

## Question Q229

**National Group:** Sweden

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

**Contributors:** Håkan BORGHÄLL, Lars EKEBERG, Kristian FREDRIKSON, Dag HEDEFÄLT, Louise JONSHAMMAR, Martin LEVINSOHN, Jonas WESTERBERG, Johan ÖRTENBLAD

**Reporter within Working Committee:** Kristian FREDRIKSON

**Date:** 19 April 2012

### Questions

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

The following short formulations are used throughout this document:

Administrative proceedings: proceedings begin at the Patent Office, whose decision always may be appealed to the Court of Patent Appeals, whose decision in turn may be appealed to the Supreme Administrative Court. Leave to appeal is required in the Supreme Administrative Court.

Civil court proceedings: the proceedings begin at the City Court of Stockholm (exclusive in patent cases), whose decision always may be appealed to the Svea Court of Appeal, whose decision in turn may be appealed to the Supreme Court. Leave to appeal is always required in the Supreme Court and most often also in the Court of Appeal.

The answers to this questionnaire regarding current Swedish law and practice needs to be read in the light of certain general principles of law, applicable in both administrative and civil court proceedings:

#### The principle of *ex officio* examination

Governmental authorities (e.g. the Patent Office) as well as administrative courts have the main responsibility of clarifying issues in a case put before the office/court. Hence, it is obligatory for the office/court to raise questions and examine issues of its own motion, and to bring in circumstances known to the authority/court to the examination if necessary for the investigation of the case.

### The principle of public access to official documents

To guarantee an open society, the work of government agencies shall, as far as possible, be accessible to the public. A key principle is therefore the principle of public access to official documents, i.e. the right for every Swedish citizen to have free access to official documents. The general rule is that all official documents are public, and the exception to the rule is that an official document may be secret under certain, legally specified, circumstances to protect particular public or private interests.

### The principle of free presentation and evaluation of evidence

A party to a court trial or administrative procedure may invoke as evidence any relevant information in any form. When trying the case, the court or authority may freely evaluate the relevance, importance and strength of every piece of evidence and thereby how it may influence the outcome of the case.

- 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?

Post-grant proceedings are available both at the Patent Office in the form of opposition proceedings and in the general courts in the form of infringement and invalidity proceedings. The possible grounds for invalidating a patent are the same for both types of proceedings. Patent limitation is available, both for patents granted by the Swedish Patent Office and patents granted by the European Patent Office (which have been validated in Sweden).

### Administrative proceedings

Natural and legal persons other than the applicant may object to the grant of a patent within nine months of the date of grant in opposition proceedings. The Patent Office will then make a re-assessment of its decision, based on the facts and arguments presented by the opponent and the patentee. The proceedings are normally in writing only, although either party can request a hearing. The decision from the Patent Office can be appealed by the losing party to the Court of Patent Appeals and later to the Supreme Administrative Court. Leave to appeal is required for an appeal to the Supreme Administrative Court, which only hears cases which include points of principle of greater importance. The proceedings at the Court of Patent Appeals are mainly in writing, but oral hearings can take place if it is requested by either party or otherwise considered beneficial to the process. There is no right to compensation for litigation costs for the prevailing party and since the process concerns validity only there is no possibility to claim damages for infringement (or otherwise).

Patents can, at any point after grant, be partially limited after an application from the patent owner to the Patent Office. This action cannot, however, be taken if the patent is subject to opposition or invalidity proceedings. In the limitation process no new assessment of the patent's novelty or inventive step is made, and the limitation is made on the basis of what has already been approved. The decision from the Patent Office can be appealed in the same way as an opposition decision, above.

A patent extension in the form of a Supplementary Protection Certificate (SPC) for medicinal products or for plant protection products is available both based on patents granted by the Swedish Patent Office and patents granted by the European Patent Office which have been validated in Sweden.

### Civil court proceedings

It is possible at any time, also after the nine month opposition period, to have a patent declared invalid by a general court, starting at the City Court of Stockholm as the first instance with Svea Court of Appeal and the Supreme Court as appellate courts. Leave to appeal is required for both appellate courts, although the threshold for obtaining leave to appeal is fairly low in the Court of Appeal. Unlike in the administrative process, both

damages for infringement and compensation for legal fees can be ordered by the general courts.

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

Yes. However, in opposition proceedings the issue at stake is the patent's validity (usually its novelty and inventive step) in relation to prior art and not claim scope in relation to an infringing item. In limitation proceedings, the request for limitation must contain a true limitation of the claim scope. Hence, in neither of these cases the patent holder is likely to argue a wider scope of the claim. In SPC applications however, the scope of the claim may well be an issue when the patent holder argues that the product subject to Marketing Authorization is covered by the basic patent. The group's answers to the questions below regarding administrative post-grant proceedings are therefore relevant only to SPC applications.

***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?

Both amendments and arguments may be taken into account during post-grant proceedings.

Regarding amendments during prosecution, there are a number of different situations:

- If an amendment has been introduced in order to render the claim novel over a prior art document, embodiments not claimed anymore would most likely not be considered to be included in the claim scope in post-grant proceedings, regardless of arguments e.g. for equivalence.
- If a narrowing amendment was introduced with the aim of making the claim inventive over cited prior art, the effect on the claim scope in post-grant proceedings depends on the circumstances.
- Regarding an amendment which does neither broaden nor narrow or both broadens and narrows, the protective scope, the effect in post-grant proceedings depends on the specific amendment and the reason for it.
- An amendment allowed by the examiner which broadens the claim scope will probably not have any larger effect in post-grant proceedings. The reason for this is that the broadening must have support in the application as originally filed. It should not be possible to broaden the protective scope beyond that which is originally disclosed by way of argument.

It is important to note that in general, arguments put forward by the applicant can affect the claim scope in post-grant proceedings. Therefore, the effect of a specific amendment in combination with the corresponding arguments depends on the specific circumstances.

- 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?

Either, as no specific restriction applies. It is possible that a certain circumstance, fact or opinion which logically follows as a result of the applicant's arguments during prosecution will be used to shed light upon the extent of the protective scope in post-grant proceedings,

either for the claim feature(s) in relation to which such arguments have been put forward or other (combinations of) feature(s). For example, if the applicant argues that a certain feature is not necessary under certain circumstances and is successful in removing such feature from a claim by arguing that the said circumstances are in fact present when carrying out the invention, the claim may in post-grant proceedings be judged not to cover embodiments where such circumstances are in fact not present.

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

Either, as no specific restriction applies. In general, amendments to the description and drawings will seldom affect the protective scope during post-grant proceedings, since no such amendments may introduce new subject-matter to the application. As a consequence, the protective scope of the claims will not be modified by such amendments, since it is merely to be determined *in light of* the information contained in the description and drawings. Should the protective scope be modified as a consequence of, for example, a proposed clarifying amendment in the description, such amendment will most likely not be allowed by the examiner.

On the other hand, if for example an entire embodiment is removed from the description without modifying the corresponding claim language, the claim may be interpreted not to cover the removed embodiment under certain circumstances.

- 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?

No. The intent of amendments and arguments is only relevant insofar as it can be interpreted as an attempt to limit the scope of protection to make the invention patentable. Other remarks, without this intent, are not considered in post-grant proceedings.

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

#### Administrative proceedings

No. The use of the patent application file in SPC applications would be to assess if the product is covered by the basic patent. The applicant would presumably argue that it is, even if the patent claim does not specifically cover the active ingredient(s). If the applicant can prove that the scope of the patent includes the active ingredient in issue, without actually broadening the claim (i.e. prove that the scope of the patent included the product all along), that argumentation and the use of the patent application file as evidence to support the argument, would be admissible as such.

#### Civil court proceedings

Arguments made during prosecution with the effect of broadening the interpretation cannot have the effect of broadening the scope of protection of the granted patent claims. Only arguments and amendments with an effect of limiting the scope of protection will have an effect in a post-grant proceeding.

- 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?

No. There is no legislation that particularly addresses the question of use of prosecution history in post-grant patent proceedings. The courts will look at the evidentiary value of the evidence presented by the parties, in accordance with the principle of free evaluation of evidence. Generally, only statements made up until grant of the patent are taken into consideration. Any later statement would only have the marginal importance of showing how a skilled person – if the patentee is such a skilled person – interprets the patent at a given time.

However, in the case of infringement proceedings, a patentee would be bound by statements about the claim scope previously made during invalidity proceedings regarding the same patent. This is because an invalidity proceeding is, in practice, a re-examination of the decision to grant the patent, and this review is also relevant to third parties. Limiting statements made by the patentee in a review should reasonably be assessed in the same manner as those statements made during the administrative procedure prior to grant. However, it is important to analyze a seemingly restrictive statement to determine that it actually is a deliberate limitation that holds general significance and not merely a part of a general discussion about different interpretations of the patent.

- 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?

Yes, the applicability of prosecution history depends on the type of post grant proceeding. As indicated in the response preamble under 2 above, the prosecution history is usually used for the assessment of the claim scope. Such an assessment is relevant in infringement proceedings before a civil court and in SPC application proceedings.

However, as the principle of free evaluation of evidence apply to all post grant proceedings, the prosecution history may be, and indeed is, invoked in many types of post grant proceedings.

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

No. Given the principle of free evaluation of evidence in Swedish law, the prosecution history may be considered in all types of proceedings and is indeed invoked by parties in many patent cases.

Although the Swedish case law that exists on the use of prosecution history in post-grant proceedings is very limited, the few cases where prosecution history has been taken into consideration by the courts have been infringement proceedings where equivalents have been at issue. Swedish case law is however also limited with respect to equivalence interpretation, and traditionally courts have been very restrictive in their equivalence interpretations. In the case NJA 2002 s. 660, the Supreme Court stated that it should be allowed to use information from the prosecution file when interpreting uncertainties and obscurities in patent claims and the specification in matters of limitation of the scope of protection. This statement does not appear to limit the applicability of prosecution history to only equivalence issues.

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

Yes. Swedish law does not restrict the sources of evidence that a party may use (the principle of free presentation of evidence) and Swedish courts have the right to freely evaluate the strength of all the evidence presented by the parties (the principle of free

evaluation of evidence). Hence, the parties may invoke as evidence information from the prosecution history of a corresponding foreign application. The importance (if any) attached by the court to information from the prosecution history of corresponding foreign applications will of course vary from case to case. We are not aware of any court case in which information from foreign prosecution history has been specifically addressed by a Swedish court. But we assume that a Swedish court would attach less importance to information from the prosecution history of a corresponding foreign application than to information from the prosecution history of the Swedish or European patent-in-suit before the Swedish court.

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

#### Administrative proceedings

The Swedish statutes do not address use of prosecution history. The Swedish AIPPI-group is unaware of any case law in administrative post-grant proceedings addressing the use of prosecution history. However, general procedural law applies, whereas there are no restrictions regarding what evidence may be put forward to the authority or court (see also d) and e) above and g) below).

#### Civil court proceedings

There is no explicit authorization in statutory law. However, the Swedish Code of Judicial Procedure lays down the principles that a party may freely invoke any evidence the party deems to be relevant (the principle of free presentation of evidence) and that Swedish courts may freely evaluate the strength of all evidence presented by the parties (the principle of free examination of evidence).

The Swedish Patents Act stipulates that “[t]he scope of the patent protection is determined by the patent claims. The description may inform the interpretation of the patent claims.” In Sweden, the preparatory works constitute a source of law that may be used for the interpretation of statutory law. A proposal from the Nordic Patent Committee formed the basis for the preparatory works that led to the Patents Act. In this proposal, the Nordic Patent Committee stated that “the prosecution documents ... may be of relevance” in interpreting unclear claims. The Committee also stated that if the applicant in e.g. correspondence with the Patent Authority “has interpreted expressions used in the claims in a restrictive manner, it is reasonable that this restrictive interpretation forms the basis for subsequent court proceedings”. These statements were quoted in the governmental bill leading up to the Patents Act, but the government did not explicitly address the question. Moreover, in its review of the governmental bill, the legislative council stated that the subsequently adopted wording of the relevant provision in the Patents Act should not be interpreted so as to exclude other sources of interpretation than the description. The legislative council explicitly referred to the Nordic Patent Committee’s statement regarding restricting interpretations submitted by the applicant during the prosecution stage.

The use of prosecution history was addressed by the Swedish Supreme Court in a decision in 2002 concerning a request for an interim injunction (NJA 2002 p. 660). Even if the Court did not find it necessary to consult the prosecution history to decide the case, the Court included the following *obiter dictum* in its reasons: “it should be permissible to use documents from the prosecution stage in order to interpret unclear parts of the patent claims and the description as far as a limitation of the scope of protection is concerned”. In other infringement cases, decided before as well as after the Supreme Court’s decision and concerning Swedish as well as European patents, the first instance and the appeals instance have referred to statements made by the applicant during prosecution when interpreting patent claims in a restrictive manner. However, none of these cases are binding precedents.

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



Neither the preparatory works to the Patents Act nor the case-law mentioned in the answer to question 2 e) above set out any explicit policy reasons.

The underlying reason for the principles of free presentation and evaluation of evidence – as set out in the Swedish Code of Judicial Procedure – is the interest of obtaining judgments and decisions that are materially correct. As stated by the legislative council in its review of the governmental bill leading up to the Code of Judicial Procedure: “there are no restrictions as concerns the nature of the material or the sources of information that may be used in the search for the truth”.

It is apparent from the Supreme Court’s obiter dictum in NJA 2002 p. 660 (the case-law cited in the answer to question 2 e) above) and the preparatory works to the Patents Act that the prosecution history may be used primarily to restrict the scope of protection and to prevent an extension of the scope of protection through the doctrine of equivalence. Even if the patent holder is free to invoke statements made during the prosecution history to support an extensive interpretation of the patent claims, it is highly unlikely that a Swedish court would attach any importance to such evidence. Most commentators in the Swedish legal doctrine agree that the interest of obtaining materially correct decisions and judgments must be balanced against the interest of legal certainty, and that the third party interest of legal certainty means that the prosecution history may be used to restrict, but not to extend, the scope of protection.

***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?

N/A

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

N/A

- 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?

Implications are limited. It would probably not influence any action by the Swedish Patent Office with regard to the patent application procedure, and it would certainly not change how the patent application file is made available to the public.

It is already a fact that other jurisdictions consider foreign prosecution history as part of claim scope interpretation. It is also a fact that this has implications on actions during prosecution in Sweden. A patent attorney in Sweden bears in mind that every statement made during prosecution, in any country, may have implications during a potential discovery in the US. There is, however, a client-attorney privilege that implies that advice given by a European Patent Attorney to a client shall remain secret and hence not be taken into account in such discovery. A corresponding privilege exists between an Authorized Swedish Patent Attorney and his client.

Hence, to the extent other countries consider foreign prosecution history, an Authorized Swedish Patent Attorney or European Patent Attorney acting in Sweden would be prepared

for this. It may however be problematic if contrary or even contradictory laws or case law are applied in different countries, since this would compromise the predictability of actions during prosecution.

- 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, the patent may be invalidated on the basis of the same prior art and the same argument used by the examiner.

The civil courts and instances of appeal are not legally bound by the findings of the Patent Office in respect of novelty or inventive step in relation to a specific piece of prior art. However, a granted patent comes with a presumption of validity, and courts are generally inclined to follow the assessment of the patent granting authorities unless there are special reasons for a different conclusion. Hence, if no new prior art is presented a court would normally conclude that the patent is valid as granted.

### **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. Harmonization of the use of prosecution history in post grant proceedings is necessary to achieve harmonization of claim scope interpretation. Harmonization is also desirable as it increases foreseeability for third parties.

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

Both use and non-use of prosecution history can be well motivated, and each standpoint may be based on principles of free presentation of evidence, foreseeability and patentability, which are – at least to some extent – in conflict.

Even though it would presumably be very difficult to find a universally acceptable standard for the use of prosecution history in post grant proceedings, it is the view of the Swedish group that a compromise may be possible.

- 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 order for a compromise situation to be an actual compromise, a harmonized standard should include use of prosecution history to some extent. The Swedish group considers it



possible to obtain acceptance for a standard where prosecution history should be applicable in all proceedings where it can be considered relevant. Such a standard should further allow the presentation of the prosecution history insofar as it is publicly available, and leave it to the courts and authorities to assess the importance of it as evidence in the individual case.

It may be noted that the Swedish group believes that a standard including the use of prosecution history would not in violation of the additional protocol to Article 69 (Extent of Protection) of the European Patent Convention in its current form.

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

---

### **Summary**

The use in Sweden of prosecution history in post-grant patent proceedings is permitted according to case law in both administrative proceedings and civil court proceedings. Use is permitted to the extent that it is relevant for the proceeding, primarily for the interpretation of claim scope. No particular limitations apply other than the general limitations for evidence according to procedural law. Harmonized rules are desirable; a starting point for the necessary compromise would be to allow use of prosecution history in post-grant patent proceedings at least to some limited extent.

### **Zusammenfassung**

Die Verwendung der Erteilungsakten in Patentverfahren nach der Erteilung in Schweden ist gemäß der Rechtsprechung sowohl in Verwaltungsverfahren als auch in Zivilprozessverfahren zugelassen. Die Verwendung ist in dem Umfang zugelassen wie sie für das Verfahren relevant ist, in erster Hand für die Auslegung von Schutzbereich. Keine besonderen Beschränkungen neben den allgemeinen Beschränkungen in Bezug auf Beweismittel gemäß dem Verfahrensrecht liegen vor. Harmonisierte Regeln sind wünschenswert; ein Ausgangspunkt für den notwendigen Kompromiss wäre die Zulassung der Verwendung der Erteilungsakten in Patentverfahren nach der Erteilung wenigstens in beschränktem Umfang.

### **Résumé**

L'utilisation en Suède de la procédure de délivrance dans les procédures après délivrance est autorisée conformément à la jurisprudence dans les deux procédures administratives et les procédures judiciaires civiles. L'utilisation est permise dans la mesure où elle est pertinente pour la procédure, surtout pour l'interprétation de la portée de la revendication. Pas de restrictions particulières s'appliquent à l'exclusion des limitations générales de la preuve conformément à la loi de procédure. Des règles harmonisées sont souhaitable; un point de départ pour le compromis nécessaire serait de permettre l'utilisation de délivrance dans les procédures après délivrance d'au moins dans une certaine mesure limitée.