

The Integrated Patent Instrument

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Abstract

Inventors who apply for a patent at the U.S. Patent and Trademark Office (PTO) routinely negotiate with the PTO over the patent's scope. The written record of that negotiation is called the prosecution history. For the past three decades, courts have held and many scholars have assumed that this written record is intrinsic evidence to a patent. The U.S. Court of Appeals for the Federal Circuit reviews de novo a trial court's findings based on that written history when construing the scope of a patent—as if such findings were pure determinations of law—because it considers that history intrinsic evidence. In doing so, the Federal Circuit encourages appeals, discourages settlement, and prolongs expensive litigation when trial courts determine the outcome of a case based on a prosecution history. In short, de novo review of that history foments litigation and taxes innovators.

This Article argues that treating prosecution history as intrinsic evidence is incorrect in concept and inconsistent with a patent as an integrated legal instrument. Instead of the prevailing view, this Article suggests that contract principles provide a coherent paradigm through which courts and scholars can understand a patent and its history. Those principles frame patents as integrated instruments, prosecution histories as extrinsic evidence, and findings based on those histories as determinations of fact, not law. This paradigm suggests a sea change in how courts should review patent constructions—namely, the Federal Circuit should review findings based on prosecution histories for clear error only, like other factual questions, not de novo, like pure questions of law. By reviewing such findings for clear error, the Federal Circuit can discourage appeals and thereby reduce costs in cases where factual inquiries based on the prosecution history drive the final construction of a patent.