

# Another Friendly Reminder from the CAFC - Use of "the Present Invention" is Clear and Unequivocal Evidence of Disavowal

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Disavowal can occur when a patent holder disavows the full scope of claim terms in the specification or during prosecution (e.g., through the doctrine of prosecution history estoppel). In either event, disavowal requires clear and unequivocal evidence that the claimed invention includes or does not include a particular feature. However, "clear and unequivocal" does not mean "explicit." Last week, in the case of *Poly-America, L.P. v. API Industries, Inc.*, the Federal Circuit explained that "an inventor may disavow claims lacking a particular feature when the specification describes 'the present invention' as having that feature." Similarly, the court explained that "an inventor may disavow claims lacking a particular feature when the specification distinguishes or disparages prior art based on the absence of that feature."

### Case Overview:

In the case, Poly-America asserted **U.S. Patent No. 8,702,308** for an elastic drawstring trash bag against API Industries' "conventional" drawstring trash bags (i.e., trash bags where the width of the bottom of the bag and the width of the opening at the top of the bag are the same size). Although the width of the opening at the top of the patented trash bag was restricted in two of the independent claims to be less than the width of the bottom, independent Claim 10 only required that the two panels and drawstrings of the trash bag be "inseparably joined together at a first short seal and at a second short seal" (emphasis added). Poly-America asserted that the short seals of Claim 10 only required "a seal that inseparably welds or joins" the drawstrings and the panels of the bag. However, the Federal Circuit disagreed.

The court noted how the specification stated that "it is important to note that one of the characteristics of *the present invention* is a reduction in upper width ... resulting from the extended short seals" (emphasis in original). The court also noted how the Abstract stated that "[w]hen the bag of the present invention is in a relaxed state, the reduced upper opening width of the elastic drawstring bag is therefore less than bag proper width," and that "[e]mbodiments of the elastic drawstring bag contemplated by the present invention have an upper opening with a width that is less than 97% of the width of the rest of the bag (by virtue of the extended short seals)." The court discussed how the specification explained that prior art bags are difficult to secure over trash can lips, and that the use of extended short seals reduces the width of the opening of the bag, thereby making it easy to fit around a trash can. Additionally, the court explained that Poly-America distinguished all of the claims from the prior art during prosecution by stating that "[t]he 'relaxed upper opening width' of Schneider is the exact same as the 'bag proper width,' not less than the 'bag proper width' as required by Applicant's independent claims" (emphasis in original). Poly-America argued that the terms "relaxed upper opening" and a "bag proper width" were not recited in Claim 10. However, the court opined that this fact was irrelevant because it was clear that all of the claimed trash bags had a "relaxed upper opening" and a "bag proper width," when considered in light of the specification.

Ultimately, the court concluded that the specification and the prosecution history "provide clear and unequivocal evidence that the inventor intended to disavow any claim scope encompassing short seals that are not inwardly extended." Although the Federal Circuit technically held that the combination of specification and prosecution history provided a restricted claim scope, it is possible that claims may be given a narrowed interpretation based on any one of (a) describing a feature as being part of "the present invention" in the specification, (b) disparaging prior art for lacking a feature, regardless of whether the feature is explicitly claimed, or (c) distinguishing the claims over prior art by asserting that the prior art lacks a feature.

### Takeaways:

Although a patent applicant may potentially circumvent some prosecution history estoppel issues through the use of a properly-filed continuation or divisional application, the Federal Circuit opinion in *Poly-America* provides clear caution that the use of the term “present invention” in the specification may be fatal. Describing the distinctions and benefits of inventions over the art, on the other hand, can be very advantageous. For example, advantages over the prior art can provide evidence of secondary factors and help to show that the invention is not obvious. As another example, for those facing subject matter eligibility rejections, advantages over the prior art can help demonstrate that the claimed invention is not routine, conventional, or well known. However, in order to mitigate any adverse effects of discussing an invention’s advantages, benefits over the prior art should be couched within non-limiting modifiers. For example, benefits can be described with respect to some embodiments, but not all (e.g., “in some implementations of the current subject matter,” “in certain embodiments,” etc.). Further, during prosecution, patent applicants should separately argue claims with differing features unless the applicant wants to simultaneously limit the scope of all of the claims.

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