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EUROPE

PROSECUTION HISTORY ESTOPPEL



UNITED KINGDOM



Case No: A3/2000/2833 CHPCF

Neutral Citation Number [2001] EWCA Civ 1589
IN THE SUPREME COURT OF JUDICATURE
COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION (PATENTS COURT)
(NEUBERGER J)

Royal Courts of Justice
Strand,
London, WC2A 2LL
Monday 29 October 2001

Before:

LORD JUSTICE PETER GEBSON
LORD JUSTICE ROBERT WALKER
and
LORD JUSTICE KEENE

(1) ROHM AND HAAS CO
(2) DOW AGROSCIENCES LLC
-and-
(1) COLLAG LTD (in receivership)

Appellants

Respondents

(2) AGFORM LTD

(Transcript of the Handed Down Judgment of
Smith Bernal Reporting Limited, 190 Fleet Street
London EC4A 2AG
Tel No: 020 7421 4040, Fax No: 02078318838
Official Shorthand Writers to the Court)

Mr H Carr QC and Dr P Acland
(instructed by McDermott, Will & Emery for the appellants)
Mr C Floyd QC and Mr J St Ville (instructed by Bristows for the second
respondent)

Judgment
As Approved by the Court
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40. There seems to be no clear English authority on the point, even at first instance. In *Bristol-Myers Squibb Co v Baker Norton Inc* [1999] RFC253, 274-5 Jacob J has given a useful summary of the problems associated with taking account of what he called prosecution history - that is, the vicissitudes of an application file's progress through the official system - as an aid to construction of the final specification. But Jacob J said that he did not have to decide anything about the point.
41. This court was shown a decision of the Supreme Court of the Netherlands, *Ciba-Geigy v Oté Optics* (13 January 1995) which contains a helpful statement of principle. In explaining that the Court of Appeal had gone too far in excluding all reference to the file, the Supreme Court said:
- "Article 69, paragraph 1 of the EPC as interpreted in accordance with the protocol relating thereto does indeed purport (among other things) to ensure reasonable certainty for third parties, but it does not follow that the information from the granting file that is available to third parties may never be used in support of the interpretation given by the patentee to his patent. The requirement of reasonable certainty for third parties does, however, call for restraint in using arguments derived from the granting file in favour of the patentee. Consequently, a court will only be justified in using clarifying information from the public part of the granting file, when it holds that even after the average person skilled in the art has considered the description and the drawings, it is still open to question how the contents of the claims must be interpreted. In this connection one must also take into consideration that the risk of any ambiguities due to careless wording of the patent specification must in principle lie with the patentee."
42. Apart from the last sentence (which raises a different point, and on which Mr Floyd did not rely) I would treat this as persuasive guidance. The letter to the European Patent Office did not have



the same status as published prior art identified in a specification, which is readily admissible. But it did contain objective information about and commentary on experiments which were conducted in response to official observations, and it could be of assistance in resolving some puzzling features of the specification. Although the prosecution process may sometimes superficially resemble a process of negotiation between the applicant and its advisers and the officials who scrutinise the file, it is not the sort of commercial negotiation which is still rigidly excluded in the construction of a written contract (see *Investors Compensation Scheme v West Bromwich Building Society* [1998] 1 WLR 896, 913). Had it been necessary for the judge to take account of the letter in order to resolve the issue of construction, I consider that he would have been entitled to do so.



IN THE HIGH COURT OF JUSTICE

CHANCERY DIVISION

PATENTS COURT

Royal Courts of Justice

Strand, London, WC2A 2LL

Date: 11th April 2001

B e f o r e:

THE HONOURABLE MR JUSTICE

CH 1993 -K-No. 937

CH 1993-B-N0.4552

In the matter of European Patents (UK) Nos. 148,605 and 411,678 and in the matter of actions for infringement and counterclaims for revocation thereof by inter alia Kirin-Amgen Incorporated, Janssen-Cilag Limited and Roche Diagnostics GmbH

HC 1999 No.02916

HC 1999 No.02917

HC 1999 No. 03241

In the matter of European Patents (UK) Nos. 148,605 and in the matter of a claim for revocation and for a declaration of non-infringement thereof by inter alia Transkaryotic Therapies Inc. and an action for infringement by inter alia Kirin-Amgen Inc.



(instructed by Messrs. Taylor Joynson Garrett) appeared on behalf of the Amgen parties.

(instructed by Messrs. Herbert Smith) appeared on behalf of the Roche Parties.

(instructed by Messrs. Bird & Bird) appeared on behalf of the TKT parties.

JUDGMENT

(As approved by the Court)

This is an approved judgment of the Court and I direct that no further note or transcript be made.

The Honourable Mr. Justice Neuberger

MR. JUSTICE NEUBERGER:

A. INTRODUCTORY

205. Roche sought to support their case by reference to the apparent finding of the Board that human cDNA was not enabled by the patent, and that, as a result, Claim 3 of 605A had to be amended to the form as it presently appears in 605. At least on the basis of the arguments I have heard, my view is that, as the law in this country currently stands, when construing a patent, it is not legitimate to have regard to the arguments raised by or before the Board in opposition proceedings relating to the grant or amendment of the patent in question, even though those observations may have led to the patent being amended.

206. First, I do not think that Roche's argument would have been easily reconcilable with Section 125 of the 1977 Act. Secondly, Roche's approach to construction would lead to inconvenience and expense. If, when construing a patent, one could take into account what was said on behalf of the patentee at any opposition proceedings, then, it seems to me, one always would have to take into account what was said at opposition proceedings. It cannot be a matter of choice. Accordingly, no patent agent or lawyer could sensibly advise an interested third party as to the meaning and effect of a European patent without



studying a transcript of the opposition proceedings (if any). Thirdly, I consider that Roche's argument would be inconsistent with the recent rejection of the proposal to amend Article 69 of the EPC to incorporate something along the lines of what is known in the United States as file wrapper estoppel.

207. Fourthly, it appears that authority supports my conclusion. In *Glaverbel* [1995] RPC 255, the precise point was not at issue, but at 270 to 271, Staughton LJ rejected an attempt to rely upon other documents containing statements by the patentee relating to the alleged invention, although he accepted that, if the facts warranted it, statements made by the patentee could give rise to an estoppel. Of more direct relevance is *Palmaz's European Patents (UK)* [1999] RPC 47 at 73 where Pumfrey J referred to the submission that a particular construction of the patent was "consistent with the representations made by... the patent attorneys acting for the patentees to the European Patent Office...", and said that "this is not a legitimate approach to construction".
208. It is true that the point was left open by Jacob J in *Bristol Myers Squibb Limited -v- Baker Norton Limited* [1999] RPC 253 at 274, and it appears that the Netherlands Supreme Court and the Stockholm City Court may well take a different view (see *Ciba Geigy AG -v- Oté Optics BV* (13th January 1985), NJ 1995 391 and *Spanak Aktiebolag -v- Allround-Smide Aktiebolag* (6th May 1997 respectively). However, as Mr Waugh points out, the Hague District Court in their decision dated 13th March 1993 (upheld by the Netherlands Appeal Court on 27th January 2000) when considering the validity and meaning of the 605 patent itself, was apparently unimpressed by this argument.
209. Indeed, the Dutch decision in the present case seems to me to highlight another reason why one should, at the very least, be wary of relying on what was said in objection proceedings before the Board. Although any decision of the Board on an issue which this court has to decide are worthy of respect and consideration, it is most certainly not binding on this court, as the Dutch courts emphasised in their decisions on the 605 patent. In the Netherlands, both the court at first instance and Appeal Court concluded, contrary to the opinion of the Board, that human cDNA was within the scope of Claim 1 of 605 m



its present form. Quite apart from this, I am not convinced of the factual basis for the contention advanced by Roche, even if the legal basis existed. However, as the point is not pursued, it would be inappropriate to delve into that aspect.



GERMANY



Decision of the Federal Supreme Court (Bundesgerichtshof)
April 20, 1993 - Case No X ZR 6/91

Should the court of appeals come to the conclusion that the plaintiff's statement also refers to moistening devices such as the one used by the defendant, it will have to decide on the disputed matter of law in how far waivers by an applicant during the application proceedings bear relevancy for the interpretation of the scope of a patent registered after January 1, 1978 (*see Benkard*, "Patentgesetz. Gebrauchsmustergesetz," Art. 14, point 80 (8th ed.) with further references, on the one hand, and on the other hand, *Schulte*, "Patentgesetz," Art. 14, point 13 (4th ed.); and *Ballhaus*, 1986 GRUR 337, 342). Even if such declarations are not generally binding, such explanations and their interpretation in the decision to grant a patent may be essential circumstantial evidence on how the patented to ching is understood by the relevant persons skilled in the art. However, it may run counter to the principles of trust and good faith, especially in view of a *venire contra factum proprium* (contradictory behaviour), if the scope of patent protection now claimed has been the subject of a waiver; this may especially be the case if the waiver was essential for the patent being granted and was declared in proceedings involving the party who is no subject to an infringement suit.



FRANCE



Cour d'appel de Paris
(4ème ch., section B),
24 avril 1998.

Société Estée Lauder SNC, Société de Gestion du
Groupe Estée Lauder Sogel SNC et Société Estée
Lauder N.V. c/ Société L'Oréal SA
M. Boval, Président.
Mes Combeau et Véron, Avocats.

- Sur la recevabilité

Considérant que L'Oréal réitère devant la Cour son argumentation, repoussée par les premiers juges, tendant à voir déclarer irrecevable la demande en nullité de son brevet européen désignant la France formée par les sociétés Estée Lauder, dans la mesure où cette demande serait en totale contradiction avec l'attitude qu'elles ont adoptée dans les procédures américaines et européennes au cours desquelles elles se sont efforcées d'obtenir la propriété du même brevet ;

Considérant que le tribunal a rejeté cette exception en relevant que, devant l'OEB, la SNC Estée Lauder avait renoncé en 1992 à sa demande de brevet européen et ensuite invoqué, à l'appui de son opposition contre le brevet de L'Oréal, les antériorités par ailleurs mises en avant dans la procédure française, et que dans la procédure d'interférence aux Etats-Unis, qui en toute hypothèse ne liait pas le juge français, Estée Lauder Inc avait aussi invoqué ces antériorités qui n'avaient été écartées que pour des raisons de procédure, leur production ayant été jugée tardive;

Considérant que les premiers juges doivent en effet être approuvés d'avoir rejeté l'exception soulevée par L'Oréal; que les péripéties de la procédure américaine ayant un objet différent de celui de la présente instance ne sauraient donner appui dans le cadre de celle-ci à une fin de non recevoir; qu'il est constant par ailleurs que les antériorités invoquées devant le juge français l'avaient été aussi (quoique vainement pour des raisons de procédure) devant les instances compétentes américaines par les sociétés Estée Lauder;



ITALY



TRIBUNALE DI MILANO - 20 marzo 1975 –
PFIZER c. CO. FARMACEUTIC MILANESE s.r.l.

Nulla vieta di integrare la descrizione del brevetto italiano con le dichiarazioni, provenienti pur sempre dal medesimo titolare del brevetto italiano, con le quali egli ha ottenuto la brevettazione del medesimo trovato all'estero: tali dichiarazioni infatti costituiscono a tutti gli effetti delle vere e proprie confessioni stragiudiziali fatte ad un terzo, in quanto rappresentano delle vere e proprie dichiarazioni di scienza consapevoli e volontarie concernenti fatti oggettivamente contrastanti con l'interesse del dichiarante.



TRIBUNALE DI TORINO — 14 luglio 1997 (ord.) — Pres.
Est. MAZZITELLI — L.I.C.A. di Rosso & C. s.n.c. (avv. Saglietti)
c. SIMOS s.r.l. (avv.ti Costa, Rosso) e c. V.I.P. s.r.l. (avv. Scalisi).

Tale assunto, del tutto in linea con la premessa generate sopra menzionata e condiviso dal Tribunale per le ragioni già esposte, non è eliso dal riscontro, posto in evidenza dalla difesa della parte reclamante nel corso della discussione finale, dell'estensione dell'invenzione in sede di rilascio del brevetto USA ed europeo a trattamenti abrasivi non implicanti particolari distinzioni.

Trattasi per l'appunto di mere rivendicazioni accettate dagli esaminatori stranieri che, pur costituendo un indizio, non implicano di per sé sole il capovolgimento dell'individuazione del settore di appartenenza del brevetto italiano o per meglio dire, così come sostenuto dalla difesa della SIMOS, un ampliamento del medesimo tale da dare origine ad una «combinazione» tra più settori.



THE NETHERLANDS



**Ciba-Geigy AG v Oté Optics BV
et al**

Supreme Court of the Netherlands

Snijders (Vice-President), Roelvink, Mijnsen,
Heemskerk and Nieuwenhuis JJ

13 January 1995

The complaint is well-founded in so far as generally speaking the opinion of the Court of Appeal is too drastic. Article 69, paragraph 1 of the EPC as interpreted in accordance with the protocol relating thereto does indeed purport (among other things) to ensure reasonable certainty for third parties, but it does not follow that the information from the granting file that is available to third parties may never be used in support of the interpretation given by the patentee to his patent. The requirement of reasonable certainty for third parties does, however, call for restraint in using arguments derived from the granting file in favour of the patentee. Consequently, a court will only be justified in using clarifying information from the public part of the granting file, when it holds that even after the average person skilled in the art has considered the description and the drawings, it is still open to question how the contents of the claims must be interpreted. In this connection one must also take into consideration that the risk of any ambiguities due to careless wording of the patent specification must in principle lie with the patentee.



NautaDutilh

IP NEWSLETTER

Amsterdam, April 2002

PATENTS SPECIAL

NO FESTO IN THE NETHERLANDS

The Supreme Court of the Netherlands by decision of 29 March 2002 firmly held that it is no defence against an allegation of infringement by equivalence to state that the patentee could have known of obvious variants such as the accused embodiment, and therefore should have expressly claimed them during prosecution.

In the case at bar (*Van Bentum/Kool*) the patentee claimed a "double deck" pallet transport truck with a movable bottom loading floor and a fixed upper loading floor. The purpose of this arrangement was to create extra loading space by creating an extension in the vertical direction of the space necessary for the loading and unloading of pallets. The defendant marketed a variant truck which incorporated a so-called "*kinematic inversion*" of the claimed means: the truck had a fixed bottom loading floor and a moveable upper loading floor.

Claiming infringement by equivalence, the patentee sought relief from the District Court of The Hague, but was rebuffed on the ground that the defendant practised an obvious improvement to the prior art.

On appeal the outcome was the same, but the grounds were different. The Court of Appeal of The Hague held that the applicant when drafting his claims should have realised that the object of the invention could also be reached by the above kinematic inversion. Thereupon the Court of Appeal spoke the words which to the international patent practitioner now have a familiar ring, namely that of the US Federal Circuit *Festo* decision of 29 November 2000. The words of the Dutch appeal court, which in fact preceded the *Festo* appeal decision by eight months, were:



"He who, as in the case at hand, could have easily drafted a claim which would have covered the defendant's variant, and omits to do so, shall not in fairness be accorded protection for this at the time of drafting of the claim know able, obvious equivalent embodiment. The doctrine of equivalence — which is framed by the balance between a fair protection for the patentee and a reasonable degree of certainty for third parties - cannot be applied as a remedy against negligent draftsmanship. The interest of legal certainty would otherwise be accorded insufficient justice. "

The appeal decision in *Van Bentum/Kool* stood for almost exactly two years. And indeed the District Court of The Hague in several decisions followed suit, denying relief even when it found infringement by equivalence, in cases where it could be argued that the applicant should have foreseen and therefore should have explicitly claimed the accused variant.

In last month's landmark decision the Supreme Court reversed the Court of Appeal. The Supreme Court *inter alia* used the following words:

" (...) that even if ... it is assumed that the claim in that sense is negligently drafted ..., when interpreting a claim the middle must be sought between a fair protection of the patentee and a reasonable certainty for third parties. A rule of interpretation as applied by the Court of Appeal cannot be reconciled therewith."

In the same decision the Supreme Court reiterated its 1989 holding on relinquishment, the Dutch equivalent of what internationally is known as file wrapper estoppel. In short, the law of the land still is that the skilled man may only then assume that a part of the protection the patent should provide was relinquished when, based on the public history of the patent, there is good ground to do so.

Conclusion: The Dutch Courts will no longer be able to infer that certain equivalent embodiments must be assumed to have been abandoned. Abandonment may *only* be assumed when there is *good ground* to do so. Such good ground could exist when it is clear from the prosecution history that the applicant had reasons having to do with validity when the alleged surrender of protection took place. No more automatic estoppel based on arguable poor draftsmanship, therefore.



If you require further information, including an English translation of the decision, please contact Richard Ebbink, Charles Gielen, Ruprecht Hermans, Gregor Vos, Chantal Morel or the NautaDutilh IP lawyer with whom you normally deal. E-mail: firstname.lastname@nautadutilh.com