

## CASE LAW UPDATE

September 13, 2005

<b>CASE</b>	Alfred SALAZAR, Plaintiff-Appellant v. PROCTER & GAMBLE CO., Defendant-Appellee. Decided July 8, 2005.
<b>MAIN ISSUES</b>	Do unilateral statements of the Examiner in stating reasons for allowance create a clear and unambiguous disavowal of claim scope and give rise to prosecution history estoppel?
<b>EXECUTIVE SUMMARY</b>	Patentee declined to comment on the Examiner's Statement of Reasons for Allowance. Court held that patentee's silence on the Statement is not an acquiescence of any patent rights.
<b>KEY TERMS</b>	Statement of Reasons for Allowance; prosecution history estoppel

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**PROCEDURAL POSTURE** District Court (N.D. Oklahoma) granted summary judgment of non-infringement because Salazar failed to present sufficient evidence to raise an issue of fact about the elasticity of the stimulator and polishing rods in the accused products. District Court also found that prosecution history estoppel precluded plaintiff from asserting infringement under DoE.

**FACTS** Salazar is the sole named inventor on U.S. Patent No. 5,535,474 for "Brush for Cleaning and Polishing Teeth While Stimulating Gums". The initial claims of Salazar's patent application included independent claim 1 and five dependent claims. Claim 2 depended from claim 1; claim 3 depended from claim 2. Claim 1 was rejected as obvious over U.S. Patent No. 3,072,944 (Clayton) in light of U.S. Patent No. 3,103,679 (Clemens), while Claims 2 and 3 were allowable. Applicant cancelled claims and introduced new claim 7, which included limitations from claims 1, 2, and 3. Claim 7 was allowed without rejection.

In the Examiner's Statement of Reasons for Allowance, the examiner stated "Claim 7 now incorporates previously allowable subject matter . . . . Although the patent to Clemens appears to have the recited structure, Clemens' 'rods' 22 are made of nylon, which is not considered 'elastic'. Obviously, the rods of Clemens are flexible, but are not considered to be 'elastic' as recited by the claim." Applicant made no comment to the Statement and U.S. Patent No. 5,535,474 (the '474 patent) issued on July 16, 1996.

Salazar sued P&G for infringing the '474 patent. The district court interpreted "elastic" as "any material, other than nylon, capable of returning to an initial state or form after deformation." The court also concluded that Salazar failed to present sufficient evidence to raise an issue of fact about the elasticity of the stimulator and polishing rods in the accused product. The district court granted Summary Judgment in favor of P&G, and Salazar appealed.

**HOLDING** In holding that the patentee's silence concerning the Statement of Reasons for Allowance resulted in no disavowal of any claim scope, the court recognized that the Statement of Reasons for Allowance will not necessarily limit a claim. Court vacated claim construction of term "elastic" as excluding nylon, and remanded.

**COURT'S REASONING** Although the regulations in force at the time of allowance (37 CFR 1.109 (1996)) offer an applicant an opportunity to respond to reasons of allowance, the applicant does not acquiesce in those reasons if he declines to respond.

**PANEL** RADER, BRYSON (dissent), and GAJARSA