

Seite der AIPPI / La page de l'AIPPI

The use of prosecution history in post-grant patent proceedings (Q 229)

REPORT OF SWISS GROUP^{*}

Questions

I. Analysis of current legislation and case law

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?

a) Post-grant proceedings available to third parties:

In Switzerland, the following post-grant proceedings are available: validity and infringement disputes and actions for issuing a license in respect of patents. These post-grant proceedings are available only at the Federal Patent Court and are subsequently appealable at the Federal Supreme Court.

Before the EPO, third parties have the possibility according to Art. 99 EPC to file an opposition against the grant of a European patent within nine months after the publication of the mention of the grant of the European patent. Analogously, but only limited to the exclusions under Articles 1a (human body as such), 1b (gene sequences as such) and 2 (non patentable inventions) PA, opposition can also be filed before the Swiss Patent Office against the grant of a Swiss patent (Art. 59c PA).

b) Post-grant proceedings available to the patent proprietor:

Furthermore, the patent proprietor has the possibility under Art. 105a EPC to limit or to revoke a European patent. Thereby, the Swiss part of a European patent will also be affected. A similar provision also exists in Swiss Patent Law, whereby under Art. 24/15a PA the patent proprietor may limit or surrender a Swiss patent or a Swiss part of a European Patent by means of a limitation or renounce (Teilverzicht/Verzicht).

See also Swiss Report on Q189.

2. In your country or region, may the prosecution history be taken into account for purposes of interpreting claim scope during post-grant proceedings?

Article 69 EPC and Article 51 PA form the basis for claim interpretation in post-grant proceedings, which provisions hold that the description and drawings shall be used to interpret the claims. Thus, prosecution history is not a statutory means for claim interpretation in post grant proceedings. One of the main reasons for this policy is to ensure legal certainty for third parties, who should not be expected to look into the prosecution history in order to determine the scope of a claim.

However, doctrine and at least one (unpublished, first instance) judgment of the Commercial Court of Zurich point out that the principle of good faith (Art. 2 CC, abuse of law) must be observed in the interpretation of claims. This means that statements made during the grant procedure may be taken into account if the patent proprietor clearly contradicts those statements in a post-grant procedure. Under such circumstances, account must also be taken of explicit restrictions and waivers on the part of the applicant in the grant procedure. According to the Commercial Court of Zurich, this applies in particular when the restriction is incorporated into the claims (unpublished decision of the Commercial Court of Zurich of 15 April 2008, HG060066).

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The Federal Patent Court, which is the first instance court for patent disputes in Switzerland since January 1, 2012, has just begun to operate, and thus no decisions are available yet on this subject from this Court.

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:

If the principles of good faith require consideration of prosecution history as set forth above,

i. does applicable prosecution history include amendments, arguments, or both?

The above-mentioned judgment of the Commercial Court of Zurich suggests that prosecution history may include 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?

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iii. does applicable prosecution history include only amendments to the claims, or does it also include amendments to any aspect of the disclosure?

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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?

The above-mentioned judgment of the Commercial Court of Zurich suggests that amendments and/or arguments may be considered irrespective of the reasons for which they were made.

v. could applicable prosecution history include a limiting interpretation that is implied through the applicant's arguments, or would it include only explicit definitional statements? Does it matter if the prosecution history has the effect of broadening the interpretation of the claim, versus narrowing it?

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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?

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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?

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d) Is the applicability of prosecution history limited to infringement proceedings where equivalents are an issue?

Under the principles of good faith, the answer would be no. There is, however, no caselaw that would provide guidance in this respect.

e) Could prosecution history from a corresponding foreign application be considered in a post-grant proceeding in your jurisdiction? If so, under what circumstances?

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f) Is the use of prosecution history authorized by statute or by case law in your jurisdiction?

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g) Explain the policy reasons for considering prosecution history during the claim interpretation process.

See above, question 2) first part.

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?

See above, question 2) first part.

i) Explain the policy reasons for not considering prosecution history during the claim interpretation process.

See above, question 2) first part.

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?

Yes, it has implications.

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?

A Swiss patent or the Swiss part of a European patent can be invalidated in Swiss post-grant proceedings on the basis of the same prior art cited before the Patent Office. In such a case, both scenarios mentioned in question 4) might occur.

II. 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?

Yes, the present situation is not at all satisfactory in view of the existence of different systems in different jurisdictions that renders problematic the handling of the patent application prosecution as well as the interpretation of claim scope.

2. Is it possible to find a standard for the use of prosecution history that would be universally acceptable?

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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.

In principle, claim interpretation should rely on intrinsic evidence directly derivable from the patent itself, unless such claim interpretation is contrary to good faith (abuse of law) in light of the prosecution history.

Summary

In Switzerland, Article 69 EPC and Article 51 PA form the basis for claim interpretation in post-grant proceedings, which provisions hold that the description and drawings shall be used to interpret the claims. Thus, prosecution history is not a statutory means for claim interpretation in post grant proceedings. However, doctrine and at least one judgment of the Commercial Court of Zurich point out that the principles of good faith (abuse of law) must be observed in the interpretation of claims. This

means that statements made during the grant procedure may be taken into account if the patent proprietor clearly contradicts those statements in post-grant proceedings. Under such circumstances, account must also be taken of explicit restrictions and waivers on the part of the applicant in the grant procedure, in particular when the restriction is incorporated into the claims.

In the opinion of the Swiss Group, claim interpretation should rely on intrinsic evidence directly derivable from the patent itself, unless such claim interpretation is contrary to good faith (abuse of law) in light of the prosecution history.

Zusammenfassung

In Verfahren nach der Patenterteilung richtet sich die Auslegung von Patentansprüchen in der Schweiz nach den Art. 69 EPÜ und Art. 51 PatG. Diese Bestimmungen legen fest, dass zur Auslegung von Patentansprüchen die Beschreibung und die Zeichnungen heranzuziehen sind. Die Erteilungsakten stellen demgegenüber keine gesetzlichen Auslegungshilfen dar. Die Lehre und zumindest ein Urteil des Handelsgerichts Zürich heben jedoch hervor, dass das Gebot des Handelns nach Treu und Glauben sowie das Verbot des Rechtsmissbrauchs auch im Rahmen der Auslegung von Patentansprüchen zu berücksichtigen sind. Demnach seien Erklärungen im Erteilungsverfahren zu beachten, wenn sich der Patentinhaber in einem späteren Verfahren in klaren Widerspruch dazu setzt. Beachtlich seien ausdrückliche Beschränkungen und Verzichte des Anmelders im Erteilungsverfahren jedenfalls dann, wenn sie in den Anspruch aufgenommen worden seien.

Nach der Auffassung der Schweizer Gruppe sollten Patentansprüche anhand der in der Patentschrift selbst enthaltenen Information ausgelegt werden. Eine Ausnahme soll für den Fall gelten, dass die so vorgenommene Auslegung im Lichte der Erteilungsakten zu einem rechtsmissbräuchlichen Ergebnis führt.

Résumé

En Suisse, l'article 69 CBE et l'article 51 LBI forment la base pour l'interprétation des revendications dans les procédures après délivrance, et disposent que la description et les dessins servent à interpréter les revendications. Le dossier de délivrance du brevet n'est donc pas un moyen législatif pour interpréter les revendications dans les procédures après délivrance. Cependant, la doctrine et au moins un jugement du tribunal du commerce de Zurich soulignent que le principe de bonne foi (abus de droit) doit être considéré dans l'interprétation des revendications. Cela signifie que les déclarations faites lors de la procédure de délivrance peuvent être prises en compte si le titulaire du brevet contredit de manière évidente ces mêmes déclarations dans les procédures après délivrance. Dans de telles circonstances, il faut de même regarder aux restrictions explicites et aux renoncements de la part du titulaire au cours de la procédure de délivrance, surtout si une restriction est incorporée dans les revendications.

Selon l'avis du Groupe Suisse, l'interprétation des revendications devrait se baser sur les preuves intrinsèques dérivables directement du brevet, à moins que cette interprétation ne soit contraire à la bonne foi (abus de droit) en vue du dossier de délivrance.