



Working Guidelines

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Q229

Use of prosecution history in post-grant proceedings

Introduction

- 1) The AIPPI Executive Committee decided, at the 2011 meeting in Hyderabad, to undertake a study of the use of prosecution history in post-grant proceedings. Despite moves toward harmonization in many areas of patent law, this issue remains one area where widely divergent practices and policies exist among various countries and regions. The degree to which prosecution history may be used in later proceedings, both in the original jurisdiction and potentially in others, affects the daily practice of patent attorneys around the world and hence merits careful study.

Previous Work of AIPPI

- 2) The subject of prosecution history estoppel and its effects on later proceedings have been touched upon in prior work of AIPPI. However, the subject has not been considered in its full breadth.
- 3) Q142, "Breadth of claims, support by disclosure and scope of protection of patents" was considered at the Rio de Janeiro Congress of 1998. In the context of examining the requirements for adequate support, it was resolved that:
 5. *Material filed during examination or in the course of inter partes proceedings to justify any generalisation in the claims of specific disclosures in the description shall not:*
 - a) *have any effect on the scope of the disclosure of the patent application as filed;*
 - b) *form part of the patent;*
 - c) *serve to remedy any inadequacy in the description as filed.*
- 4) The issue of prosecution history was also considered in the context of equivalents in Q175, "The role of equivalents and prosecution history in defining the scope of patent protection." The working guidelines asked the questions,

*Does the prosecution history play a role in determining the scope of patent protection?
If so, how does it work? In particular:*

- a) *Is there "file wrapper estoppel"? If so, in what circumstances does it arise?*
- b) *Is there a difference between formal (e.g. oppositions) and informal (e.g. discussions with the examiners) actions in the Patent Office?*
- c) *Is there a difference between actions taken by the Patent Office and by third parties?*

Although these questions addressed prosecution history in a broad sense, the resolution reached at the Executive Committee meeting of Lucerne, 2003, was limited to the context of equivalents:

Notwithstanding that an element is regarded as an equivalent, the scope of protection conferred by a patent claim shall not cover the equivalent if:

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c) the patentee expressly and unambiguously excluded it from the claim during prosecution of that patent to overcome a prior art objection.

Discussion

- 5) In the interest of clearly defining the scope of this question, "prosecution history" as used herein will include:
 - a) amendments made to the application during the examination process, including amendments to the claims, specification, or drawings, and
 - b) arguments made to the examiner during the examination process.

Statements or definitions made in the specification as originally filed are outside the scope of this question and shall not be considered "prosecution history."
- 6) "Post-grant proceedings" as used in these working guidelines shall include any proceedings that require determining claim scope:
 - a) proceedings before a patent office, including, e.g.:
 - i. reexamination or reissue;
 - ii. opposition; and
 - iii. invalidity proceedings; and
 - b) proceedings before a court, including, e.g.:
 - i. infringement;
 - ii. invalidity; and
 - iii. support / sufficiency of disclosure.
- 7) While there are many variations in practice, two primary schools of thought exist with regard to whether prosecution history should be used to interpret claims in post-grant proceedings. Interestingly, although they are diametrically opposed, both are based primarily on public policy rationales. The first school of thought considers it contrary to the public interest to allow an applicant for patent to argue, for example, a narrow interpretation of the words or phrases of a claim during prosecution in order to distinguish over prior art, and then to later argue a broader interpretation in support of a charge of infringement. The second school of thought will argue that it is the claims, not the prosecution file, that fulfill the public notice requirement

and therefore it is contrary to the public interest to require reading of the prosecution file to determine what a claim means. Indeed, this second school of thought will argue that if a particular interpretation is necessary to obtain allowance, then such language should be placed in the claim (or specification) to make this clear.

- 8) Use of prosecution history in the “claim construction” phase of a post-grant proceeding is well established in the United States. Originally known as the doctrine of “file wrapper estoppel,” (referring to the documents formally stored in the paper files at the US Patent and Trademark Office) and now called “prosecution history estoppel,” the doctrine holds that a U.S. court will consider representations made by the applicant during the examination process in determining the meaning of the claims. “[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*). Claim language is therefore limited if the prosecution history contains any express representations made by the applicant regarding the scope of the claims. “The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.” *Southwall Tech. Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).
- 9) Although not specifically provided for in legislation, the practice in Japan is similar in effect to that of the United States. In post-grant proceedings, typically court proceedings, parties commonly present arguments based on the statements made by the patent applicant during prosecution. The courts will review these arguments and use them, where appropriate, in interpreting the meaning of the claims. The Supreme Court specifically addressed the use of prosecution history in the context of the doctrine of equivalents, stating that one of the requirements for applying the doctrine of equivalents is that “there were no special circumstances such as the fact that the products had been intentionally excluded from the scope of the patent claim in the patent application process.”
- 10) In Sweden, a court is entitled to consider the prosecution history when it is relevant. The principle of free evaluation of evidence is set out in the Swedish Code of Judicial Procedure and means that the court should take into account everything presented during the proceedings and based on that make its judgment. It is up to the parties to present evidence and state what they intend to prove by each piece of evidence. Then the court will look at the evidentiary value of the evidence presented. There is no legislation that particularly addresses the question of use of prosecution history in post-grant patent proceedings. However, in a case heard by the Supreme Court (NJA 2002 s. 660) about the granting of an interim injunction, the Supreme Court stated that it should be allowed to use data from the prosecution file when interpreting uncertainties and obscurities in patent claims and the specification in matters of limitation of the scope of protection.
- 11) Under Australian law, there is no equivalent to prosecution history estoppel. *Baygol Pty Ltd v Foamex Polystyrene Pty Ltd* (2005) 64 IPR 437 (*Baygol*), held that the Patent Office file could not, and should not, be admitted in that case. The court stated that there was ‘great force’ in the proposition that Australian law does not look at such extrinsic material as the Patent Office file. *Baygol* was cited in *Ranbaxy Australia Pty Ltd v Warner-Lambert Company LLC* [2006] FCA 1353 as authority for the proposition that documentary evidence disclosing the patentee’s intentions, opinions or submissions in communications with the Patent Office will not be admissible. Further, the Australian Patent Examiner’s Manual states that ‘[a] specification

should provide a full description of the invention without reference to other documents (cl 2.11.3.7). Nevertheless, there is some authority that conduct during the application stage for a patent may be considered by a court in a post-grant proceeding. Under section 138(3)(d) of the Patents Act 1990 (Cth), the court may revoke a patent on the basis that it was obtained by fraud, false suggestion or misrepresentation. *Uniline Australia Ltd v S Briggs Pty Ltd* (2009) 81 IPR 42 is an example where a judge was prepared to consider communications at application stage when deciding whether fraud, false suggestion or misrepresentation was present on the facts.

- 12) In Canada, the Supreme Court of Canada in *Free World Trust v. Electro Santé Inc.* [2000] 2 S.C.R. 1024 emphatically rejected use of prosecution history in claim interpretation, stating: “To allow such extrinsic evidence for the purpose of defining the monopoly would undermine the public notice function of the claims, and increase uncertainty as well as fuelling the already overheated engines of patent litigation.” Similar sentiments are found in Germany and Ireland. The United Kingdom “discourages” the use of prosecution history in claim construction. In China, however, the patentee may not recapture what was abandoned (either through amendment or disclaimer) during prosecution in later patent invalidation proceedings.
- 13) Contrary to most of Europe, the Dutch Supreme Court has adopted the doctrine of prosecution history estoppel. Specifically, the Court held “in the event a third party invokes the prosecution history file to substantiate its interpretation of the patent, it cannot reasonably be considered that such requirement would require (i.e. reasonable legal security for third parties) any restriction with respect to taking into consideration of publicly accessible information found in the prosecution history file upon interpretation of the patent.” *Dijkstra v. Saier* (22 December 2006).

Questions

The Groups are invited to answer the following questions under their national laws.

- 1) What types of post-grant proceedings are available in your jurisdiction? Are post-grant proceedings available both at a patent office and at a court?
- 2) In your country or region, may the prosecution history be taken into account for purposes of interpreting claim scope during post-grant proceedings?

If the answer to question 2 is yes, please answer the following questions:

- a) Please explain the types of prosecution history that may be considered. For example:
 - i. Does applicable prosecution history include amendments, arguments, or both?
 - ii. Could applicable prosecution history include a limiting interpretation that is *implied* through the applicant’s arguments, or would it include only *explicit* definitional statements?
 - iii. Does applicable prosecution history include only amendments to the claims, or does it also include amendments to any aspect of the disclosure?
 - iv. Does it matter if the amendments and/or arguments are made to overcome prior art versus being made to address sufficiency or some other formal requirement?
 - v. Does it matter if the prosecution history has the effect of broadening the interpretation of the claim, versus narrowing it?

- b) Does the applicability of prosecution history depend on when the prosecution history occurred? For example, does it matter if a particular statement by an applicant was made during initial examination as opposed to during a later invalidity proceeding?
- c) Does the applicability of prosecution history depend on the type of post grant proceeding, or on the authority before which the proceeding is held? For example, would prosecution history be more applicable in an infringement action at court than in a post-grant patent office invalidity proceeding?
- d) Is the applicability of prosecution history limited to infringement proceedings where equivalents are an issue?
- e) Could prosecution history from a corresponding foreign application be considered in a post-grant proceeding in your jurisdiction? If so, under what circumstances?
- f) Is the use of prosecution history authorized by statute or by case law in your jurisdiction?
- g) Explain the policy reasons for considering prosecution history during the claim interpretation process.

If the answer to question 2 is no, please answer the following questions:

- h) Is the disallowance of use of prosecution history mandated by statute or by case law in your jurisdiction?
 - i) Explain the policy reasons for not considering prosecution history during the claim interpretation process.
- 3) Assuming that at least some countries will consider foreign prosecution history as part of claim interpretation in their jurisdictions, does this have implications for how you would handle prosecution of a patent application in your country? Is this problematic?
 - 4) In your country or region, may a patent be invalidated in post-grant proceedings on the basis of the same prior art which was taken into account by the examiner of the patent office during prosecution of the patent? If so, may the patent be invalidated on the basis of the same prior art and the same argument used by the examiner or may the same prior art only be used if it is shown that there is a new question based on some other teaching or aspect of that prior art?

Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the use of prosecution history in post-grant proceedings. More specifically, the Groups are invited to answer the following questions *without* regard to their national laws:

- 1) Is harmonization of the applicability of prosecution history in post-grant proceedings desirable?

- 2) Is it possible to find a standard for the use of prosecution history that would be universally acceptable?
- 3) Please propose a standard you would consider to be broadly acceptable for a) the types of prosecution history that should be considered, if any; and b) the type of proceeding and circumstances in which it should be considered.

National Groups are invited to comment on any additional issue concerning the use of prosecution history in post-grant proceedings that they deem relevant.

NOTE:

It will be helpful and appreciated if the following points could be taken into consideration when editing the Group Report:

- kindly follow the order of the questions and use the questions and numbers for each answer
- if possible type your answers in a different colour
- please send in a word document
- in case images need to be included high resolution (not less than 300 dpi) is required for good quality printing