

Congress Seoul 2012  
Adopted Resolution  
October 23, 2012

## Resolution

### Question Q229

#### The use of prosecution history in post-grant patent proceedings

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**AIPPI**

#### Noting that:

- 1) The use of the prosecution history of a patent in post-grant patent proceedings remains an area where divergent practices exist among various countries and regions.
- 2) This subject has been touched upon in prior work of AIPPI, such as in Q142 ("*Breadth of claims, support by disclosure and scope of protection of patents*") and Q175 ("*The role of equivalents and prosecution history in defining the scope of patent protection*").
- 3) In the Rio de Janeiro Congress in 1998, it was resolved in the context of Q142 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 Q175, but the resolution reached at the Executive Committee meeting of Lucerne in 2003, was limited to the use of the prosecution history in the context of equivalents and was as follows:

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

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

- 5) In the context of this present resolution on Q229, "prosecution history" shall mean:
  - a) amendments made to the patent application during the examination process, including amendments to the claims, the description and the drawings; and
  - b) arguments made to the examiner and positions adopted by the applicant during the examination process.

Statements and definitions made in the application as originally filed shall not be considered "prosecution history". The "examination process" shall mean the original examination and any subsequent examination, opposition or re-examination, but excludes court proceedings. For additional clarity, unless otherwise stated, the term "prosecution history" does not include foreign prosecution history.

- 6) In the context of this present resolution on Q229, "post grant proceedings" shall include any proceedings determining the scope of protection of a patent claim, in particular
  - a) proceedings before a patent office, including, for example
    - i) re-examination or reissue;
    - ii) opposition; and
    - iii) invalidity proceedings; and
  - b) proceedings before a court, including, for example:
    - i) infringement, including declarations of non-infringement
    - ii) invalidity and/or
    - iii) support/sufficiency of disclosure.

**Considering that:**

- 1) Almost all legal systems recognize the interest of legal certainty for third parties who may be accused of infringing a patent right.
- 2) Many legal systems contain statutory provisions, case law and/or legal doctrines that seek to prevent a patentee from benefitting from taking inconsistent positions in the prosecution history and in post grant proceedings.
- 3) The question arises as to whether the interest of legal certainty is served by using the prosecution history when interpreting the claims, or, alternatively, whether the wording of the claims should be decisive, as interpreted in the light of the description and the drawings, but without having regard to the prosecution history.
- 4) These questions are addressed differently in different legal systems.
- 5) In the context of the use of prosecution history in post grant proceedings, a balance must be struck between the interests of third parties accused of infringement and those of the patentee, recognizing that a fair protection for the patentee must be ensured.
- 6) In view of the fact that the use of the prosecution history in the context of claim construction is, if indeed possible, addressed differently in different legal systems, often on the basis of different general civil or common law doctrines such as estoppel, forfeiture, abandonment of rights or tort laws, AIPPI expresses the desire to

harmonize certain principles on the use of prosecution history specifically in the context of patent law.

**Resolves that:**

- 1) The prosecution history should be made publicly available as much as possible and in a transparent and easily accessible manner, preferably via internet.
- 2) The primary source for determining the scope of patent protection shall be the words of the claims, in the light of the description and the drawings, as those words would be understood by a person skilled in the relevant art. Statements made during the examination process that purport to limit the scope of a claim should, as much as possible, be added as limitations in the claims or, where appropriate, as disclaimers in the description or drawings, during the examination process.
- 3) Under certain circumstances and taking into account certain restrictions as set forth herein, the prosecution history shall be taken into account in post-grant proceedings provided it is publicly available.
- 4) The prosecution history may be relied upon by any party to a post-grant proceeding. However, the prosecution history shall be taken into account in post-grant proceedings only when and to the extent that it is relied upon by a party thereto.
- 5) The prosecution history cannot serve as support for an interpretation of a claim, broader than justified by the meaning of the claims in the light of the description and the drawings in the patent.
- 6) The prosecution history may be taken into account in post-grant proceedings in order to establish the meaning of ambiguously worded claim features, as they would be understood by the skilled person in the art.
- 7) Where the prosecution history contains a clear and unambiguous statement made (and not withdrawn before the grant of the patent) by or on behalf of the applicant, from which it must be concluded that the applicant disclaims or abandons part of the scope of protection that would otherwise be included, the scope of protection shall be limited accordingly in post-grant proceedings.
- 8) In considering whether a particular amendment or argument from the prosecution history from an earlier stage in the examination process should be taken into account during post-grant proceedings, it shall make no difference:
  - a) whether the particular amendment or argument in question was made during the original examination or during a later stage in the examination process;
  - b) whether the particular amendment or argument related to the claims, to the specification, or to the drawings; or
  - c) in which particular type of proceeding the amendment or argument was made.

- 9) Without prejudice as to its probative value, the prosecution history from an examination process in a first jurisdiction may be taken into account in post-grant proceedings in a second jurisdiction.