

## Q229

### 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?**

#### (Answer)

The types of post-grant proceedings include: an invalidation trial where a request for patent invalidation is examined (before the Patent Office); a suit for cancellation of invalidation trial decision (before the Intellectual Property High Court, and appealable to the Supreme Court); and a patent infringement suit where a charge against patent infringement is examined (1st instance before a district court, 2nd instance before the Intellectual Property High Court, and 3rd instance before the Supreme Court).

The types of post-grant proceedings also include a correction trial where a request for correction to a patent is examined (before the Patent Office) and a suit

for cancellation of correction trial decision (before the Intellectual Property High Court, and appealable to the Supreme Court).

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

#### (Answer)

If “taken into account” merely means “consulted for the purpose of reference” or something like that, we will answer “Yes” on all cases of the above-mentioned post-grant proceedings. In Japan, there exists no school of thought that the prosecution history should not be taken into account even when merely used as reference information.

In relation to patent infringement suits in Japan, there is an established practice of interpreting the scope of claims limitedly (narrowly) based on the patentee’s arguments in the prosecution history. However, this practice is not applied in the other types of post-grant proceedings.

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***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?**

**(Answer)**

Both. Under the previous Act, the applicant's arguments made during opposition proceedings were also taken into account (*Osaka District Court, Heisei 6 (wa) No. 2090*).

Moreover, arguments made during post-grant proceedings have an influence on other post-grant proceedings (*Tokyo District Court decision, 27 September 2000, Hanrei Times No. 1042 page 260; Tokyo District Court decision, 30 March 2001, Hanrei Jiho No. 1753 page 128; Tokyo District Court decision, 10 February 2005, Hanrei Jiho No. 1906 page 144*).

**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?**

**(Answer)**

There exists no concept of distinction between *explicit* and *implied*. Therefore, both are included.

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

**(Answer)**

Even if an amendment is made only to the specification without amending the claims, the amendment may have an influence on interpretation of the scope of claims ("*Pen Ink Tube*" case, *Osaka District Court decision, 25 March 2001, Hanrei Times No. 1098 page 208*). Therefore, not only amendments to the claims, but also amendments to the disclosure (specification and drawings) are included.

**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?**

**(Answer)**

Yes. As described above, in relation to patent infringement suits in Japan, there is an established practice of interpreting the scope of claims limitedly (narrowly) based on the patentee's arguments in the prosecution history. A decision to make a limited (narrower) interpretation generally depends on whether such arguments were made to overcome prior art.

However, at the phase of determining the applicability of the doctrine of equivalents, if an amendment was made to formally restrict the claims, the doctrine will not be applied to the restricted constituent features regardless of the reason for amendment, according to a court precedent (*Intellectual Property High Court decision, Heisei 21 (ne) No. 10033*).

In relation to the applicability of the doctrine of equivalents, the Supreme Court holds, "if the patentee admitted that a component is not included in the technical scope of the patented invention, e.g., he/she intentionally excluded said com-

ponent from the scope of claim during the patent application process (or he/she appears to have done so), he/she is not allowed later to make an argument contradictory to this in the context of the doctrine of estoppel” (*Supreme Court decision, 24 February 1998, Minshu vol. 521 No. 1 page 113*). This decision does no touch on the issue of whether such arguments are made to overcome prior art.

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

**(Answer)**

The prosecution history does not have the effect of broadening the scope of the claims.

However, if an argument in the prosecution history may be used for a narrower interpretation of the claims and the patentee withdraws or modifies the argument in a later process of the prosecution, it is highly likely that this withdrawal or modification will be determined to be valid. That is, through this withdrawal or modification, it is highly likely that the patentee may prevent the argument from being used for a narrower interpretation of the claims.

For example, a court decision (*Heisei 23 (ne) No. 10002*) states that if the applicant withdrew an amendment that was not entered by the examiner (or he/she abandoned this amendment and made a different amendment), this withdrawn amendment (and arguments related thereto) should not be used as a reason for a narrower interpretation of the claims.

**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?**

**(Answer)**

No. As described above, arguments made during post-grant proceedings have an influence on other post-grant proceedings (*Tokyo District Court decision, 27 September 2000, Hanrei Times No. 1042 page 260; Tokyo District Court decision, 30 March 2001, Hanrei Jiho No. 1753 page 128; Tokyo District Court decision, 10 February 2005, Hanrei Jiho No. 1906 page 144*).

**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?**

**(Answer)**

If “application of the prosecution history” merely means “consultation for the purpose of reference” or something like that, its applicability will not depend on the type of post-grant proceeding, or on the authority before which the proceeding is held.

On the other hand, as described above, in relation to patent infringement suits (before the court) in Japan, there is an established practice of interpreting the scope of claims limitedly (narrowly) based on the patentee’s arguments in the

prosecution history (although this practice is not applied in the other types of post-grant proceedings, e.g. invalidity trial proceedings).

In the other types of post-grant proceedings (than the patent infringement suits), the wording of the claims is interpreted literally as in the pre-grant process of prosecution, in accordance with the Supreme Court decision on the Lipase case (its summary is shown below). Only the specification and drawings are taken into account if there are special circumstances and therefore, it is extremely rare that the prosecution history can have an influence on the claim interpretation.

“This determination of the gist (of the invention) should, in the absence of special circumstances, be made on the basis of what is described in the claims attached to the patent application. Only in cases such as when the technical meaning of the description of the claims cannot be understood clearly and unambiguously, or where, in the light of the description in the detailed explanation (specification) of the invention, there is an obvious error in the description of the claims, can the description in the detailed explanation be taken into account.” (*“Lipase” case, Supreme Court decision, 8 March 1991, Minshu vol. 45 No. 3 page 123*)

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

**(Answer)**

No.

**e) Could prosecution history from a corresponding foreign application be considered in a post-grant pro-**

**ceeding in your jurisdiction? If so, under what circumstances?**

**(Answer)**

Many years ago, there was a case where prosecution history from a corresponding foreign application was considered in post-grant proceedings (*Osaka District Court decision, 11 March 1977, Hanrei Jiho No. 869 page 79*). These days, however, we find few precedents or theories related to this issue. We cannot say that there is an established doctrine.

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

**(Answer)**

Not authorized by statute, i.e. the Patent Act or other related laws do not provide that the prosecution history may be taken into account for the purpose of claim interpretation.

The use of prosecution history is authorized by case law, i.e. there are many decisions by the district and high courts where the prosecution history was taken into account for the purpose of interpreting the scope of claims.

An example of such decisions is, “when interpreting an invention, it is a matter of course to consider amendments and other representations made during the process for its registration. The appellant said in an amendment that the aperture in this invention has a “slit-like” shape, not a “grid-like” shape. As a natural result, a “grid-like aperture” does not correspond to the “slit-like aperture” (the principle of file wrapper estoppel).” (*Tokyo High Court decision, 26 December 2002 (Heisei 14 (ne) No. 5092)*)

A decision by the Tokyo District

Court (on 28 November 1997) holds that a written argument may be used for an interpretation of the claims.

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

**(Answer)**

The prosecution history is considered as “reference information” in all types of the post-grant proceedings. The policy reasons for this are thought to be the following:

- (a) The prosecution history contains expression of the parties’ intentions (intentions or views expressed by the applicant and the Patent Office) that may serve as reference information for interpretation of the claims. (This approach is similar to a process of determining an intention (an intention to bring about a legal effect) from a manifested act in relation to a juristic act).
- (b) For interpretation of the claims, the practice of “considering the state of the art at the time of application” is widely accepted. The prosecution history may serve a similar purpose.
- (c) For interpretation of a statute, its legislative process is taken into account. For interpretation of patent claims, considering the process of how the rights were formed (prosecution history) may serve a similar purpose.

In relation to patent infringement suits in Japan, there is a practice of interpreting the scope of claims limitedly (narrowly) based on the patentee’s argu-

ments in the prosecution history. The policy reasons for this practice are thought to be the following:

This practice is based on the “principle of faith and trust” or the doctrine of estoppel, a dominant concept under the civil legislation in general (meaning that “when a person acted on his own and made other people believe that a certain fact exists, then he cannot assert the non-existence of this fact against those who acted on the belief that it exists”).

For example, in relation to the applicability requirements for the doctrine of equivalents, the Supreme Court holds, “if the patentee admitted that a component is not included in the technical scope of the patented invention, e.g., he/she intentionally excluded said component from the scope of claim during the patent application process (or he/she appears to have done so), he/she is not allowed later to make an argument contradictory to this in the context of the doctrine of estoppel” (*Supreme Court decision, 24 February 1998, Minshu vol. 521 No. 1 page 113*).

According to a decision (by a lower court, though), a reply to an opposition is taken into account in accordance with the “principle of faith and trust” or the doctrine of estoppel, which is a dominant concept under the civil legislation in general: “the technical scope of the patented invention must be defined based on what is described in the claims attached to the application. For the purpose of interpreting the scope of claims, matters described in the specification and drawings attached to the patent application should be taken into consideration, in addition to technical matters that are obvious to those skilled in the art. As a general rule, the types of data used to interpret the scope

of claims should be limited to these. However, assume that an applicant made a statement to restrict the meaning of what is described in the claims by submitting a reply to an opposition (or other types of document (i.e. the file wrapper) that is accessible to anyone by means of a request for inspection, copying or issuance of a copy), and this statement was accepted by the examiner of the Patent Office and a patent was granted. If, without this statement, it is highly likely that his patent application would have been rejected due to lack of novelty or inventive step relative to known art (i.e. a cited reference) asserted by an opponent, and therefore, it is objectively justifiable that the applicant needed to make this statement, then, the same person, as the patentee, is not allowed to make an argument that is contradictory to said statement in proceedings against alleged infringement on his patent in the context of the principle of faith and trust or the doctrine of estoppel, which is a dominant concept under the civil legislation in general (the doctrine of “file wrapper estoppel,” one aspect of the principle of faith and trust or the doctrine of estoppel applied in the field of patent law). In such a case, even if the technical meaning of the description in the claims is clear in light of the description in the specification and drawings that are publicized in the patent gazette, the above-mentioned statement by the applicant is usually understood by third parties as an indispensable matter for the grant of patent. The trust of third parties based on such understanding must be protected. Allowing the patentee to make an argument that is contradictory to said statement in patent infringement proceedings would represent a betrayal of the third parties’

legitimate trust.” (*Osaka District Court decision, 26 September 1996, Hanrei Jiho No. 1602 page 115*)

Note that, according to a commonly accepted theory, it does not matter whether a third party actually had such trust or not in the above case (i.e. the doctrine is applied categorically).

***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?**

**(Answer)**

We think that applicants become likely to refrain from making statements during the prosecution of a patent application in Japan in order to avoid any disadvantageous effect on interpretations of patent claims in such countries (e.g. use of foreign prosecution history for a narrower interpretation of the claims in the context of the doctrine of estoppel). As a result, the prosecution process may become constrictive.

Moreover, if practices related to the applicability of foreign prosecution his-

tory (e.g. for a narrower interpretation of claims) vary from country to country, these applicants may refrain from making statements in all foreign countries, in consideration of a country of the most unfavorable practices for each type of applicability. As a result, the prosecution process may become even more constrictive.

- 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?**

**(Answer)**

Yes (a patent may be invalidated on the basis of the same prior art taken into account by the examiner during prosecution of the patent). Under the Japanese Patent Act, there is no provision like “A patent shall be presumed valid” as in Section 282 of the US Patent Law.

Typically, a patent can be invalidated on the basis of the same prior art and a different argument (justification). However, a patent can be invalidated on the basis of the same prior art and the same argument used by the examiner. The same prior art may be used regardless of whether it is shown that there is a new question based on some other teaching or aspect of that prior art.

Incidentally, up until recently, Article 167 of the Patent Act stated, “When a final and binding trial decision in a trial for patent invalidation ... has been registered, no one may file a request for a trial on the basis of the same facts and evidence.” However, it was difficult to rule out the possibility that a trial decision may vary depending on how skillfully the demandant for trial makes an argument, so that a revision was made on 1 April 2012 to abolish the effects on third parties to final and conclusive decisions in invalidation trials, by modifying this article to read as follows: “When a trial decision in a trial for patent invalidation ... has become final and binding, the parties and the intervenors may not file a request for a trial on the basis of the same facts and evidence” (applicable to the patents registered on and after the effective date of the revised Act). This revision made it possible for a person other than the parties and the intervenors in the relevant trial for invalidation to file a request for another trial for invalidation on the basis of the same prior art and justification.

## **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?**

**(Answer)**

We think the harmonization is desirable for third parties as well as patentees, because it would become possible to overcome problems with the predictability that is attributable to difference in practices between the countries. However, there is also a strong opinion that harmonization of criteria for claim interpretation should be achieved first.

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

**(Answer)**

We think it is 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**

**(Answer)**

Due to the reason described in our answer to Q 3), foreign prosecution history should not be considered.

**b) the type of proceeding and circumstances in which it should be considered.**

**(Answer)**

It is not necessary to limit these types. We think that not only arguments made during the application proceedings and opposition proceedings (written arguments, amendments), but also arguments made during post-grant proceeding should be considered.

However, the prosecution history

should be considered in its entirety. For example, if an argument in the prosecution history may be used for a narrower interpretation of the claims and the patentee withdraws or modifies the argument in a later process of the prosecution, this withdrawal or modification should be determined to be valid. That is, through this withdrawal or modification, the patentee should be allowed to prevent said argument from being used for a narrower interpretation of the claims.

Moreover, the use of an argument in the prosecution history for a narrower interpretation of the claims should be allowed only if this argument was needed to highlight a difference from prior art. For example, if an amendment was made to clarify the wording in response to a notice of inappropriate description, this amendment should not be used for a narrower interpretation of the claims. Otherwise, the applicants may hesitate to make an amendment even for the purpose of clarifying the wording, and thus the prosecution process may become constrictive. If the clarity of description is not ensured due to such hesitation, examination of patent infringement cases may not be carried out smoothly, which in turn could make it difficult for the patentees to enforce their rights.

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

None.

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