

Federal Circuit Expands Scope of Prosecution Disclaimer to IPR Proceedings

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In its opinion in [*Aylus Networks, Inc. v. Apple Inc.*](#), the *Federal Circuit* expanded the scope of prosecution disclaimer to statements made by a patent owner during *Inter Partes* Review (IPR) proceedings. The Court explained that extending the doctrine to cover patent owner statements, made either before or after institution of an IPR, ensures that claims are not argued in one way to maintain patentability and a different way to support infringement allegations. The Court also noted that its conclusion promotes the public notice function of intrinsic evidence and protects the public's reliance on statements made during IPR proceedings.

By way of context, the doctrine of prosecution disclaimer prevents patent owners from recapturing claim meanings disclaimed during prosecution through later claim interpretation. The disclaiming actions or statements made during prosecution must be both clear and unmistakable in order for prosecution disclaimer to apply—only when a patentee clearly and unmistakably disavows a certain meaning in order to obtain a patent is the claim narrowed consistent with the patent owner's disavowal. This doctrine allows competitors to rely on statements made during prosecution when determining a course of conduct, for example, when designing or launching new products.

The doctrine originally arose in the context of pre-issuance patent prosecution. However, it was later applied to statements made during reissue and reexamination proceedings. The Court found that extending the doctrine to statements made during IPR proceedings naturally flowed from these previous applications. In doing so, the Court rejected two arguments made by Aylus: (1) that an IPR proceeding is adjudicative rather than administrative, and therefore statements made during an IPR proceeding are unlike those made in reissue or reexamination proceedings; and (2) the statements at issue in *Aylus v. Apple* were not part of an IPR "proceeding" because they were made in a preliminary response.

In dismissing the first argument, the Court found that, because an IPR proceeding involves the *reexamination* of an earlier patent grant by an administrative body, it follows that statements made during the course of IPR proceedings can be used during claim construction. Second, though the Court has previously said that an IPR does not begin until it is instituted, for purposes of prosecution disclaimer the differences between the decision on institution and the proceeding itself

are immaterial. Papers filed before and after institutions are official, public documents in which patent owners can define claim terms and make representations about claim scope. Regardless of whether filed before or after institution, the Court noted that the public is entitled to rely on representations made by patent owners in these official, public documents. For these reasons, the Court found that prosecution disclaimer applied to IPR proceedings regardless of which point in the IPR the statements were made.

As a result, patent owners in the future must take care in arguments to the Patent Trial and Appeal Board (PTAB) during IPRs, even in their Patent Owner's Initial Response to the Petition, in order to ensure they are not unintentionally limiting the scope of patent claims. Failing to take such care may undermine existing or future patent infringement actions.

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