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Should patent prosecution be taken into account when interpreting the claims?

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One of the most disputed topics within the patent community is whether or not the patent prosecution history should be taken into account when interpreting the scope of protection of the claims. Whereas U.S. Courts have traditionally accepted the so-called "file-wrapper estoppel" or "patent prosecution estoppel" defence, the answer on this side of the Atlantic is far less clear.

To date, the judgment that has addressed this question most thoroughly in Spain is the Judgment of 17 January 2008 from Provincial Cout of Barcelona (Olanzapina), from which the following paragraphs may be transcribed:

> "*There may in fact be cases in which, although involving a variation that does not alter the functioning of the invention and obvious to a person skilled in the art, it cannot however be considered as equivalent, due to the conviction that the patent holder wanted to exclude it: hence, a waiver or limitation accepted by the applicant cannot be equivalent, according to prosecution history estoppel. The Spanish professionals who participate in AIPPI have accepted that prosecution history can be raised before the Courts and is relevant for these purposes (AIPPI Conclusions, October 2003) and, although it is true that in the Revision Act of the EPC of November 2000, now in force, the proposed Article 3 of the Protocol for Interpretation, expressly providing for this prosecution history estoppels, was rejected, that does not mean that it is not possible to use it* per se*, not even because in Spanish law it is classified in estoppel and "previous acts" as a guideline for interpreting the declaration of science. The German Supreme Court has explicitly confirmed this doctrine* (Hansen & Hirsch)*, stating that, if a waiver has already been accepted, it is not necessary to verify whether the state of the art really required it. The waiver must be clearly and unquestionably derived from the dossier of the infringing patent, or from parallel files on the processing of equivalent patents in other countries; but it is not necessary to explicitly mention the word waiver or a synonym thereof. If the applicant declares without reservation that it agrees with a limitation proposed by the examiner or by the opposing party and adapts the documents to such limitation, it is considered that this is a waiver*".

This interesting judgment has prompted the debate as to whether an element of interpretation (i.e.

prosecution history) that was explicitly rejected when the contracting parties to the European Patent Convention ("EPC") negotiated the amendment of the Protocol of Interpretation of article 69 of the EPC that came into force on 13 December 2007 should still be considered by European Courts, in spite of having been rejected by the negotiating countries. Hopefully, the Supreme Court will shed some light on this topic when it decides the appeal filed against that judgment, although this will still be several years from now.

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