

Question Q229

National Group: Poland

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

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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?

Polish law makes available:

- a. opposition proceedings
- b. invalidity proceedings

These are essentially identical, the only difference being that petitioner for invalidity proceedings needs to demonstrate legal interest in his request, whereas opposition is an *actio popularis* and can be launched by any, even not factually interested party.

These proceedings may be based on any bases on which the patent application could have been refused. Partial invalidation may also be requested.

- c. voluntary partial surrender of a patent

A patentee may request surrender of the patent. It appears that this could also concern part of the patent and thereby result in voluntary limitation of protection.

- d. Amendments

Obvious mistakes in the patent may be amended at the request of the patentee.

All of the above a.-d. are conducted before the Patent Office. Appeal is available to Administrative Court in Warsaw, which acting as a judicial review body can verify legal correctness of PPO's decisions. A further appeal to Supreme Administrative Court is available.

- e. infringement/declaratory non-infringement declaratory actions

Infringement proceedings (and NID actions) are conducted by district courts. No validity arguments are considered in general. The decision of the Patent Office is usually perceived as valid until successfully challenged.

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

No case law on the issue is available. In general, it seems that taking prosecution history into account is unlikely. The law (art. 63 sec. 2 Industrial Property Law) stipulate that scope of a patent is to be determined by claims and specification and drawings may be used to interpret the claims.

Declarations made in prosecution may play a role based on various provisions:

- as part of evidence to consider what a skilled person understands from claims (art. 33 of IPL within the general procedural rule of freedom for the court to consider any evidence in reviewing a civil matter);
- as giving rise to a claim of abuse of rights (art. 5 Polish civil code).

It seems that these bases are likely to be an acceptance rather than the rule and due to a careful separation of validity and infringement in Polish law effect of prosecution on claim construction is not likely to be important.

Despite the fact that currently there is no case-law which could be an example of the influence of the patentee's statements included in the examination files on the judicial interpretation of the scope of protection resulting from the patent, we can assume that in a situation when the charge on infringement is based on the interpretation of the claims broader than the literal one, the contrary patentee's statements relating to the prior art and limiting the scope of the invention included in the examination files shall be considered by the court as an important evidence in a case on infringement or non-infringement declaratory action. Such an issue is argued to an extent successfully in some of the judicial proceedings being nowadays conducted in Poland.

In light of the recent case-law it seems that only in proceedings on patent invalidation the contents of the files pertaining to the examination proceedings may play some role. In particular, in light of the precedent decision issued by the Administrative Court in April, the history of the examination proceedings shall be considered by the panel of PPO during the invalidation proceedings in a situation when a charge on an inadmissible change of the subject matter of the invention after the date of filing is raised and connected with the aforementioned charge on incorrect assessment of the inventive step as made by the PPO.

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? 5
- 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?

The bases would mainly be statute. No case-law is available, but that which is indicates a strong separation of validity and infringement, which points to disallowance of prosecution history estoppel.

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

Legal certainty. Stability of final administrative decisions.

- 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?

Very much so. Handling prosecution in a country where prosecution history estoppel is an important consideration seems considerably more risky and requiring more far more preparation to preserve client's rights.

- 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. Case-law clearly states that justification burden is much heavier in this case due to general principles of administrative procedure, but the possibility is very much available and sometimes used.

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.

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

Not immediately, but worth striving for.

- 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.

Prosecution history estoppel should be limited to instances giving rise to a claim for abuse of right or other cases in which the specifics of the case suggest it would be clearly against equity to grant protection. We do not think there should be a general rule on prosecution history estoppel, but merely a possibility to invoke it in clear case in which the patentee abuses the basic equitable principles in trying to over-broadly enforce the patent in view of his earlier actions in prosecution.