's noninfringement ruling support complete invalidation of Hakim's '931 patent.

Claim Construction Analyses Support Validity, No Infringement

The district court and CAFC agreed a claim construction analysis revealed no infringement of the '931 patent and interpreted the claims based on prosecution argument

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[81] *Hakim*, 479 F.3d at 1318.

[82] *See supra* note 76.

[83] *Id*.

[84] *Hakim,* 479 F.3d at 1318 (Fed. Cir. 2007).

[85] *Id*.

disclaimers which distinguished it from prior inventions.[86] Further detailed claim construction analysis enlightens the reader and supports the unstated logic behind the *Hakim* opinion of noninfringement.[87] Claim construction analysis using historically recognized cannons of claim construction provide further support and a foundation for subsequent discussions on the written description requirement, prosecution history disclaimers, and patent continuation practice.

The patent codes and regulations stemming from the Constitution were created to spur economic growth through technological achievement, regulate and facilitate recording of the inventor's property rights, and provide public notice as to the protected property rights generated by the patent.[88] As early as the 1880s, the Supreme Court emphasized the importance of a patent's claims. The Supreme Court stated in *Miller*: "The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed."[89] In 1884, the Court later elaborated the concept of a claim in *Mahn:*

> "[T]he claim actually made operates in law as a disclaimer of what is not claimed; and of all this the law charges the patentee with the fullest notice . . . [O]f course, what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent."[90]

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[86] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *15; *Hakim*, 479 F.3d at 1318.

[87] *Hakim*, 479 F.3d. at 1318.

[88] U.S. Const. art. I, § 8, cl. 8; 35 U.S.C. § 2 (a)(2) ("The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce . . . shall be responsible for disseminating to the public information with respect to patents and trademarks.").

[89] Miller v. Bridgeport Brass Co., 104 U.S. 350, 352 (1881).

[90] Mahn v. Harwood & Others, 112 U.S. 360, 361 (1884).

The patent rules clearly state that the public patent claims, not the specification, provide the measure of the patentee's right to exclude.[91] The words of a claim are generally given their ordinary and customary meaning.[92] The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention."[93] Analyzing "how a person of ordinary skill in the art understands a claim term" is the starting point of a proper claim construction.[94] "Because the patentee is required to 'define precisely what his invention is', it is 'unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms'."[95]

After gaining a level of understanding of the application, the USPTO examiner completes a prior art search and compares the application's claims to any relevant prior art found.[96] The communication record between the examiner at the USPTO and the inventor applicant or his legal representative is called the "prosecution history" and is publicly available.[97] The public patent prosecution record allows the public to view what is not being claimed by reading the

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[91] Milcor Steel Co. v. George A. Fuller Co., 316 U.S. 143, 146 (1942) ("Out of all the possible permutations of elements which can be made from the specifications, he reserves for himself only those contained in the claims.").

[92] Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).

[93] *Phillips*, 415 F.3d at 1312, 1313.

[94] *Id*.

[95] *Phillips*, 415 F.3d at 1312 (quoting White v. Dunbar, 119 U.S. 47, 52 (1886)).

[96] 35 U.S.C. § 131 (Examination of application).

[97] The prosecution history for many patents is available on the USPTO website. *See* USPTO, Patent Application Information Retrieval, http://portal.uspto.gov/external/portal/pair (last visited May 1, 2008).

disclaimers and any disclaimer rescissions in the patent's prosecution record.[98] The doctrines of prosecution history estoppel and disclaimer serve to enhance the public notice function as the practice seeks to avoid recapture of prior public dedications of inventions created during the patent prosecution effort before the USPTO.[99]

USPTO examiners give the claims their broadest reasonable interpretation but if the invention as a whole, or any individual claims, are not novel, or are obvious in light of the prior art, the examiner rejects the claims.[100] To overcome the rejection, the applicant may amend the patent application by clarifying or narrowing the claims at issue.[101] The applicant may also attempt to explain why the prior art is not the same as the proposed claim.[102] The patentability arguments between the inventor and the examiner provide additional intrinsic evidence for use by courts to assess patent validity and infringement claims.[103]

The court determines infringement by construing the issued claims and then applying that construction to the accused product.[104] An inventor (patentee) may act as his own lexicographer

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[98] Gillespie v. Dywidag Sys. Int'l., 501 F.3d 1285, 1291**,** 84 U.S.P.Q.2d 1051, XYZ (Fed. Cir. 2007) ("The patentee is held to what he declares during the prosecution of his patent."); Springs Window Fashions L.P. v. Novo Indus., L.P., 323 F.3d 989, 995 (Fed. Cir. 2003).

[99] *Omega Engineering, Inc.*, 334 F. 3d at 1323; Southwall Technologies., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed Cir. 1995).

[100] 35 U.S.C. §§ 100-212 (Part II – Patentability of Inventions and grant of patents).

[101] 37 C.F.R. § 1.121 (Manner of making amendments in applications); Claims may also be rejected on other grounds, and the same amendment procedure would apply.

[102] 37 C.F.R. § 1.111 (Reply by applicant or patent owner to a non-final Office action).

[103] *Markman*, 52 F.3d at 979-80.

[104] W. L. Gore & Assocs., Inc. v. Garlock, Inc., 842 F.2d 1275, 1279 (Fed. Cir 1988); Business Objects, S. A. v. Microstrategy, Inc., 393 F.3d 1366 (Fed. Cir. 2005); *Markman*, 52 F. 3d at 976.

and define a claim term differently from its ordinary meaning.[105] In court however, claim construction interpretation is a question of law and not for the trier of facts to decide.[106] In determining the meaning of disputed claim language, the court looks in order: the intrinsic evidence of record, the claim language itself, the specification then, the prosecution history.[107] "[I]ntrinsic evidence, including the patent's claims, specification, and prosecution history, is the most significant source of the legally operative meaning of disputed claim language."[108] Although the specification does not define the invention, the specification is always highly relevant to the claim construction analysis and is the single best guide to the meaning of a disputed term.[109] The public prosecution history is analyzed to avoid claim constructions that recapture inventions disclaimed during prosecution of the patent.[110] Ultimately, the court's claim construction analysis yields the legal meaning of the disputed claims then the court uses that legal meaning to determine whether a defendant is infringing.[111]

As noted by the CAFC, the intrinsic record revealed that Hakim differentiated his invention from the prior art during prosecution to differentiate the '931 invention from known prior art:

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[105] Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578 (Fed. Cir. 1996); *Vitronics Corp.*, 90 F.3d at 1582.

[106] *Markman*, 517 U.S. at 370.

[107] Alza Corporation v. Mylan Laboratories Inc. et al, 391 F.3d 1365, 1370 (Fed. Cir. 2004).

[108] *Vitronics*, 90 F.3d at 1582.

[109] *Phillips*, 415 F.3d at 1315; *Vitronics*, 90 F.3d at 1582.

[110] *Omega Engineering, Inc,* 334 F. 3d at 1314; *Southwall Technologies., Inc.,* 54 F.3d at 1576.

[111] *Gore*, 842 F.2d at 1279.

> "[T]wo separate mechanisms are both used to close off the passage of liquid through the valve when not in use. The first mechanism involves an inverting, flexible valve material which has a slit therein and responds to suction. The second mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, to yet further prevent the passage of liquid through the valve."[112]

Hakim further argued "by providing both the elastomeric member with a slit and a blocking element, a sealing mechanism is provided which reduces spillage beyond that of either mechanism alone".[113]

As a result of the design distinction argued during prosecution arguments, the district court recognized the disclaimer:

> "The prosecution history makes perfectly clear that Hakim specifically distinguished his invention from the prior art by limiting it to an apparatus with both (1) *a slit which closes when suction is not applied*, and (2) *a second closure consisting of a blocking element which the slit rests against*."[114]

The district court used the prosecution history to interpret the disputed claim language and limited Hakim's invention to a two-mechanism design with a slit for purposes of an infringement analysis against Avent's design.[115]

Extrinsic evidence such as reference books or expert testimony may only be considered to enhance the court's understanding of a terms meaning and may not be used to contradict the intrinsic evidence.[116] The district court ruled that it was not necessary for the court to examine

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[112] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *11.

[113] *Id.* at *12.

[114] *Id.* (emphases added).

[115] *Id.* at *14.

[116] EMI Group N. Am., Inc. v. Intel Corp., 157 F.3d 887, 892 (Fed. Cir. 1998); Mantech Envtl. Corp., v. Hudson Envtl. Servs., Inc., 152 F.3d 1368, 1373 (Fed. Cir. 1998).

extrinsic evidence and analyze whether the patent used the term opening or slit because it was clear that the Hakim patent required two separate mechanisms to close off the liquid.[117] The accused Avent sippy-cup technology did not require two separate mechanisms and therefore no infringement of the '931 patent existed.[118]

Further, the district court stated if the court did not to construe the patent in this manner, then the invalidity of the Hakim patent '931 was assured for Hakim's patent would be no more than a duplication of the prior art, which included at least four prior patents.[119] If Hakim had not previously differentiated his invention by arguing that it involved two mechanisms, he would have had no patent at all because it would have been anticipated by the prior art.[120] The district court said it was not necessary to find the '931 patent was anticipated by others and invalid but instead ruled that Avent did not infringe the Hakim invention.[121]

In analyzing the '931 claim language, the CAFC held the district court did not err when the district court ruled the word opening was restricted as a slit.[122] The district court was correct applying the doctrine of prosecution history disclaimer to restrict the use of the broader claim language and strike down Hakim's attempt to overcome the two-mechanism valve disclaimer

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[117] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *19.

[118] *Id.* at *17.

[119] *Id.* at *18 ("The concept of a flexible diaphragm with a hole in it which rests against a blocking element to shut off the flow of liquid when pressure (sucking) is not applied, has been known since at least 1959 and is the subject of at least four patents. *35 U.S.C. 102(b)*. The first is the EP '828 European patent, the second is the IT '286 Italian patent, the third is the Robbins III U. S. patent, copies of which appear at Defendants' Exhibits 2, 3, and 15, respectively, and the fourth is the Belcastro patent…").

[120] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *19.

[121] *Id.*

[122] *Hakim,* 479 F.3d at 1318.

and subsequent limitation.[123] In doing so, the CAFC acknowledged the distinctions between the Hakim and Avent technologies and Hakim's disclaimed single-mechanism in which utilized an opening instead of a slit.

In analyzing claim language several cannons of claim construction are well recognized by the courts and used to assess disputed claim language. One holds that patent claims are presumed valid which requires claims be construed so as to maintain validity if possible.[124] When there is a choice between two possible claim constructions, one that would render the claim invalid and one that would preserve validity, the court should choose the latter absent a compelling reason not to.[125] This may require a narrow claim construction, which is the opposite of the patent examiner that interprets as broadly as possible.[126]

This does not mean that courts are allowed to rewrite claim language to maintain validity.[127] *Rhine* stated "where the only claim construction that is consistent with the claim's language and the written description renders the claim invalid, then the axiom does not apply and

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[123] *Id*.

[124] 35 U.S.C. § 282 ("[a] patent shall be presumed valid"); Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1384 (Fed. Cir. 2001).

[125] *Id*.

[126] MPEP § 2106(C) ("[o]ffice personnel are to give claims there broadest reasonable interpretation in light of the supporting disclosure").

[127] Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 911 (Fed. Cir. 2004).

the claim is simply invalid."[128] However, after a claim construction analysis renders the patent invalid, the court will not apply a narrowing limitation to save the patent.[129]

Claims with slits would not render the patent invalid under *Rhine*, the cannon requires an interpretation that construes validity.[130] However, preserving validity of the '931 patent resulted in a lack of infringement by Avent.[131] Also, any attempt to broaden the claims with the term opening would ultimately invalidate the patent as anticipated under §102 by at least four prior patents.[132] Under the cannon of construction, the court correctly interpreted the opening as a slit to preserve validity. The court's noninfringement ruling was fully supported by the cannon; Hakim's desire to broaden the claims language with the CPA by making it a single-mechanism design was properly rejected by the court.

Another helpful claim construction canon deals with claim differentiation.[133] The cannon instructs that no two claims in the same patent should be interpreted to have the same scope.[134] A patent often includes sets of claims of varying scope.[135] For example, one dependent genus

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[128] Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed. Cir. 1999); E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1434 (Fed. Cir. 1988) (emphasizing that claims are not "to be 'saved' from invalidity by reading extraneous limitations into them").

[129] *Liebel-Flarsheim*, 358 F.3d at 911; *Karsten*, 242 F.3d at 1384; *E.I. du Pont*, 849 F.2d at 1434.

[130] *Rhine*, 183 F.3d at 1345.

[131] *Hakim,* 479 F.3d at 1318.

[132] 35 U.S.C § 102; *Hakim*, 479 F.3d at 1318.

[133] Mark A. Lemly, *The Limits of Claim Differentiation*, 22 Berkeley Tech L.J. 1389, (2007) (discussing the cannon of claim differentiation and its limits).

[134] *Id.*

[135] *Id.*; Karsten, 242 F.3d at 1385 ("it is customary for patentees to present claims of varying scope or stated in a variety of ways").

type claim may include all possible embodiments presented in the specification while another dependent claim may cover one specific embodiment, or species, of the invention. The cannon of claim differentiation requires that the language of the specific claim should not limit the scope of the genus claim.[136]

To apply the cannon of claim differentiation to the '931 patent, the patent must include such claims that requires interpretation. In fact, the '931 patent includes independent claim five which requires an opening and dependent claim six which requires a slit.[137] The cannon requires the court to accept the broader term opening as a genus while interpreting the narrower terms such as slit, cross, and T as mere species of the genus.[138] Application of the cannon of claim differentiation however, is not possible because, as discussed above, doing so would violate the cannon of patent validity. The patent would fail §102 as anticipated by the known prior art.[139] So, again, Hakim is stuck with the two-mechanism claim interpretation and limited to a slit in every claim.

The above represents a brief discussion on claim construction using two of the cannons used to interpret patent claims. A more detailed analysis of the other cannons is beyond the scope of this article. The claim interpretation methods used by the district court and the CAFC reconcile and affirm their respective holdings of patent validity and noninfringment.[140] Whether examined through use of the prosecution disclaimer doctrine, presumption of validity cannon, or

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[136] *Id.*

[137] U.S. Patent No. 6,321,931 col.10 l.11-30 (filed Aug. 22, 1998) (claims 5 and 6).

[138] Lemley, *supra* note 131.

[139] 35 U.S.C § 102.

[140] *Hakim*, 2005 U.S. Dist. LEXIS 16830; *Hakim*, 479 F.3d at 1318.

claim differentiation doctrine, the '931 claims do not support Hakim's claim of infringement. Any other interpretation would result in a patent that is invalid as anticipated by multiple prior inventions under §102.[141]

Written Description Limitations Support Patent Invalidity

An analysis of the '931 patent specification reveals another argument to reject the broadening of the '931 Hakim patent and invalidate it entirely. Written description issues can arise when a claim is narrowed or broadened.[142] The written description requirement can be an issue in at least four situations: 1) amended claims in an original application; 2) claims in a continuation seeking the earlier filing date of a parent application; 3) claims copied for an interference action and 4) in reissue situations.[143] An examination of Hakim's '931 specification reveals that the claims are not supported by the '931 specification in violation of §112.[144] As a result, Hakim could not obtain the priority date of his original application, and his '931 CPA was invalid for lack of proper written description.

The Patent Act §112 requires patents to include a specification supportive of the claimed invention:

> §112. Specification
> "The 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

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[141] 35 U.S.C. § 102.

[142] Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993); Gentry Gallery, Inc. v. The Berkline Corp, 134 F.3d 1473 (Fed. Cir. 1998); US Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp., 315 U.S. 668 (1942).

[143] In re Wilder, 736 F.2d 1516 (Fed. Cir. 1984), cert. denied 469 U.S. 1209 (1985); Fields v. Conover, 443 F.2d 1386 (CCPA 1971); In re Smith, 481 F.2d 910 (CCPA 1973).

[144] 35 U.S.C. § 112 (Specification).

same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."[145]

Cases involving the written description requirement of Patent Act § 112 are most often intertwined with issues of priority, covered in § 120 and the question of new matter codified in § 132.[146] These sections read as follows:

> §120. Benefit of Earlier Filing Date in the United States
> "An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . ., which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."[147]

> §132. Notice of Rejection; Reexamination
> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. *No amendment shall introduce new matter into the disclosure of the invention*."[148]

It's important to note that the written description requirement of §112 is distinct from the statutory new matter prohibition of § 132.[149] New matter rejections are more appropriate for

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[145] 35 U.S.C. § 112.

[146] 35 U.S.C. § 112; 35 U.S.C. § 120; 35 U.S.C. § 132.

[147] 35 U.S.C. § 120.

[148] 35 U.S.C. § 132 (emphasis added).

[149] 35 U.S.C. § 112; 35 U.S.C. § 132.

changes to the specification.[150] Thus, an amended claim can be rejected for failing to have an adequate written description but not as new matter.

These statutes require the inventor to describe the invention to the public so that they may rely on it upon expiration of the patent. Continuations are allowed as long as the claims are supported in the written description as the application was originally filed.[151] The law does not allow the patent to extend through broadening amendments beyond the invention described and explained as the statute requires.[152] Section 132 states that an applicant who continues to prosecute an application cannot add any new matter to the application disclosure (i.e. the written description of the invention).[153] Section 120 allows an inventor to file a "continuation application" and to have the new application keep the original filing date (of the parent) provided that the claims in the continuation application are supported by the original description in the parent application.[154] Applicants who wish to add new material to their specifications must file

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[150] In re Rasmussen, 650 F.2d 1212 (CCPA 1981).

[151] Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 58 (1938) (citing Permutit Co. v. Graver Corporation, 284 U.S. 52, 57, 60 (U.S. 1931) ("The object of the [written description] statute is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and 'to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.").

[152] *Id.* ("[T]he application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened."); Snow v. Lake Shore & M. S. Ry. Co., 121 U.S. 617 (1887); Railway Co. v. Sayles, 97 U.S. 554, 563, 564 (1878); Powers-Kennedy Corp. v. Concrete Co., 282 U.S. 175, 185-186 (1929); Webster Electric Co. v. Splitdorf Electrical Co., 264 U.S. 463 (1924); Permutit Co. v. Graver Corporation, supra; Crown Cork & Seal Co. v. Gutmann Co., 304 U.S. 159 (1937).

[153] 35 U.S.C. § 132.

[154] 35 U.S.C. § 120

new applications which will have new, later, effective filing dates.[155] Applicants who wish a particular filing date for priority purposes must have satisfied the disclosure requirements of §112 by that date.[156] In summary, whenever a continuation application is in the family chain of a patent, and the patentee desires reliance on the filing date of the parent application that precedes the continuation filing date, the specification of the parent application must contain adequate written description consistent with the claims placed in continuation application.

Broadening of claims is typically performed by omitting a previously recited element from a claim.[157] A patent's claim language and specification words do not have to be identical, but when a claim is narrowed, the issue becomes whether the added feature or limitation is adequately described in the specification.[158] Broadening is more difficult to address because broadening issues focus on whether the specification suggests that the inventor contemplated the invention, in terms of the broadened claim, at the time of filing.[159] Also, *Cooper* states "a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of much narrower scope."[160]

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[155] 35 U.S.C. § 132

[156] *Id.*

[157] See Robert Merges & John Duffy, Patent Law and Policy: Cases and Materials, 300 (LexusNexis Group, 4th ed. 2007).

[158] In re Lukach, 442 F.2d 967, 969 (CCPA 1971); In re Wertheim, 541 F.2d 257, 262, 191; Merges *et al. supra* note 155.

[159] *Gentry Gallery, Inc.*, 134 F.3d 1473; In re Hayes Microcomputer Products Inc. Patent Litigation, 982 F.2d 1527 (Fed. Cir. 1992).

[160] Cooper Cameron Corporation v. Kvaerner Oilfield Products, Inc, 291 F.3d 1317, 1323 (Fed. Cir. 2002) (interpreting *Gentry Gallery, Inc.*, 134 F.3d 1473).

The written description requirement is satisfied when "the test for sufficiency of support in a patent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession (*of the invention*) at the time of the later claimed subject matter."[161] Stated differently, adequate written description support requires the specification clearly describe, to a person having skills in the art, that the applicant has actually invented the claimed invention.[162] In *Hakim*, the CPA changed from a two-mechanism invention to a single-mechanism one makes the claimed invention broader in nature therefore, the issue becomes whether the inventor adequately described and was in possession of the single-mechanism valve at the time of the original application.[163] Failure to adequately describe the new, broad claim (with an opening instead of a slit) in the written description of the parent demonstrates that the inventor did not possess, invent, or disclose the invention and the applicant is justifiably denied the earlier filing date of the parent application.

The '931specification used the terms opening, slit, "T", and "X" interchangeably many times to describe the means to pass liquid to the sippy-cup user. The interchangeable use of the terms therefore supports the notion that Hakim's broadening CPA retained adequate written description support of the parent application. Without consideration of any intrinsic prosecution or extrinsic evidence to define the invention, and presuming that the specification changed little throughout prosecution, the original specification of the abandoned parent application was supportive of a sippy-cup valve that included an opening. Logically then, the Hakim valve claiming an opening in claims one and two as described in the '931CPA and accompanying

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[161] In re Hayes Microcomputer Products Inc. Patent Litigation, 982 F.2d 1527, 1533 (Fed. Cir. 1992).

[162] In re Wertheim, 541 F.2d 257, 262 (C.C.P.A. 1976)

[163] *Hakim*, 479 F.3d 1313.

letter, was adequately supported in the original specification as required by §112.[164] Based on this simple analysis alone, the '931 patent was apparently given the benefit of the earlier effective priority date of the parent application as allowed under § 120 however, the examiners analysis was incomplete.[165]

Based on *Hayes and Cooper,* the examiner actually incorrectly accepted the CPA without further prosecution and absent a determination of whether Hakim actually invented the single-mechanism sippy-cup valve.[166] The effect of using the term opening broadens the claim in which it's used because it effectively eliminates one of the sealing features relied upon to differentiate the invention from prior art. Specifically, the use of the term opening instead of slit changes the invention from a valve that utilizes two sealing mechanisms (the mating slit surfaces and the diaphragm resting against the blocking element) to a design that utilizes only a single sealing element (the diaphragm resting against the blocking element). If the CAFC, assessed whether Hakim was in possession of or invented the single-mechanism design as required by *Hayes*, the prior art would have demonstrated the '931 CPA was not supported with an adequate written description and the patent should have been invalidated by the CAFC.[167]

The '931 patent specification repeatedly provides a description of the invention, which includes a flexible diaphragm used in conjunction with a blocking or closure element, center seal-off , or center stop.[168] The blocking element is also included in multiple claims.[169] The use

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[164] 35 U.S.C. 112.

[165] U.S. Patent No. 6,321,931 (filed Aug. 22, 1998); 35 U.S.C. 120.

[166] *In re Hayes*, 982 F.2d 1527.

[167] *Id.*

[168] '931 Patent col.1-9 specification.

of both the diaphragm and the blocking element describe a method of closing a valve in the absence of a hole in the diaphragm. The patent specification also describes the preferred embodiment where "fluid cannot flow through the closed slit in the valve".[170] No embodiments describe a valve which only utilizes a single sealing element.[171] The '931 specification therefore does not support the broader invention that results from the use of the term opening and does not meet the required written description support required by §112 as interpreted by *Hayes*.[172] Additionally, based on the disclaimed broad claim language, the entirety of the specification, Hakim indicated the invention was much narrower than requested in the CPA so the written description failed the *Cooper* test.[173]

Even if analyzed differently, and provided with an earlier priority date, the '931 patent would be invalid as anticipated by the four cited prior art patents that include a single sealing valve design.[174] The cannon of claim construction which preserves patent validity in conjunction with prosecution disclaimer, which limited the claimed invention to a two-mechanism valve, defeated all other claim interpretations. Since a single-mechanism valve with an opening was not described in the '931 specification, the written description requirement was not satisfied and the '931 CPA should have been rejected and no patent should have been issued.

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[169] '931 Patent col.9-10 claims 1-14.

[170] '931 Patent col.7 ln.60.

[171] '931 Patent col.1-9 specification.

[172] 35 U.S.C. § 112; *In re Hayes*, 982 F.2d at 1527.

[173] Cooper Cameron Corporation v. Kvaerner Oilfield Products, Inc, 291 F.3d 1317 (Fed. Cir. 2002)

[174] *Hakim*, 2005 U.S. Dist. LEXIS 16827, *19; *Hakim*, 479 F3d at 1318.

On The Surface, The CAFC Seemed To Create A New Disclaimer Rule

The CAFC attempted to answer whether Hakim could use the term opening after it was disclaimed during the prosecution effort of the abandoned parent application.[175] Without a detailed critical analysis in light of precedent, *Hakim* seemed to set forth a new rule: continuation patent applications cannot recapture disclaimed broadening claim language if the disclaimed claim language was ineffectively rescinded in a parent patent.[176] Relying on precedent, the CAFC determined Hakim was not allowed to broaden his invention with a CPA if the rescission of the disclaimed feature was not *sufficiently clear* to the examiner.[177] Despite the confused and surprised patent practitioners, the CAFC holding did not create a new disclaimer rule.

The CAFC stated that the applicant may apply the disclaimed terms in a continuation patent if rescinded with sufficiently clear language.[178] Yet placing limits on a patentee's ability to broaden the scope of his invention as development progresses also seemed to go against the constitutional desire to advance the state of the arts and the very letter of the law.[179] When interpreting *Hakim* with full knowledge of precedent, the CAFC remains consistent with existing

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[175] *Id.*

[176] *Id.*

[177] *Id.* citing *Omega Engineering, Inc.*, 334 F.3d at 1324 (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.") ; *Id.* ("Although a disclaimer made during prosecution can be rescinded, permitting recapture of the disclaimed scope, the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited.") (emphasis added).

[178] *Id.*

[179] U.S. Const. art. I, § 8, cl. 8, ("Congress shall have 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."); 35 U.S.C. § 2 (b)(2)(E) ("The office . . . shall recognize the public interest in continuing to safeguard broad access to the United States patent system."); 37 C.F.R. § 1.53, ("A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).").

U.S. Patent Law and merely highlighted a continuation rule that was actually already in place.[180]

Hakim exposed the strain between the public notice and dedication goals of the U.S. patent system and the statutory right to maximize the protection of an invention.[181] The CAFC's holding put patent attorneys on notice that patent prosecution must not only inform the public of what is claimed, but what is not claimed.[182] The resultant potentially onerous patent prosecution practices feared by practitioners will keep the public informed and preserve patent validity.[183]

Precedent Supports "Sufficiently Clear" Rescission of Prosecution Disclaimer

The Hakim case was confusing to practitioners because the CAFC did not allow the patentee to rely on his broadening CPA and accompanying letter to the examiner to rescind his prior disclaimer.[184] The CAFC relied on the public notice aspect of patent law to justify and restate the current disclaimer clarity requirements in continuation practice.[185] If the disclaimer clarity rules were not fully appreciated by patent practitioners prior to *Hakim*, the case clearly enunciates that the clarity rules of disclaimers definitely apply to disclaimer rescissions.[186]

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[180] *Hakim* 479 F3d at 1318; Jonsson v. Stanley Works*,* 903 F.2d 812 (Fed. Cir. 1993); Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973 (Fed. Cir. 1999).

[181] *Hakim*, 479 F.3d 1313 (citing Springs Window Fashions LP v. Novo Indus., L.P., 323 F.3d 989, 995 (Fed. Cir. 2003) "The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent. A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement.")).

[182] *Hakim* 479 F.3d at 1318.

[183] *See supra* note 76.

[184] *Hakim* 479 F.3d at 1316.

[185] *Id.*

[186] *Id.*

The Supreme Court and the CAFC adhere to the principle that the patent claims define the scope of patent protection.[187] "The claims of the patent define the invention to which the patentee is entitled the right to exclude."[188] Claims also provide public notice of the scope of patent protection sought to which the public relies when patenting their invention or making competing products.[189] During prosecution of the patent, the claims give the USPTO examiner, the general public, and potential commercial competitors express notice of what is claimed within the four-corners of the patent.[190]

The prosecution disclaimer doctrine is also well established and allows the court to examine the intrinsic prosecution evidence and construe the meaning of an invention, claim or element.[191] Construing claims based on the arguments made during examination of the prosecution history enhances the public notice function as the practice seeks to avoid recapture of prior interpretations disclaimed during the prosecution effort to avoid statutory patent bars such as novelty or obviousness.[192] Thus, consulting the prosecution history during claim

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[187] *Aro Mfg.*, 365 U.S. at 339 ("[T]he claims made in the patent are the sole measure of the grant . . . ."); *Vitronics Corp., 90 F.3d at 1583* ("the claims, specification, and file history . . . constitute the public record of the patentee's claim, a record on which the public is entitled to rely").

[188] *Phillips,* 415 F.3d at 1312.

[189] Mahn v. Harwood, 112 U.S. 354, 361 (1884) ("The public is notified and informed by the most solemn act on the part of the patentee, that his claim to invention is for such and such an element or combination, and for nothing more.").

[190] *Id*.

[191] *Omega Engineering, Inc.,* 334 F.3d at 1324 ("The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.").

[192] *Omega* 334 F.3d 1314; 35 U.S.C. §§ 102-103.

construction also serves to exclude any interpretation that was disclaimed during prosecution.[193] Further, the public can see what is *not* being claimed through a reading of the disclaimers any rescissions in the patent's historical prosecution record.[194]

Prosecution history is also used to construe claims and ascertain the whether use of the doctrine of equivalents is appropriate.[195] The doctrine of prosecution history *estoppel* is well established and allows competitors in the market to rely on a clear public record of the patent prosecution to learn the meaning and scope of the patent.[196] Prosecution history estoppel is almost identical to the disclaimer doctrine but applies when an inventor attempts to use the doctrine of equivalents. Prosecution history can act to limit the use the doctrine of equivalents by preventing a patentee from arguing equivalence to subject matter surrendered during prosecution of the patent.[197] Prosecution history estoppel equivalents analysis uses the same prosecution disclaimer rules to prevent the patentee from encroaching back into territory that had

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[193] Chimie v. PPG Indus., Inc., 402 F.3d 1371, 1384 (Fed. Cir. 2005); see also *Phillips,* 415 F.3d at 1316-17 ("'the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.'").

[194] *See supra* note 175.

[195] Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo VI)*,* 234 F.3d 558 (Fed. Cir. 2000) (The doctrine of equivalents states that a accused infringer can be liable for patent infringement even though the accused device does not fall within the claimed invention if otherwise equivalent to the plaintiffs device).

[196] *Festo VI*, 234 F.3d 558.

[197] *Id.* at 564 (quoting Pharmacia & Upjohn Co. v. Mylan Pharm., Inc., 170 F.3d 1373, 1376 (Fed. Cir. 1999)); *Omega* 334 F.3d at 1326 ("We note that this is the same standard applicable, in the context of the doctrine of equivalents, to the doctrine of argument-based estoppel, Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449, 1458, 46 USPQ2d 1321, 1327 (Fed. Cir. 1998), and that our precedent has recognized a relation between the doctrines of argument-based estoppel and prosecution disclaimer, Alpex Computer Corp. v. Nintendo Co. Ltd., 102 F.3d 1214, 1221, 40 USPQ2d 1667, 1673 (noting that "just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction").

previously been committed to the public.[198] As with prosecution disclaimer, a patentee is held to a particular claim construction argued during patent prosecution to preserve public reliance on statements made in the public record.[199]

Digging a bit deeper, case law is not indifferent as to narrowing versus broadening disclaimers. "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application".[200] When a patentee disclaims *any* subject matter during the prosecution of the patent, for any reason, the public, and any competitors, will understand that the patentee has dedicated that subject matter to the public.[201] Any attempt to rescind any disclaimer brings the *Hakim* ruling into play requiring sufficiently clear communication to the examiner of the desired rescission.[202]

In *Hakim*, the Federal Circuit stated that "although a disclaimer made during prosecution can be rescinded, permitting recapture of the disclaimed scope, the prosecution history must be *sufficiently clear* to inform the examiner that the previous disclaimer, and the prior art that it was

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[198] Vectra Fitness, Inc. v. TNWK Corp., 162 F.3d 1379, 1384 (Fed Cir. 1998) ("the recapture rule prevents a patentee from regaining through reissue subject matter that was surrendered during prosecution, thus ensuring the ability of the public to rely on a patent's public record")

[199] *See supra* note 193.

[200] Ball Corp. v. United States*,* 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984).

[201] Sage Prods. Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1424 (Fed. Cir. 1997); See also Johnson & Johnston v. R.E. Service Co*.,* 285 F.3d 1046, 1054 (Fed. Cir. 2002) (en banc) (explaining that described but unclaimed subject matter is dedicated to the public).

[202] *Hakim*, 479 F.3d at 1316 (Fed. Cir. 2007) ("Although a disclaimer made during prosecution can be rescinded, permitting recapture of the disclaimed scope, the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited.").

made to avoid, may need to be re-visited."[203] The *sufficiently clear* requirement recited in *Hakim* was merely derived from the disclaimer clarity rules articulated in *Omega* which stated that in order for prosecution disclaimer to attach, the disavowing actions must be both "*clear and unambiguous*."[204] Based on *Omega*, the CAFC properly advanced this requirement to Hakim's '931prosecution effort to preserve the public's reliance on the disclaimed single-mechanism sippy-cup valve design.[205]

Although the CAFC in *Hakim* did not discuss the inadequacies of the Hakim's communication, the CAFC in *Hakim* found that the examiner was not sufficiently informed of Hakim's intended rescission of the disclaimed features and the term opening.[206] Hakim's attempted rescission was inexplicably rejected by the CAFC despite an expressed desire to broaden the invention amongst the three documents including, the letter to the examiner, the CPA, and its amendment. Clearly, in the eyes of the court, Hakim should have done more to establish his intent, however, the CAFC is silent on what constitutes sufficiently clear communication.

If the examiner was sufficiently informed that the requested broadening in the CPA was an attempt to recapture a past disclaimer in the parent application and that the prior art might need re-examined, then Hakim would have met the required, yet undefined, level of

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[203] *Id.* (emphasis added).

[204] *Id.*; *Omega Engineering, Inc.,* 334 F.3d at 1325 (citing Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1369 (Fed. Cir. 2003) ("The prosecution history does not show any clear and unambiguous disavowal of steps in advance of the step of growing *E. coli* cells in the claimed temperature range.").

[205] *Id.*

[206] *Hakim*, 479 F.3d at 1318.

communication. However, as discussed below, further analysis demonstrates that the '931 patent should never have been issued and used to expend the courts resources in this infringement suit.

Precedent Supports Use of Prosecution Disclaimer Doctrine In Familial Patents

The major concern with *Hakim* arose because the CAFC applied the disclaimer clarity rules to Hakim's disclaimer in his CPA of '931.[207] The well established practice of broadening scope through continuation practice is recognized in *Hakim* but the court only discussed recapture of disclaimed material as it related to the re-issue procedure.[208] *Hakim* skips a crucial discussion on the application of the doctrine of prosecution disclaimer in conventional continuation practice.[209]

The CAFC in *Hakim* stated that prosecution history estoppel applies to single patent cases as well as continuation patents.[210] Unfortunately, none of the cited cases were that of a continuation application. *Omega* involved a CIP application but the disclaimed feature was wholly within the prosecution of the child CIP.[211] *Schriber-Schroth* involved a single patent application filed in 1920.[212] *Crawford* was a 1887 patent infringement case involving a re-issued

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[207] Patent Blogs *supra* note 76; *Hakim*, 479 F.3d at 1318.

[208] *Id.*at 1317.

[209] *Id.*

[210] *Id.* (stating "the district court did not err in holding that the examiner's action in allowing the continuation claims without further prosecution was based on the prosecution argument in the parent. See *Omega Engineering, Inc.,* 334 F.3d at 1324) ("The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.") (citing Schriber-Schroth Co. v. Cleveland Trust Co*.,* 311 U.S. 211, 220-21, 61 S.Ct. 235, 85 L.Ed. 132 (1940), Crawford v. Heysinger*,* 123 U.S. 589, 602-04, 8 S.Ct. 399, 31 L.Ed. 269 (1887), and Goodyear Dental Vulcanite Co. v. Davis*,* 102 U.S. 222, 227, 26 L.Ed. 149 (1880)).")

[211] *Omega Engineering, Inc.,* 334 F.3d 1314; U.S. Patent 5,727,880 (filed Mar 18, 1996).

[212] *Schriber-Schroth Co.*, 305 U.S. at 58; U.S. Patent 1,763,523 (filed Mar 11, 1920).

patent.[213] Finally, *Goodyear* was a 1880 case regarding a single patent.[214] All cases are still good law however, none involve a disclaimer in a parent application which is then applied to a familial continuation patent application.

The CAFC's imprecise statement of precedent in support of their ruling was a major source of confusion for practitioners struggling to understand the impact of *Hakim*.[215] A closer look at the CAFC's own precedent revealed a number of cases that support the use of prosecution disclaimer rules across patent family lines. *Jonsson* stated that when analyzing prosecution history estoppel, the prosecution history as a whole including the prosecution history of parent applications must be examined.[216] To be clear, *Elkay* ruled that "[w]hen multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation."[217] Conversely, the CAFC has consistently held that the prosecution history of an *unrelated* patent cannot be used as a basis for applying prosecution history estoppel.[218] *Hakim* places significance on the *Omega* disclaimer clarity rules as applied

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[213] Crawford v. Heysinger, 123 U.S. 589, 602-04, 8 S.Ct. 399 (1887); U.S. Re-issue Patent 9803 (granted July 12, 1881).

[214] Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 227 (1880); US Re-issue Patent 1904 (granted Mar 21, 1886).

[215] *Hakim*, 479 F.3d at 1316.

[216] Jonsson v. Stanley Works, 903 F.2d 812, 818 (Fed. Cir. 1993).

[217] Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 980 (Fed. Cir. 1999).

[218] Abbott Labs. v. Dey, L.P., 287 F.3d 1097, 1105 (Fed. Cir. 2002) (vacating the district court's order and holding that arguments made during prosecution of a commonly-owned but unrelated patent did not create prosecution history estoppel); Sextant Avionique S.A. v. Analog Devices, Inc., 172 F.3d 817, 836 (Fed. Cir. 1999) (Smith J., dissenting) ("We have never based a finding of prosecution history estoppel on a statement made by a different applicant during prosecution of an unrelated application…"); Goldenberg v. Cytogen, Inc., 373 F.3d 1158, 1167-68

to continuation applications and imposes a duty on patent practitioners to provide unambiguously clear disclaimer rescissions in continuation applications.[219]

Broader Claims In Hakim's '931 CPA Were Prohibited By Statute

The United States Supreme Court has overwhelmingly supported the rule that new patent material may not be added by amendment but patent statues allow the addition of new, broadening material through other continuation methods such as a CIP, divisional, request for continued examination (RCE), or correction.[220] The patent codes and regulations have changed frequently throughout history, and the Manual of Patent Examining and Prosecution (MPEP) has changed in parallel.[221] At the time Hakim attempted to broaden his sippy-cup invention, the MPEP did not allow CPA broadening but inexplicably, '931 CPA was issued with a broadening amendment.[222]

Prior to July 14th, 2003, if a patent was filed before May 29th, 2000, a CPA for a utility patent was allowed and processed and examined under 37 C.F.R. 1.53(d).[223] Sometime during the pendency of the original application, Hakim chose to file a CPA in conjunction with a

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(Fed. Cir. 2004) (holding that statements in another patent's prosecution history is irrelevant to claim construction "[a]bsent a formal relationship or incorporation during prosecution" of the patent at issue.).

[219] *Hakim*, 479 F.3d at 1318; *Omega Engineering, Inc.,* 334 F.3d at 1325.

[220] *See supra* note 150; MPEP 201.08; 37 C.F.R. §§ 1.141-146; 37 C.F.R. §§ 1.171-1.179.

[221] 35 U.S.C. §§ 1-376; C.F.R . §§ 1.1-150.137; MPEP, The Barbri Group, 8th ed., rev 6, (2007); The MPEP is a compellation of statutes and regulations for use by patent examiners during patent prosecution.

[222] 37 C.F.R. § 1.53(d).

[223] *Id.*

amendment changing the term slit to opening in claims one and two and abandon the original application.[224] The CPA ultimately became the '931patent.

The patent codes require that a CPA only disclose claimed subject matter that was also disclosed in the prior application.[225] "Any new change that would have been considered new matter in the parent application must be made in the form of an amendment to the prior application as it existed prior to the filing of the CPA."[226] Furthermore, no CPA amendment may introduce new matter or matter that would be considered new in the parent application.[227]

Hakim's '931 utility patent claims priority to a provisional application dated August 21st, 1997 and was filed on August 22nd, 1998 which, at the time, allowed a CPA on utility patents.[228] The prosecution history revealed that the two-mechanism design which required the use of the term opening, was disclaimed and not part of the abandoned application.[229] Adding this previously disclosed term, opening, and consequently, the two-mechanism design, into the CPA by amendment constituted an improper addition of new matter. Hakim's broadening claim language should have been re-examined, considered new matter, and rejected under the rules of

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[224] *Hakim*, 479 F.3d at 1317.

[225] 37 C.F.R. § 1.53(d)(2)(ii) (Application Filing Requirements – Continued Prosecution (nonprovisional) application).

[226] 37 C.F.R. § 1.53(d)(5) ("The patent codes require that a CPA disclose and claim subject matter disclosed in the prior application. Any new change that would have been considered new matter in the parent application must be made in the form of an amendment to the prior application as it existed prior to the filing of the CPA. Furthermore, no CPA amendment may introduce new matter or matter that would be considered new in the parent application.").

[226] *Hakim*, 479 F.3d at 1317.

[227] *Id*.

[228] U.S. Patent No. 6,321,931 (filed Aug. 22, 1998); 37 C.F.R. § 1.53(d).

[229] *Hakim*, 479 F.3d at 1317.

the USPTO at the time.[230] Despite violating U.S. patent regulations to the contrary, the Hakim's broader term was accepted by the examiner into the '931 CPA and no further examination was conducted.[231]

A patent applicant who, in response to an examiner rejection, wishes to modify a claim to address the rejection may do so through an amendment.[232] In the amendment, the applicant must request consideration for further examination with or without an amendment.[233] To advance the prosecution, the applicant must present bona fide arguments pointing out *specific distinctions* laid out in the amendment believed to render the claims patentable over any previously applied references.[234] In amending the claims, the applicant must also clearly point out the patentable novelty of the claims presented in view of the state of the art disclosed by the references cited or the objections made.[235] The examiner "shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention."[236]

As outlined in *Omega* and discussed above, any disclaimer filed in the parent application was carried over into the CPA.[237] When Hakim disclaimed an opening in lieu of a slit to avoid

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[230] 37 C.F.R. § 1.104 (Nature of examination); 37 C.F.R. § 1.53(d)(5).

[231] *Hakim*, 479 F.3d at 1317.

[232] 37 C.F.R. § 1.111 (a)(1) (Reply by applicant or patent owner to a non-final Office action).

[233] *Id*.

[234] 37 C.F.R. § 1.111 (b).

[235] 37 C.F.R. § 1.121 (Manner of making amendments in applications).

[236] 37 C.F.R. § 1.104.

[237] *Omega Engineering, Inc.,* 334 F.3d at 1325.

collisions with the prior art, the slit limitation became attached to his CPA and should have been re-examined so the new matter would have been evaluated.[238] If the CPA and associated amendment did not point out the specific distinctive patentability arguments over past references or clearly point out the novel aspects of the additional material, the CPA should have been rejected as incomplete.[239] Hakim failed to clearly and distinctly present the new, disclaimed claim language and emphasize the known patentability issues known to him at the time to indicate to the examiner that perhaps another search of the prior art was necessary.[240] The District Court and the CAFC should have emphasized the failures of the USPTO examiner who failed to reject the CPA and amendment and invalidated the patent.

POST HAKIM EFFECTS ON PATENT PROSECUTION[241]

The CAFC ruled that Hakim's CPA and accompanying letter, and amendment requesting the use of the term opening was insufficiently clear for the public and USPTO to recognize the rescission of the two-mechanism design.[242] *Hakim* informed practitioners they must inform the examiner, with sufficient clarity, of the intent to recapture specific subject matter disclaimed in a prior familial patent so the examiner can assess the need for additional prior art comparisons.[243] *Hakim* restated the *Omega*, *Jonsson,* and *Elkay* requirements for unambiguous clarity when

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[238] 37 C.F.R. § 1.104.

[239] *Id*.

[240] *Hakim*, 479 F.3d at 1318.

[241] *Id*.

[242] *Id.*

[243] *Hakim*, 479 F.3d 1313; *Omega.,* 334 F.3dat 1325; *Jonsson,* 903 F.2d 812; *Elkay Mfg. Co.*, 192 F.3d 973.

recapturing disclaimed patent terms in continuation patents, and in doing so, restated the practitioner's affirmative duty to clearly communicate their desire to recapture a disclaimed element of an invention in a CPA.[244] The court was silent on exactly what constitutes sufficiently clear communication and leaves the practitioner to determine what constitutes unambiguous communications.

Hakim restated precedent that placed a serious burden on practitioners and applicants to examine all amendments and patentability arguments made in during the prosecution of parent applications prior to submitting any continuation application.[245] Pragmatic practitioners must identify all prior disclaimers and explicitly communicate any rescissions to the examiner to preclude surprise and preserve the public reliance on the prosecution history. Ignoring *Hakim*, the precedent it relied upon, and the precedent it should have relied upon, may result in a patent prosecution failure, an infringement accusation, or an invalid patent.[246] The failure of the prosecuting representative to clearly and unambiguously inform the examiner of an attempt to reclaim disclaimed inventions may be subject to a claim of inequitable conduct or possibly worse ramifications.

The *Hakim* decision, however, does not discuss what level communication rises to support an unambiguous rescission.[247] Sufficient communication requires that each party to the prosecution negotiation have clear and express transmission and receipt of any or all disclaimers or rescissions. Future cases will undoubtedly address the subjective nature of the required

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[244] *Hakim*, 479 F.3d 1313; *Omega*, 334 F.3d 1314; *Jonsson*, 903 F.2d 812; *Elkay*, 192 F.3d 973.

[245] *Hakim*, 479 F.3d 1313.

[246] *Id.*

[247] *Id.*

communication to the examiner and what examiner actions convey effective or constructive disclaimer rescission. The USPTO and the courts should expressly define the required language to prevent any ambiguity or create a bright-line rule that applies to all continuation applications.

A constructive rescission might simply be in the form of a request for consideration of the prosecution history. If the practitioner knows what disclaimer is being rescinded, she would do well by herself and client to expressly state the intent to rescind that specific disclaimer. As a self preservation measure, the practitioner or applicant would be wise to include an all encompassing statement in every continuation application such as "all arguments or disclaimers made in the parent application do not apply to this continuation application." The statement should also include a request to the examiner to review the prosecution history to identify prior disclaimers and to reexamine any new claims in light of the prior art of record. Any thorough search of the prior art should also include a search of the technical landscape between what was claimed in the parent and the newly claimed subject matter. Since the practitioner must provide sufficient details for unambiguous clarity, whatever method chosen, clear and open communication is crucial to prevent patent invalidity and practitioner misconduct.[248]

After allowance of the patent, a response by the practitioner stating his understanding for the reasons for allowance provides a vehicle to state that the applicant presumes examiner has considered the file history in parent applications in the issuance of the present application. Such a hindsight measure in conjunction with an express statement at the time of filing provides a redundant measure of protection for the practitioner, the applicant, and the examiner. Whatever method is adopted, unambiguous acknowledgement of the rescission is essential to preserve the public reliance on the prosecution record of the claimed invention.

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[248] *Omega*, 334 F.3d 1314 ("unambiguous"); *Hakim*, 479 F.3d 1313 ("sufficiently clear").

Hakim also argued for validity of the '931 patent based on "that when the examiner allowed the new claims without rejection, there is a presumption that the examiner assured himself of the patentability of the new claims"[249] Hakim thought he did what was appropriate when he flagged this change to assist the examiner, and that the claims as granted should not be unnecessarily narrowed by the court.[250] The CAFC did not address this argument.[251] Perhaps the court didn't argue the premise because arguably, there is no presumption at all anymore when it comes to disclaimers and rescissions. The validity of the continuation patent now rests on whether the communication between the practitioner and examiner was good enough to preserve the patent's public notice function.

The method of ensuring unambiguous communication between the practitioner and examiner is relatively simple and cost free but all other impacts of the *Hakim*, *Omega, Jonsson,* and *Elkay* collectively are very significant.[252] Due diligence of patent validity analyses will rise dramatically as additional time will be required to comb through the prosecution history to ensure continuation applications were communicated clearly. The impact of this cost will be felt by both practitioners and examiners and ultimately be passed along to the inventor. The cost of litigation will also rise equally for many of the same reasons. Due diligence exercises during patent licensing negotiations will similarly rise especially in light of *MedImmune* and *SanDisk*

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[249] *Hakim*, 479 F.3d at 1317 (citing United States v. Chemical Foundation*,* 272 U.S. 1, 14-15 (1926) ("The presumption of regularity supports the official acts of public officers, and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties.")) .

[250] *Hakim*, 479 F.3d at 1317.

[251] *Id*.

[252] *Hakim*, 479 F.3d 1313; *Omega*, 334 F.3d 1314; *Jonsson*, 903 F.2d 812; *Elkay*, 192 F.3d 973.

which significantly lowered the threshold for patent invalidity suits.[253] Patent validity challenges will be more easily achieved and more costly as practitioners react to *Hakim*.[254]

Hakim also added force to the brakes already being applied to continuation practice in the U.S. Congress.[255] No longer will practitioners be allowed to nonchalantly reserve disclaimed subject matter for a later filed continuation application without first making clear what aspects of the invention are being dedicated to the public. *Hakim* shed light on the importance of clear unambiguous communication between the practitioner and the examiner to preserve the public's reliance on the public notice function of the US patent system, while seriously impacting the costs of successfully holding a valid patent in the U.S.[256]

CONCLUSIONS

A detailed claim construction analysis of the '931 patent set forth in *Hakim* and applying the cannon to preserve patent validity and the public's reliance on it, validated the CAFC's holding of noninfringement in lieu of invalidation.[257] *Omega* supported the requirement for sufficiently clear, unambiguous disclaimer rescissions while *Jonsson* and *Elkay* validated the CAFC's application of prosecution disclaimer doctrine to continuation applications.[258] The court's opinion in *Hakim* applied existing law and revealed the important need to provide the

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[253] *MedImmune, Inc*., 549 U.S. 118; *SanDisk Corporation*, 480 F.3d 1372.

[254] *Hakim*, 479 F.3d at 1313.

[255] Patent Reform Act of 2007 H.R. 1908, S. 1145, 110th Cong. (2007).

[256] *Hakim*, 479 F.3d at 1313; *See supra* note 185.

[257] *Hakim*, 479 F.3d at 1313.

[258] *Omega*, 334 F.3d 1314; *Jonsson*, 903 F.2d 812; *Elkay*, 192 F.3d 973.

public with clear and unambiguous knowledge when patent applicants attempt reclaim disclaimed subject matter dedicated to the public.[259] However, the validity of the '931 patent should not have been preserved in view of a §112 written description failure, and a failure to comply with the new material CPA rules set forth by federal patent regulations.[260]

Hakim kept an invalid patent alive and functional, and imposed a duty on patent practitioners to provide unambiguously clear disclaimer rescissions in continuation applications.[261] Although the latter is an important to preserve the public trust on the public patent file history, the fallout will seriously increase the costs of successfully holding a valid patent in the U.S. *Hakim* forces practitioners to recognize and adopt a simple but diligent practice of unambiguous communication with the examiner when making patentability arguments but looking backwards, many issued patents are now at risk.[262] As patent validity challenges now require a very detailed prosecution file history examination, issued continuation patents with unclear or ambiguous rescissions attempts may result in a worthless or invalidated patent. The cost of defending or licensing a continuation patent will undoubtedly increase as a result of the added effort. Communication between the patentee and the examiner was the ultimate failure in *Hakim*.[263] Poor communication seemed to surround the invention, the patent application, the specification, the claim language, the disclaimer, and most of all, the rescission.

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[259] *Hakim*, 479 F.3d at 1313.

[260] 35 U.S.C. § 112; 37 C.F.R. § 1.104; 37 C.F.R. § 1.53(d)(5).

[261] *Hakim*, 479 F.3d at 1313.

[262] *Id.*

[263] *Id.*

SUMMARY

This article suggests the *Hakim* CAFC opinion regarding the use of prosecution history disclaimer in continuation patents was correct, despite the confusing language of the *Hakim* opinion.[264] However, the '931 patent should have been invalidated for written description and new matter violations.[265] The failure of the CAFC to provide a concise opinion was a lost opportunity to provide the patent practitioner with direction and guidance to minimize the escalating costs of patent ownership.

Hakim invented infant sippy-cups for his company, Luv n' Care® Ltd, sued Cannon Avent Group, PLC, (Avent) in the United States District Court for the Western District of Louisiana.[266] Hakim, claimed infringement of his '931 and '620 patents by Avent's leak-resistant drinking cups.[267] *Hakim* created a firestorm of confusion as patent practitioners struggled to understand its holding and the impact on their practice and clients.[268] Patent agents, prosecuting attorneys, litigators, and patent portfolio managers feared the worst. Practitioners feared severe weakening of the patent as a vehicle for technological advancement as patent value was drastically reduced due to new onerous prosecution procedures.[269]

The *Hakim* case was seemingly unique because the patentee purportedly disclaimed a broad interpretation of his invention during prosecution then tried to rescind that broad

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[264] *Hakim*, 479 F.3d 1313.

[265] 35 U.S.C. § 112; 37 C.F.R. § 1.104; 37 C.F.R. § 1.53(d)(5).

[266] *Hakim*, 2005 U.S. Dist. LEXIS 16830.

[267] *Id.; Hakim*, 479 F.3d 1313.

[268] *Id.*; *see supra* note 76.

[269] *Id.*

interpretation by filing a continued prosecution application.[270] Hakim's patents were held not infringed despite his efforts to follow USPTO practice rules.[271] The legal community believed *Hakim's* confusing CAFC opinion was another, in a stream of cases, which weakened the United States patent system and imposed onerous prosecution requirements on practitioners.[272]

As a result of *Hakim*, many issued patents may easily be invalidated in court as prosecution history reveals foreseen and unforeseen disclaimers and rescissions that fall within the realm of the *Hakim* decision.[273] Patentees will see yet another rise in the cost of obtaining and retaining a patent in the United States, but the CAFC merely followed precedent and revealed another potential patent pitfall.[274] The limits on broadening invention claims expressed in *Hakim* were already in place and never fully recognized by patent practitioners.[275] Patent law practitioners are justifiably concerned about the impact on their practice however, precedent suggests the *Hakim* opinion not surprising.[276]

Hakim was decided through a detailed claim construction analyses which drew from the

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[270] *Hakim*, 479 F.3d 1313; 37 C.F.R. § 1.53.

[271] *Id.* at 1318.; 37 C.F.R. § 1.53; 37 C.F.R. § 1.121.

[272] *Id.*; See KSR Int'l Co. v. Teleflex Inc., 550 U. S. 398, 127 (2007) ("[T]he obviousness analysis cannot be confined by a formalistic conception."); eBay Inc. v. MercExchange *L.L.C.*, 547 U.S. 388 (2006) (Supreme Court of the United States unanimously determined that an injunction should not automatically issue based on a finding of patent infringement); *Medimmune, Inc.,* 549 U.S. 118 (holding that a patent licensee need not breach its license agreement in order to file a declaratory judgment action regarding non-infringement, invalidity or unenforceability.); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002) (which holds that a patent can be infringed by something that is not literally falling within the scope of the claims).

[273] *Hakim*, 479 F.3d 1313.

[274] *Omega*, 334 F.3d 1314; *Jonsson*, 903 F.2d 812; *Elkay*, 192 F.3d 973.

[275] *Hakim*, 479 F.3d 1313.

[276] *Id.*; *Omega*, 334 F.3d 1314; *Jonsson*, 903 F.2d 812; *Elkay*, 192 F.3d 973.

prosecution history disclaimer doctrine to find that the Luv n' Care® '931 patent was not infringed by Avent's products.[277] The CAFC affirmed and chose to expound on the district court ruling by addressing the rescission of disclaimers in continuation patents while virtually ignoring the issues of validity that surrounded the '931 patent.[278] *Hakim* reiterated precedent that the reclaiming of disclaimed subject matter was, and will continue to be, guided by the clarity rules set forth in *Omega*.[279] *Hakim* also affirmed the courts precedent in *Jonsson* and *Elkay* which applied prosecution disclaimer doctrine to continuation patents. However, the court did not acknowledge the '931 failure to comply with §112 written description requirement and the failure to comply with the rules regarding new subject matter in CPA's.[280] These dramatic failures should have outweighed the courts desire to preserve patent validity.

As a result of *Hakim*, many issued patents may easily be invalidated in court as prosecution history reveals disclaimers and rescissions that fall within the realm of the *Hakim* decision.[281] Practitioners and patentees will see yet another rise in the cost of obtaining and retaining a patent in the United States, but the CAFC merely followed precedent and revealed another potential patent pitfall.

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[277] *Hakim*, 479 F.3d at 1318.

[278] *Id.*

[279] *Omega*, 334 F.3d 1314.

[280] 37 C.F.R. § 1.53; 37 C.F.R. § 1.121.

[281] *Hakim*, 479 F.3d at 1318.