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## The uncertain prior existence of disclaimed patent claims

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Under 35 U.S.C. § 253, a disclaimed patent claim is effectively eliminated and treated as if it had never existed in the original patent. However, a disclaimed claim whose initial inclusion had real-world consequences does not necessarily meet the same fate. The impact of its prior existence may have potential consequences that can, in effect, treat it as surviving even after its disclaimer. This article discusses the history and implications associated with statutory disclaimers, including the potential impact of patent claims that continue to survive even after being disclaimed.

### Background

Pursuant to 35 U.S.C. § 253, a patentee has the ability to disclaim one or more claims after the patent's issuance. Disclaiming particular claims under Section 253 effectively eliminates the claims from the original patent.<sup>1</sup> According to Federal Circuit precedent, upon entry of a disclaimer, the patent is treated as if the disclaimed claims had never existed.<sup>2</sup> Once the patentee disclaims its claims, the patentee has no further interest or right to enforce these claims or the right to obtain a reissue of any of the previously disclaimed claims.<sup>3</sup>

Historically, disclaimers originated as a response to the common law rule which voided an entire patent due to a portion of the patent being invalid.<sup>4</sup> At that time, the general purpose of a disclaimer was “to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it.”<sup>5</sup>

However, when disclaimers were initially introduced, it became common practice among practitioners to use disclaimers as a means to amend claims, including disclaiming broadening statements in the specification in addition to modifying the claims themselves.<sup>6</sup> This practice of amendatory disclaimers led to public confusion regarding the claim scope and to inconsistent decisions by courts regarding the allowance of amendatory disclaimers.<sup>7</sup>

In 1952, Congress enacted Section 253 to abrogate the earlier practice of partial scope disclaimer within a single claim.<sup>8</sup> Section 253, provides in relevant part:

A patentee, whether of the whole or any sectional interest therein, may... make a disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office; and it shall thereafter be *considered as part of the original patent* to the extent of the interest possessed by the disclaimer and by those claiming under him.<sup>9</sup>

The noteworthy change in Section 253 was that it deleted the authorization of a patentee to disclaim part of a patent claim. Unlike before, a patentee is currently limited to disclaiming claims in their entirety.<sup>10</sup> Thus, Section 253 foreclosed the possibility that the patentee could obtain the equivalent of a broadened reissue by partially disclaiming a portion of a claim.<sup>11</sup>

For that reason, a patentee may now make a disclaimer of any complete claim.<sup>12</sup> And such disclaimer will be recorded at the Patent and Trademark Office (“PTO”) and treated as “part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.”<sup>13</sup>

## Potential Impact of Disclaimed Claims

Although a disclaimed patent claim under Section 253 is effectively treated as if it never existed in the original patent, a disclaimed claim, which has inflicted real-world consequences, cannot always be treated as such. A 1961 decision of a divided Court of Customs and Patent Appeals (“CCPA”), *In re Hession*, addressed exactly that.<sup>14</sup> In *Hession*, a common assignee disclaimed a reference patent when faced with a common-assignee double patenting challenge.<sup>15</sup> Although the common assignee argued that the reference patent should be treated as though it never existed, Chief Judge Worley disagreed in his concurrence.<sup>16</sup> In his opinion, the justice determined that, when considering a disclaimer, it is necessary to look at the use to which the patentee put its patent.<sup>17</sup> The patentee’s “*patent rights* should be crystal clear before [the] court [is] justified in putting [the patentee] in a position whereby [the patentee] could subject to legal harassment those who, in good faith, relied on the validity of the [original] patent.”<sup>18</sup>

Thus, a disclaimed patent claim’s prior existence may have potential consequences that can, in effect, treat it as surviving even after its disclaimer. Below is a list of such real world consequences where a disclaimed patent claim continues to have an impact even after being disclaimed.

### 1. Claim Construction

A disclaimed claim is not removed from the prosecution history and is consequently available for use in construing the remaining claims of the patent.<sup>19</sup> For example, even after a dependent claim is disclaimed, it can be used to construe an independent claim because the dependent claim is included in the patent prosecution history, which is now part of the public record.<sup>20</sup> The reason being that “the public is entitled to rely on the clear and unambiguous prosecution history demonstrating the patentee’s understanding [of its own claim terms].”<sup>21</sup>

### 2. Hatch-Waxman

By virtue of listing a patent in the Food Drug Administration (“FDA”) Orange Book, a disclaimed patent does not necessarily remove the exclusionary effect the patent continues to have after its disclaimer. Specifically, a disclaimed patent may have an indirect exclusionary effect on second and subsequent generic filers because of a first filer’s presumptive 180 day exclusivity due to the continued listing of the disclaimed patent in the Orange Book.<sup>22</sup> Consequently, the disclaimed patent may continue to serve as an obstacle for generic drug entry for second or successive generic filers and

effectively delay the FDA from approving generic companies' abbreviated new drug applications and allowing drugs to enter into the U.S. market.

Further, disclaimers of Orange Book listed patents do not deprive a court of jurisdiction in a declaratory judgment action for patent certainty brought by a second generic filer.<sup>23</sup> “[T]he listing of the patent, with its concurrent consequences of preventing FDA approval during [a first filer’s] presumptive exclusivity period” is indicative of the parties’ adverse interests in the truncation, forfeiture, or preservation of that exclusivity period.<sup>24</sup>

### 3. Interferences

Similarly, disclaiming all claims in an Interference relating to a count at the PTO does not divest the Board of jurisdiction even though the interference was effectively terminated.<sup>25</sup> The Board maintains jurisdiction to decide priority when the priority issues have been fairly raised and fully developed at the Board prior to a disclaimer.<sup>26</sup> In other words, the Board continues to decide issues of priority as long as jurisdiction was proper at the time the interference was declared.<sup>27</sup>

### 4. Other Implications

Further, once a patentee disclaims a patent claim, it no longer holds any meaningful interest in the disclaimed patent. The effect of the patentee’s action is the same as dedicating the patent claim to the public or abandonment.<sup>28</sup> In the same vein, the disclaimed claim—now vested to the public—can be used as prior art, even against the patentee who previously disclaimed it.<sup>29</sup>

It is thus not a universal truth that all claims vanish upon being disclaimed. Their impact during their existence, however brief, reverberates well after their disclamation. Historically, the purpose of a disclaimer was meant to prevent voiding an entire patent due to a portion of the patent being invalid. Presently, a disclaimed claim is treated as non-existing so that the patentee no longer has the right to enforce the claim or recover from infringement prior to the disclaimer. However, while the disclaimer wipes the slate of patentee’s rights to the claim clean, its imprint may remain. Practitioners should thus be mindful of these residual effects when disclaiming claims under Section 253.

### Endnotes

- 1 *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998).
- 2 *Id.*; see also *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) (“A statutory disclaimer under [section 253] has the effect of cancelling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent”).
- 3 See *Teva Pharm. USA Inc. v. Eisai Co. Ltd.*, 620 F.3d 1341, 1345 (Fed. Cir. 2010), *vacated with instructions to dismiss as moot*, 131 S.Ct. 2991 (2011); see also *Genetics Inst. LLC v. Novartis Vaccines & Diagnostic Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011).
- 4 See *Ensten v. Simon, Ascher & Co., Inc.*, 282 U.S. 445, 452 (1931).
- 5 *Id.* (internal citations omitted); see also Ernest A. Wegner, *The True Function of Disclaimer in Patent Law*, CHI.-KENT L. REV. 12, 107 (1934).
- 6 See *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403 (1901).
- 7 See generally, *Patents—Disclaimer—Every Disclaimer Filing to Surrender Entire Claim Declared Invalid*, 55 Harv. L. Rev. 152 (1941).

- 8 See Ernest A. Wegner, *The True Function of Disclaimer in Patent Law*, CHI.-KENT L. REV. 12, 107 (1934).
- 9 35 U.S.C. § 253 (emphasis added).
- 10 See generally, Pasque J. Frederico, Commentary on the New Patent Act, reprinted at 75 JPTOS 161 (1993) (“Under the prior statute a disclaimer could either have the form of cancelling a claim from the patent, or it could revise a claim by restricting its scope. While disclaimers of the latter type had not met with much success in recent times, there can be no question but that they were permitted by the statute, and they were often sustained in the past. Under the new statute a claim cannot be revised by a disclaimer; the patentee is left to the reissue section if he desires to revise his claim”).
- 11 *Id.*
- 12 *Vectra Fitness*, 162 F.3d at 1382-83.
- 13 *Id.*; see also *Guinn v. Kopf*, 96 F.3d at 1422.
- 14 *In re Hession*, 296 F.2d 930 (C.C.P.A. 1961); see also Charles L. Gholz, *A Disclaimed Claim Is Not Always Treated as If It Had Never Existed!*, OBLON.COM, Sept. 2011.
- 15 *In re Hession*, 296 F.2d at 931.
- 16 *Id.* at 931-932, 939. The Majority opinion focused on the doctrine of election.
- 17 *Id.* at 939.
- 18 *Id.* (emphasis added).
- 19 See, e.g., *Allergen Sales, LLC v. Sandoz, Inc.*, 2013 Markman 4854786, 2013 WL 4854786 (E.D. Tex. 2013).
- 20 *Id.* at \*4,\*6, and \*8 (“While it is true that the patentees ultimately disclaimed claims 2–7 of the ‘890 patent, that disclaimer did not and could not erase the prosecution history record of the ‘890 patent”).
- 21 *Id.* at \*8.
- 22 See generally *Apotex, Inc. v. Daiichi Sankyo, Inc.*, 2015 WL 1423624 (Fed. Cir. Mar. 31, 2015); *Teva Pharm. USA Inc. v. Eisai Co. Ltd.*, 620 F.3d 1341 (Fed. Cir. 2010), *vacated with instructions to dismiss as moot*, 131 S.Ct. 2991 (2011).
- 23 See e.g., *Apotex, Inc.*, 2015 WL 1423624 at \*14; *Bone Care Int’l L.L.C., et al. v. Sandoz, Inc.*, Case No. 09-CV-00524 (D.I. 39) (D.Del. Oct. 6, 2011) (reinstating patent declaratory judgment claim on reconsideration of D.I. 29 (Sept. 30, 2010).
- 24 See *Apotex, Inc.*, 2015 WL 1423624 at \*6, \*7, and \*14.
- 25 See, e.g., *Guinn v. Kopf*, 96 F.3d 1419 (Fed. Cir. 1996); *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000); *but cf. 3V, Inc. v. CIBA Specialty Chemicals Corp.*, 587 F.Supp.2d 641 (D.Del. 2008).
- 26 *Id.*
- 27 *Guinn*, 96 F.3d at 1421-22.
- 28 See *Altoona Public Theaters v. American Tri-Ergon Corp.*, 294 U.S. 477 (1935) (“[u]pon filing of the disclaimers, the original claims are withdrawn from the protection of the patent laws . . . as though it had been abandoned”); see also *3V, Inc.*, 587 F. Supp.2d at 643; *W.L. Gore & Associates, Inc. v. Oak Materials Group, Inc.*, 424 F.Supp. 700, 702 (D.Del.1976). However, while the filing of a disclaimer dedicates the subject matter to the public, it does not operate as a legal admission that the dedicated subject matter was in the prior art. *National Fruit Products Co., v. C.H. Musselman Co.*, 8 F.Supp. 994 (M.D. Pa.1934)
- 29 *3V, Inc.*, 587 F. Supp.2d at 645-646 (“It is possible that in the future, [a party] may assert claims resulting from the [] application in a patent infringement lawsuit. Then, . . . some other party, may have an interest in litigating the priority date of such claims and addressing the issue of whether the now disclaimed [] patent constitutes anticipatory prior art”).

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