



# Use of prosecution history in the United States, UK and Australia

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# Overview

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  - Post-*Actavis* decisions
- Australia
  - Recent case law: *Bradken Resources*
  - *Patents Act 1990* (Cth), s. 116

# US: Introduction / Definitions

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## Doctrine of equivalents (DoE):

- Allows patentee to assert infringement against “equivalents” that do not infringe the claims on a literal reading
- “Equivalence” is assessed element-by-element and asks
  1. whether an element performs substantially same function in substantially same way to obtain same result; *or*
  2. whether differences between elements in question are insubstantial.
- Use of DoE is constrained by multiple judicial limitations, one of which is **prosecution history estoppel**

# US: Introduction / Definitions

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## Prosecution history (file wrapper) estoppel:

- Prevents patentees from recapturing in litigation subject-matter surrendered during prosecution
- Acts to limit patentee's assertion of infringement under **DoE**

## Prosecution disclaimer:

- a separate doctrine that acts to narrow claims during **claim construction**

# US: Two stages for prosecution history use

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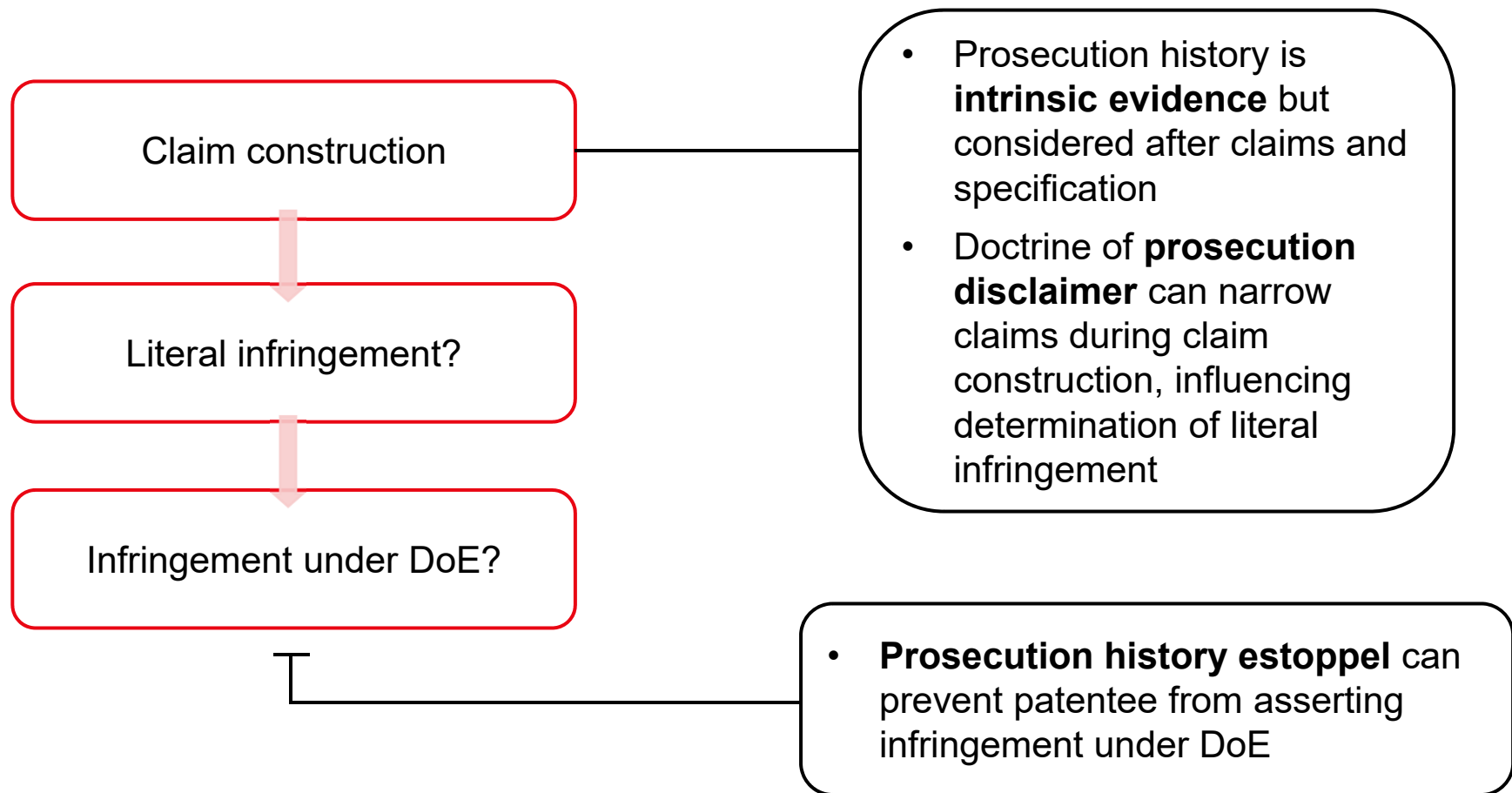
## 1. Claim construction

- Prosecution history is considered ‘intrinsic evidence’ (along with the claims and specification) and may be used to construe claims
- Considered *after* consideration of claims and specification
  - One use is **prosecution disclaimer**: Narrows claims when a patentee *unambiguously disavows* a certain meaning through amendment or argument during prosecution – burden is on asserting party

## 2. Infringement under DoE

- **Prosecution history estoppel**

# US: Two stages for prosecution history use



# US: Prosecution history estoppel overview

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- **Amendment-based estoppel:** Presumption of estoppel arises any time a claim is narrowed to satisfy the Patent Act - not limited to amendments made to avoid prior art (*Festo Corp v Shoketsu Kinzoku Kogyo Kabushiki Co*, 535 US 722 (2002))
- Patentee can rebut presumption by showing one of three exceptions:
  1. rationale underlying amendment bore no more than tangential relation to equivalent in question (**tangential relation**)\*;
  2. equivalent unforeseeable at time of application (**unforeseeability**); or
  3. some other reason suggesting patentee could not reasonably be expected to have described insubstantial substitute in question (“**some other reason**”).

\*only tangential relation exception has been applied by Federal Circuit

# US: Prosecution history estoppel overview

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- **Argument-based estoppel:** Estoppel can arise from arguments made during prosecution, provided prosecution history evinces a *clear and unmistakable surrender of subject matter* (*Deering Precision Instruments, LLC v Vector Distribution Systems, Inc*, 347 F 3d 1314 (Fed Cir 2003))

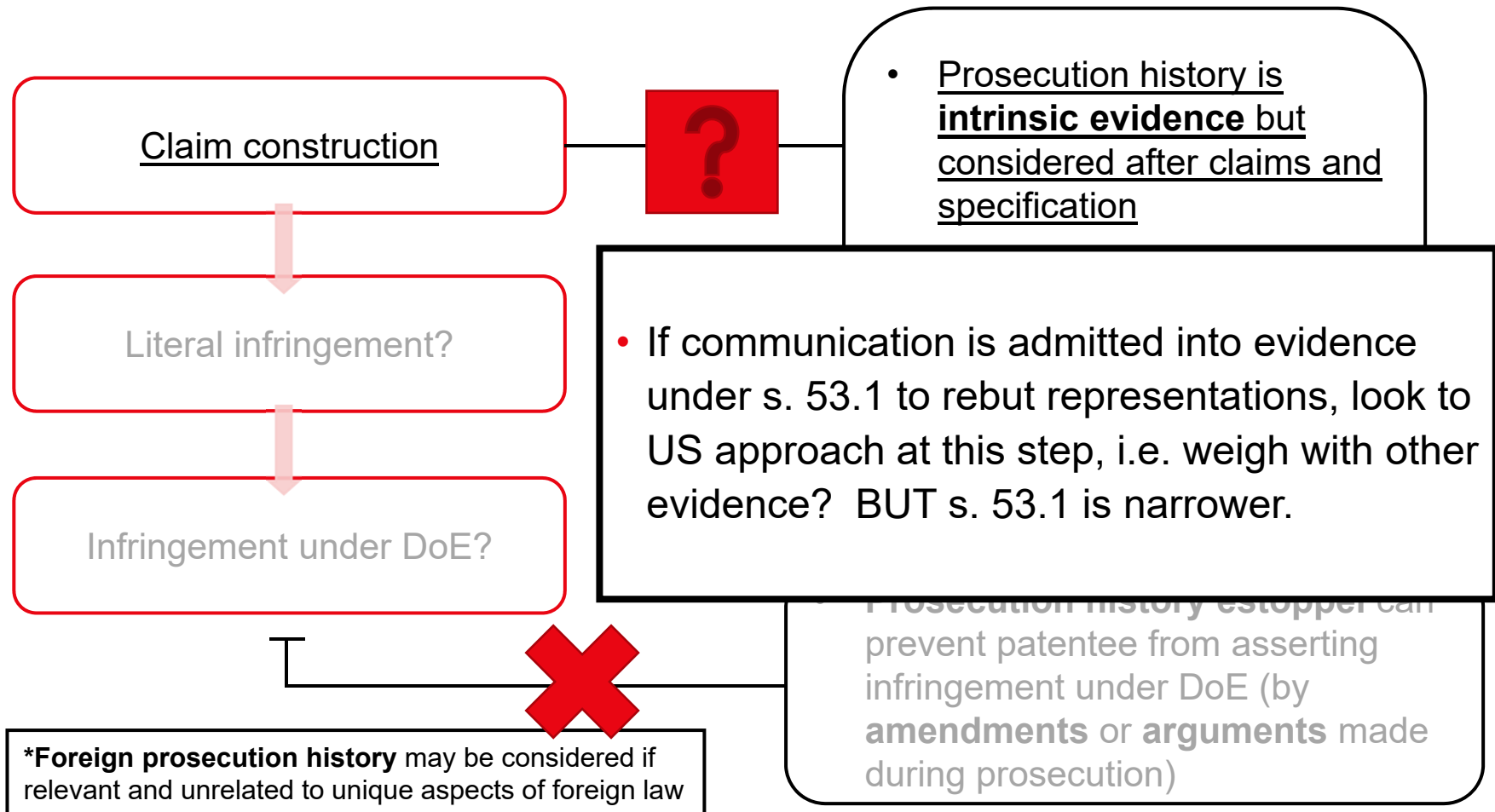


## US: Use of foreign prosecution history

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- Use of **foreign prosecution history** is narrow but may be considered if relevant and not related to unique aspects of foreign patent law
  - Has been considered by Fed Cir in both claim construction and prosecution history estoppel contexts, e.g.
    - statements made in a related but later-prosecuted foreign application with an identical specification that “could not [have been] clearer” which were consistent with construction based on specification (*Apple Inc v Motorola, Inc*, 757 F 3d 1286 (Fed Cir 2014), overruled on other grounds)
    - a “blatant admission” regarding claim interpretation made by a party (alleged infringer) before a foreign office supported construction (*Gillette Co v Energizer Holdings, Inc*, 405 F 3d 1367 (Fed Cir 2005))
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# US: Applicable to Canada?



## UK: *Actavis UK Ltd v Eli Lilly & Co*

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- Prior to 2017, use of prosecution history in claim construction was widely discouraged (e.g., *Kirin-Amgen v Hoechst Marion Roussel*, [2004] UKHL 46)
- ***Actavis UK Ltd v Eli Lilly & Co*, [2017] UKSC 48**: Lord Neuberger provided two limited circumstances in which prosecution history can be considered to determine scope of claims:
  1. Where point at issue is truly unclear if one confines oneself to specification and claims of patent, and contents of file unambiguously resolve point; and
  2. Where it would be contrary to the public interest for contents of file to be ignored (e.g. made clear to EPO that would not contend that would extend to the sort of variant now claimed to infringe)

# UK: *Actavis UK Ltd v Eli Lilly & Co*

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## Overview:

- Claims referred to “pemetrexed disodium”
- Court found Actavis’ pemetrexed diacid and 2 different salt forms of pemetrexed infringed as being “equivalents” to “pemetrexed disodium” under Article 2 of the Protocol to Article 69 of EPC 2000 (effectively adopting **doctrine of equivalents**), subject to considering prosecution history
- Actavis sought to use EPO communications detailing a series of amendments made by Lilly during prosecution, alleging claims had been narrowed strictly to use of “pemetrexed disodium” and thus use of other salts would not infringe

## UK: *Actavis UK Ltd v Eli Lilly & Co*

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### Application:

- Neither “limited circumstance” allowing use of prosecution history was present
- Examiner considered claims should be limited to pemetrexed disodium because there was no basis in the application as filed to “pemetrexed”
- Court held that this has no bearing on whether patentee can contend that the scope of protection extends beyond claims as construed according to normal principles

## UK: post-*Actavis* decisions

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- In all four post-*Actavis* decisions, neither *Actavis* condition met
- ***Icescape Ltd v Ice-World*, [2018] EWCA Civ 2219**: Presence of narrowing amendment did not indicate patentee had designated all of remaining claim elements as essential; Lord Kitchin (now of the Supreme Court) referred to scenario as “illustration of why it is generally so unprofitable to explore the prosecution history”
- ***Regen v Estar*, [2019] EWHC 63**: Correspondence referring to a “specific concentration” was not accepted to show patentee intended strict compliance with specific molarity of buffered solution in claim
- Also: *Illumina v Premaitha*, [2017] EWHC 2930 and *L'Oréal v RN Ventures*, [2018] EWHC 173 (Pat) “Parties should think carefully in future before incurring additional costs in arguing about the prosecution history”

# UK: Applicable to Canada?

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- *Actavis* test for use of file history likely irrelevant in view of s. 53.1 + Free World
- Use s. 53.1 evidence similar to German/Dutch use (viewed favourably by UKSC)? BUT s. 53.1 is narrower.
  - **German:** permissible to use statements by applicant as indication of how skilled person understands subject matter but such indications cannot be readily used as the sole basis for construction
  - **Dutch:** use only when after skilled person has considered description and drawings, still open to question how contents of the claims must be interpreted

## Australia: *Bradken Resources*

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- Australia does not have established doctrine of prosecution history estoppel nor can prosecution history *as a whole* be used in claim construction
- Last discussed in ***Bradken Resources Pty Ltd v Lynx Engineering Consultants Pty Ltd*, [2015] FCA 1100, aff'd [2016] FCAFC 19** – Court looked to Lord Hoffman’s comments in *Kirin-Amgen* and noted that Australian authorities have “eschewed recourse to extrinsic materials (such as correspondence between the patent applicant and the Commissioner) for the purpose of ascertaining the true scope of a claim”
- Issue was ultimately left undetermined, and has not been raised since



## Australia: *Patents Act 1990*, s. 116

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- Per Australian *Patents Act 1990*, s. 116, courts may refer to specification without amendment during claim construction:

### **116 Interpretation of amended specifications**

The Commissioner or a court may, in interpreting a complete specification as amended, refer to the specification without amendment.

- Provision is framed in narrow terms and does not allow recourse to other documentation surrounding amendments nor should it be used as starting point for claim construction (*Ranbaxy Laboratories Limited v AstraZeneca AB*, [2013] FCA 368; *Sigma Pharmaceuticals (Australia) Pty Ltd v Wyeth*, [2010] FCA 1211)
  - However, s. 116 has been used to provide a basis for an inference as to what was intended by patentee and to cast light on construction of claims (see, e.g., *Baygol Pty Ltd v Foamex Polystyrene Pty Ltd*, [2005] FCA 624)
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## Australia: Applicable to Canada?

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- N/A – very narrow permissible use of former version of specification under statute