

## **UCB v. Yeda Research: Estoppel against Unamended Claim**

Yesterday in *UCB, Inc. v. Yeda Research and Development Co., Ltd.*, \_\_\_ F.3d \_\_\_, 2016 WL 4698962 (Fed. Cir. 2016)(Newman, J.), the court reaffirmed the holding in *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255, 259 (Fed. Cir. 1985), that prosecution history estoppel can apply to an **unamended** claim, based upon amendments made to other claims.

An excerpt from the opinion is attached to the pdf version of this note.

Regards,  
Hal

***From the opinion:*** “[The patentee] argues that absent a narrowing amendment to \*\*\* claim 1, there can be no prosecution estoppel to the scope of claim 1, merely because some proposed different claims were rejected by the examiner and then dropped by the applicant. That is not a correct general principle. Although each claim in a patent warrants independent consideration in light of its particular facts and history, ***the general rule is that a patent applicant cannot later obtain [claim] scope that was requested during prosecution, rejected by the Examiner, and then withdrawn by the applicant.*** Such estoppel was reasonably applied to claim 1 by the district court, although claim 1 had not been amended. In *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255, 259 (Fed. Cir. 1985), the court rejected the argument that ‘file wrapper estoppel cannot arise without an amendment,’ and explained that the ‘position must be evaluated in the context of this specific case.’ In *Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc.*, 103 F.3d 1571, 1578 (Fed. Cir. 1997), the court again explained: ‘We examine the statements and actions of the patentee before the PTO during prosecution ... and ask what a competitor reasonably may conclude the patentee surrendered to gain issuance of the patent.’ (internal citations omitted).”  
[colored material added for emphasis]