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The Game of Disclaim: Curious Case of Strategic Prosecution Disclaimer in IPR

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Prosecuting a patent application at the U.S. Patent & Trademark Office (USPTO) often involves numerous exchanges with a patent examiner in which an applicant is provided an opportunity to discuss and distinguish examined claims and claim terms in view of cited prior art. Statements provided by the applicant are regarded as intrinsic evidence that can result in binding prosecution disclaimers. Prosecution disclaimers often carry a negative connotation of narrowing claim scope, but can sometimes be a positive.

In the *non-precedential* opinion *Intex Recreation Corp. v. Team Worldwide Corporation*, 2020-1144 (Fed. Circ. 2021), we are provided with an example where prosecution disclaimer actually worked in favor of the patent holder, shielding the patent from later discovered prior art.

In *Intex*, the Federal Circuit affirmed-in-part a PTAB decision issued for an *inter partes* review initiated by petitioner Intex that sought to invalidate Team Worldwide's patent as anticipated and obvious. The patent at issue was directed to an inflatable airbed with an electric pump that is "wholly or partially recessed into the inflatable body."

At the PTAB, Intex challenged Team Worldwide's patent as anticipated by a prior art reference disclosing an inflatable toy that included a platform mounted to a perforated pillow. As air is pumped into the pillow, air is constantly expelled, causing the platform to "hover." The Board found anticipation lacking, however, because the reference did not disclose a substantially airtight "inflatable body" as required by the construed claims.

During claim construction, the Board construed "inflatable body" as meaning "a substantially airtight structure that expands when filled with air or other gases," despite Intex's arguments that the construction of the term was unduly narrow. "Inflatable body" was not defined in the claims or specification of the application, but Team Worldwide pointed to its statements made during prosecution for support. Particularly, when presented with an Office Action prior art

reference directed to a temperature controlled pillowcase, Team Worldwide argued in a response that the pillow case was not "substantially airtight" and did not meet the criterion of "an inflatable body, i.e., the combined structure taken as a whole must be substantially airtight and expand when filled with air or other gas."

The Federal Circuit noted that Applicant's use of the term "i.e." in a definitional way with respect to a claim term was an effective disclaimer that limited claim. Consequently, the court agreed with the Board's claim construction and holding of the claims as not anticipated.

PRACTICE NOTE

In general, patent practitioners should always be wary of making statements during prosecution that could be regarded as defining, limiting, or otherwise providing bright line characterizations of their claimed subject matter. Every statement made on record can be interpreted as narrowing the scope of protection of the claims, and the impact can be felt long after a patent has issued. The best practice is to be as short and concise as possible when distinguishing prior art references.

Intex represents a rare case in which a prosecution disclaimer benefitted a patent holder and resulted in claim construction that removed prior art that would otherwise render patent claims as anticipated and/or obvious. It is unclear whether the outcome here was intentional or simple luck on the part of the applicant, but an alert patent practitioner can certainly take note that strategic admissions and definitions may be woven into the prosecution history in view of possible challenges that might rear their head down the road. Possible applications may include providing a definition or example where events in prosecution make clear that certain claim limitations are subject to multiple interpretations, or to rebut an examiner applying a sweeping characterization of a claim term to utilize "near fit" prior art.