



Opening Pandora's Box

Use of File Wrapper History (what it will mean)

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No File Wrapper Estoppel

- In Canada we have informed and purposive construction
 - Historically the Courts have rejected file wrapper estoppel or reference to the file wrapper for claim construction
- “...those references to the inventor’s intention refer to an objective manifestation of that intent in the patent claims, as interpreted by the person skilled in the art, and do not contemplate extrinsic evidence such as statements or admissions made in the course of patent prosecution.”



Informed and Purposive Approach

- Avoids literal and substantive approach
- Reliance on claims performs a public notice function
- Purpose is to identify essential elements not just interpret words in the claims.
- Focus for claim construction is the date the specification (or claims) were published.
- File history may be relevant for a purpose other than claim construction



What of the File Wrapper?

- Section 53.1 allows use of some parts of the prosecution history meeting conditions:
 - It is a written communication or part of it
 - Prepared in respect of (1) the prosecution of the application; (2) disclaimer respecting the patent; or (3) a request for re-examination or a re-examination proceeding
 - It is between
 - The applicant for the patent or the patentee; and
 - The Commissioner, an officer or employee of the Patent Office, or a member of the re-examination board.



When Can the File Wrapper Come In?

The written communication or any part of it:

may be admitted into evidence;

to rebut any representation made by the patentee in the action;

as to the construction of a claim in the patent;



Estoppel Does Not Apply

- Claim construction is a question of law to be determined by the Court.
- The standard conditions for an estoppel (issue estoppel) do not apply
- Is the section to be applied in a way corresponding to file wrapper estoppel in the U.S.?



Essential Element Estoppel

- Is the section to be applied in a way corresponding to file wrapper estoppel on the doctrine of equivalents?
 - No doctrine of equivalents in Canada to which a file wrapper estoppel could apply
 - We do have essential elements, the determination of which is a purpose of claim construction



Binding Admission of Meaning

- Binding admission against interest as to the meaning of a term.
- Premise that it is not fair to make two different representations about the meaning of terms in a claim – claims have the same meaning, without an eye on infringement or validity.
- What happens in the situation when both parties agree that what was said in the patent office is wrong, i.e. both parties put up experts setting up entirely different meanings.



An Evidentiary Issue

“...may be admitted into evidence” - evidence of what fact?

- Evidence needs to be weighed but only for the purpose it was admitted.
- Not directly for claim construction but to rebut a representation about a claim construction
- Weigh other evidence – what other evidence (peering into the box)



An Evidentiary Issue

- If the intent is to maintain the primacy of informed and purposive construction the use of a written document to rebut a representation should be limited.
- Admitted as primary evidence of the meaning of claims?
- Admitted as secondary evidence of the meaning of claims?



An Evidentiary Issue

- If the intent is to maintain the primacy of informed and purposive construction the use of a written document to rebut a representation should be limited.
- Admitted as an issue of credibility of the patentee?
- Can only be used against the patentee, not to support the patentee.



Timing of the Statement

- When was the statement made? “Prepared in respect of”
 - the prosecution of the application...”
 - A disclaimer
 - Reexamination
- When is the meaning of the statement to be determined – what did they mean when they said it, what does it mean when the claim is finalised?
- Claims are to be construed when published
- to rebut any representation made by the patentee in the action



Who Made the Statement?

- The statements at issue are typically made by the patent agent on instructions from the patent owner
- Often not on the instruction of the inventor
- How relevant are such statements as evidence going
 - to an objective manifestation of the inventor's intent in the patent claims



Why Was the Statement Made?

- Re-examination and disclaimer – often addressing specific pieces of prior art;
- Prosecution – when does it begin?
- Was a statement made to overcome a piece of prior art, e.g. narrow the claim to avoid prior art?
- Was a statement made for some other purpose, eg. An amendment to make language consistent with other claims?



More Deference to the Patent Office

Historically, claims construction has not given any deference to the patent examiner.

- If now give weight to written statements made by the patentee/agent
- Does the Court now give weight to written statements or objections by the patent examiner? Are they admissible?



More Conflicts for Law Firms?

- IP firms often act as both patent agent during prosecution and counsel in litigation for a client
- Double duty does not create a conflict.
- If, and when, there is admissibility of written communications of such patent agents as evidence, does that create a conflict that may preclude them from acting as counsel?
- Do agents need to hire expert witnesses during prosecution?



Hand in Glove With Section 53?

Does this Breathe some new life into section 53?

- “...the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, and the omission or addition is willfully made for the purpose of misleading”
- Section 53.1 can further support an inquiry into why statements are made in a specification.



Informed and Purposive- The End

- “The *Patent Act* promotes adherence to the language of the claims”
- “...according to the intent of the inventor, expressed or inferred from the claims...”
- “...without, however, resort to extrinsic evidence of the inventor’s intention...”