

## Question Q229

**National Group:** Netherlands

**Title:** **The use of prosecution history in post-grant patent proceedings**

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### 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?

In the Netherlands, on a national level the relevant post-grant proceedings are Court proceedings. These concern both infringement and validity, which are in most cases tried in the same proceedings. After a first instance decision of the District Court of The Hague (which has a specialized chamber for patent litigation), there is a possibility of an appeal before the Court of Appeal in The Hague (no leave being required) and finally, the Dutch Supreme Court may rule on points of law or a lack of proper reasoning.

For Dutch national patents granted by the Dutch patent office (now: *NL Octrooi Centrum*), the Dutch Patent Act 1995 provides in Article 76 that an action for the invalidation of a Dutch national patent shall be dismissed if the applicant does not obtain and submit a validity advice from the national patent office. Since i) there is usually no or a very limited prosecution file in respect of Dutch national patents and ii) the Court is not bound by the advice, the Dutch group will not address this particular procedure in this report.

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

The Supreme Court of the Netherlands has consistently held that both the patentee and the alleged infringer may rely on the public parts of the prosecution history to advance a claim interpretation, although - as will be explained below - more restrictions apply where it concerns the patentee<sup>1</sup>. To this it should be added that the Supreme Court has given only limited guidance under which circumstances and exactly how the prosecution history may play a role in determining the scope of the claims.

In this case law, first of all a distinction is made between situations where the patentee relies on the prosecution history, and ii) where it is the alleged infringer.

#### In favor of the patentee

The patentee may use the prosecution history to his advantage, but in view of the legal certainty for third parties only under exceptional circumstances, more specifically only when it is established that the skilled person, having consulted the description and drawings of the patent, would still have reasonable doubts as to the meaning of the claims. In that case the patentee may rely on elucidating information in the public part of the prosecution history.<sup>2</sup> At the same time, any lack of clarity resulting from the careless drafting of the patent is for the risk of the patentee.

Also in view of the latter principle, using the prosecution history to the advantage of the patentee is generally considered to be highly exceptional or even theoretical.

#### In favor of third parties

The Supreme Court held that when consulting the prosecution file in favor of the alleged infringer, there is no ground for a restrictive approach. The Supreme Court held that

*in the event that a third party invokes the prosecution history file to substantiate his interpretation of the patent, there is no reason why that principle of legal certainty would dictate any reservations in relying on publicly available information for the prosecution history to interpret the patent.*

In addition, the Supreme Court held that there is no relevant distinction to be made between the situation where a patentee surrenders a part of the scope of protection (which may only be assumed "on good grounds") or the situation where a third party alleges that *the patentee claims subject matter which it did not claim during prosecution*.

An example of the latter is the situation where the patentee overcame a novelty objection by introducing a limitation into the claim. In later infringement proceedings the patentee advanced a broad interpretation of the claim which effectively disregarded this specific limitation. The Supreme Court accepted that under those circumstances, where the prosecution file confirmed the skilled person's interpretation that it concerned an essential feature of the invention, such a broad claim interpretation cannot be accepted.<sup>3</sup>

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<sup>1</sup> See Supreme Court 22 December 2006, LJN ZA 1081 (Dijkstra/Saier), also restating/addressing earlier Supreme Court case law such as Supreme Court 13 January 1995, NJ 1995, 391 (*Ciba Geigy AG vs. Oté Optics*).

<sup>2</sup> Supreme Court 12 November 2004, NJ 2004/674 (Impro/Liko).

<sup>3</sup> Supreme Court 13 January 1995, NJ 1995/63 (Dreizler/Remeha).

## Conclusions

On the basis of this case law, it is clear that third parties may rely on the prosecution history without any restrictions when advancing their perspective on claim interpretation. However, little guidance is given under which circumstances the prosecution history will actually have consequences as to the scope of the claims. What is clear is that it must not be assumed too readily that the patentee has surrendered part of the scope of protection which would otherwise fall within the scope of the claims. This may only be assumed *on good grounds*, which is intended to express that the courts should not readily conclude that this is the case.<sup>4</sup>

At District Court and Appeal Court level, the prosecution history is frequently considered. However, even though it is often said to play a role in claim interpretation, in most cases it is used to confirm the interpretation established on the basis of the description and drawings, and not as an independent source of information for the interpretation of claims or claim features.<sup>5</sup>

### ***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?

The case law in the Netherlands has not made this distinction but has used the expression "*publicly available information*" from the prosecution file. It is therefore safe to say that that amendments as well as arguments may be considered, observing the restrictions as explained in the general introduction above.

- 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?

The existing case law has not ruled out that a limiting interpretation may be implied, but the case law generally requires that there are *good grounds* to assume that the patentee has limited the scope of the patent/has surrendered part of the scope of protection. It may be assumed that therefore under normal circumstances, a restriction of the scope of protection would result either a) from an explicit limiting statement or b) from an implicit statement, provided that such a limitation is the direct and unambiguous consequence of the applicants' arguments or amendments.

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<sup>4</sup> Supreme Court 27 January 1989 NJ 1989/506 (*Meyn/Stork*) and Supreme Court 22 March 2002, NJ 2002/530 (*Van Bentum/Kool*).

<sup>5</sup> See e.g. Court of appeal The Hague 3 July 2003, LJN AH9364 (*Boston Scientific/Cordis*);

In *Van Bentum/Kooij*<sup>6</sup>, the Supreme Court has rejected a certain rule of claim interpretation in situations where the patentee has "voluntarily" limited the patent more than necessary in view of the prior art. The Supreme Court rejected the view, expressed by the Court of Appeal, that third parties could assume that there were "good grounds" why certain obvious equivalent embodiments fell outside the literal scope of the claims and should therefore be considered non-infringing. The Supreme Court held that such a rule of interpretation was held contrary to the general rule of claim interpretation, whereby a balance should be struck between a fair protection for the patentee and the legal certainty for third parties. The Supreme Court considered that the skilled person, also in the situation where he would consult the prosecution history, would be satisfied that under the circumstances of that case, there was no objective reason for the limitation to certain specific embodiments.

On the other hand, in a more straightforward case where a limitation was introduced to overcome a novelty objection, the patentee is not allowed to broaden the claim such as to effectively disregard the limitations in infringement proceedings.<sup>7</sup>

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

The case law has not made such a distinction and rather refers to "*publicly available information*" in the prosecution history, which indicates that also amendments to the specifications may be taken into account.

In the *AGA/Occlutech*<sup>8</sup> case, the Court of Appeal held that certain parts of the description would not serve to interpret the claims as it was held that the skilled person would, on the basis of the prosecution history, consider those parts to apply to an embodiment which was no longer claimed when the patent issued. The Supreme Court has yet to rule on this point of law.

- 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?

There is no established case law of the Supreme Court on the relevance of this difference.

If the statements of the patentee qualify as "*surrendering (part of) the scope of protection*", the question *why* the patentee abandoned part of the protective scope of his patent is likely to be irrelevant to the Dutch courts.

However, as explained above, surrendering part of the protective scope can *only* be assumed on "good grounds. To assess whether or not a third party can rightfully argue that such "good grounds" are present, it seems relevant to look at the *context* in which the patentee made the amendments/arguments

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<sup>6</sup> Supreme Court 22 March 2002, NJ 2002/530 (*Van Bentum/Kooij*).

<sup>7</sup> Supreme Court 13 January 1995, BIE 1995/63 (*Dreizler Remeha*)

<sup>8</sup> Court of Appeal 19 October 2010, IEPT20101019 (*AGA/Occlutech*)

during prosecution on which the third party wants to rely for a limited interpretation of the granted claims.

It is first of all noted that amendments/arguments made during prosecution are often made in the context of validity, not in the context of infringement/protective scope. It therefore seems that there are only “good grounds” to assume that the patentee has “surrendered (part of) the protective scope” of his patent, if the broad(er) scope brings him into validity problems.

The controlling question then seems to be: is there a squeeze between validity and infringement? This is not always the case: determination of validity of subject matter, and determination of protective scope after grant, are two different issues, with different rules and different requirements.

In this respect, it should matter if the amendments and/or arguments made during prosecution were to overcome prior art (novelty, inventive step), or if they were made to address other requirements (such as added matter).<sup>9</sup>

If the patentee was forced to limit his claims to overcome novelty or inventive step issues with prior art, a broad(er) interpretation/construction of certain claim features for protective scope purposes to (try to) bring the allegedly infringing product or process under the subject matter of the claim will indeed bring the patentee in trouble: his claim could then (again) encompass the prior art he demarcated his claim from during grant, or an obvious variant of that prior art, which could render the claim invalid for lack of novelty or inventive step.

But in a case in which the patentee had to introduce a certain limitation of his claim during prosecution, in part to overcome formal requirements, such as clarity or added matter, scope of protection and validity may not be directly interrelated. The circumstance that certain subject matter cannot be *claimed* explicitly for added matter reasons, does not (necessarily) mean that the patentee could not argue a broader scope of protection in infringement proceedings.

- v. Does it matter if the prosecution history has the effect of broadening the interpretation of the claim, versus narrowing it?

Reference is made to the general introduction above.

In The Netherlands, the court may under certain circumstances use clarifying data from the prosecution history to interpret the claims. However, use of the file prosecution history in favor of the patentee is restricted, and therefore broadening the claim solely on the basis of the prosecution file seems a theoretical possibility only.

The use of the file prosecution in favor of a third party is in principle without restriction, although it is not always clear how and under which circumstances. Nevertheless, it may be assumed that all cases where a third party (alleged infringer) relies on the prosecution file, he will seek to limit the scope of protection.

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<sup>9</sup> See in this respect also W.A. Hoyng, *De dood van de angorakat?* [The death of the angora cat?], BIE 2007, no. 11, p. 628-633 and Court of Appeal 3 July 2003, LJN AH 9364 (Boston Scientific/Cordis).

- 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?

The case law has not made such a distinction but has primarily dealt with "*publicly available information*" in the prosecution history.

It is therefore likely that in respect of statements made in later validity proceedings before the national courts or before a foreign court, the more general principles of civil law *estoppel* or "*surrender of rights*" applies. Arguably, on the basis of these rules there would be less room to argue that the patentee has limited the scope of protection than in the context of prosecution history, as the test would rather more be whether the patentee has unambiguously abandoned his rights or part of his rights. The mere inconsistency of statements may not be sufficient for such a conclusion.

- 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?

Reference is made to the general introduction. Only Court proceedings are considered by the Dutch group.

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

No, in the above discussed Supreme Court case law about allowing the prosecution history as a source for claim construction, the Dutch Supreme Court did not distinguish between 'literal infringement' and 'equivalent infringement'

In lower case law examples may be found of a practice to use the prosecution file (if relied on by the parties) to determine whether a limitation is "essential".<sup>10</sup> If a limitation is deemed essential, the consequence is that there is no room to extend the scope of the claim on the basis of a functional interpretation or on the basis of equivalence.<sup>11</sup> The Supreme Court has held that if the prosecution history confirms that the specific limitations were the distinguishing features over the prior art, these may not effectively be disregarded ("interpreted away") in later infringement proceedings.<sup>12</sup>

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

There is no explicit basis in Dutch (case) law for considering the prosecution history from a corresponding foreign application in post-grant proceedings. It may be assumed that the Dutch courts will only in exceptional circumstances take the prosecution history of a foreign (e.g. US or Japanese) patent into account to determine the scope of a European or national patent. After all, a foreign patent concerns a different right with usually also different claims.

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<sup>10</sup> Court of Appeal 21 February 2008, BIE 2009/86 (MWV Packaging Systems/A&R Carton))

<sup>11</sup> District Court 29 October 2008, IEPT20081029 (AGA/Occlutech).

<sup>12</sup> Supreme Court 13 January 1995, BIE 1995/63 (Dreizler Remeha).

However, where it would concern the skilled person's interpretation of certain features in the claim (as advanced by the patentee himself), the Dutch court may not be adverse to taking into consideration statements from the patentee and/or even the foreign patent office during prosecution of the foreign application. After all, defining the skilled person's interpretation of a patent claim is a more objective process, in respect of which information coming from the prosecution of corresponding foreign application may also provide guidance.

An illustrative example of a broader approach concerns the case *Plumettaz et al vs. British Telecommunications*<sup>13</sup>. In that case, the Dutch courts were called to establish the exact meaning of two particular claim features *lightweight and flexible* and *propelled along the pathway by fluid drag of a gaseous medium*.

Alleged infringer Plumettaz argued that the patent's scope was limited to transmission lines with a certain maximum diameter (*lightweight and flexible*), and that the scope thereof would also not comprise methods that apply a certain pushing force (*propelled along the pathway by fluid drag of a gaseous medium*). BT argued that its patent did not define any limitations in this respect.

The Hague Court of Appeal first of all relied on the description and drawings. Further, it also based its finding on the scope of the claim on *post art* publications by the patentee. Considering that the average skilled person's knowledge would not go beyond the knowledge of the patentee, the Court of Appeal held that also from the patentee's own *post art* publications it followed that the skilled person would interpret BT's patent claim in the more restrictive way. By decision of the Dutch Supreme Court upheld this decision.<sup>14</sup>

This case shows that when it comes to claim interpretation in infringement cases, statements by the patentee outside the framework of the prosecution of the relevant patent may also be of relevance.

More generally, Dutch Courts regularly take into account and address decisions of foreign courts, especially in parallel proceedings on the same European patent or even other equivalent patent rights.<sup>15</sup>

Also, in the above mentioned Supreme Court case *Dijkstra/Saier* the Advocate-General (A-G) commented extensively on the use of the file history, both in the Netherlands and abroad. In his comments, the A-G made no objections for the Netherlands to the use of the file history against the patentee, since the patentee is fully aware of the file history. Although the A-G did not comment on the use of the file history of a corresponding foreign patent, his discussion on the pros and cons appears to suggest that any information that is publicly available may be used, although it may require the preparation of a translation. Correspondence with a patent granting authority may carry weight (4.25-27 of the considerations of the A-G).

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<sup>13</sup> Supreme Court 2 november 2001, NJ 2001, 686 (*Plumettaz et al vs. British Telecommunications*)

<sup>14</sup> Supreme Court 2 November 2001, NJ 2001/686),

<sup>15</sup> For example, in District Court The Hague 24 November 2004, BIE 2007/141 (*Merck vs. Aktiebolaget e.a.; Omeprazol*), the court took into consideration the decisions on validity by the English High Court, Bundes Gerichtshof, the New York Court of Appeal, the Canadian Federal Court, and the Australian High Court.

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

In the Netherlands, the use of prosecution history in the context of claim scope is based on case law.

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

The policy reasons for considering prosecution history are not always explicit.

However, in *Dijkstra/Saier* and *Ciba/Geigy*, the Supreme Court held that the restrictive approach when using the prosecution file to the advantage of the patentee is for reasons of legal certainty for third parties as stipulated in the Protocol on the interpretation of Article 69 EPC.

***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?

The fact that at least some countries will consider the prosecution history will have an impact on the handling of patent applications. This may sometimes be problematic.

Problems are caused by the following main factors:

1. Lack of world-wide harmonization of what constitutes patentable subject-matter.

For example, in the field of inventions making use of or embodied in computer programs, there are substantial differences as to suitable claim type and underlying arguments between the EPO and , e.g., the US. This means that to obtain patent protection in Europe claim formats are arguments may be required that are not completely in line with US practice. This may bring the European practitioner in a squeeze between the statements, arguments, and claim formats that would best serve the need of the European case and the possible impact these may have in other jurisdictions.

2. Lack of worldwide harmonization of validity and infringement criteria

This means that statements or amendments which do not affect claim scope in the Netherlands may impact claim scope in other countries, e.g. the applicability of a doctrine of equivalence.

3. Insufficient data

While the Netherlands/European patent attorney should have a fair grasp of the major aspects of patent procurement and enforcement in some foreign countries, he does not have, and cannot have, a detailed insight into the intricacies of patent law and practice in all countries where counterpart patent applications may have been filed. Despite the best efforts of the attorney it can therefore not be avoided that statements are made which may inadvertently affect the validity or scope of protection of the patent in other countries.

- 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?

Yes. A patent may 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. The Courts make their own independent assessment.

### 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, *inter alia* for the reasons mentioned sub Question 3 in the substantive part.

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

The Dutch group would hope so.

- 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.

The Dutch national group considers that the prosecution history as such should play a very limited role of independent source of information for determining the scope of the claims. The prosecution file may only serve to limit the scope of protection if there is support for a clear and unambiguous intention to limit the scope of the patent, which is inconsistent with the position of the patentee in an infringement debate. Such clear and unambiguous intention should not be readily assumed.

Under normal circumstances, the prosecution history has limited added value other than being a source of information, e.g. on the prior art that was considered.

The Dutch group considers that the patent laws at present provide sufficient safeguards against overly broad or inconsistent claim interpretation during prosecution and during post grant proceedings.

If the patentee argues a broad scope of protection in post grant proceedings, he may risk the invalidity of the patent (e.g. if a Formstein/Gillette defence is run). In addition and/or alternatively, the principle of legal certainty for third parties is already a correction mechanism that should be applied when determining the scope of the claim (see the Protocol on the interpretation of Article 69 EPC). In that context the meaning of the claims as understood by the skilled person should be determined on the basis of the description, and, as much as possible on objective grounds rather than on statements made during prosecution in a different context and at a different time. In most cases, the use of the prosecution history as such does not appear necessary as a source to determine the scope of the claims.

The Dutch group sees no reason to distinguish between the different types of prosecution history. It is the content, substance and context, rather than the time and place of a statement, which should be decisive.