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Prosecution file relevance in assesement of protective scope – a recent Danish High Court decision

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In 1984, the claimant filed an application for an agricultural crop spraying device which by the use of compressed air was intended to offer a more efficient means of dispensing the liquid.

In 1986, the claimant sent a copy of the application to the defendant and in 1989 the claimant alleged having noticed that the defendant had commenced marketing of a device virtually identical to the one for which the claimant had applied for a patent. The defendant's preliminary response was that there was no reason to discuss the matter of the alleged infringement until and unless the application were ultimately to result in a granted patent.

The Danish Patent Office ended up concluding that the application lacked inventive step and this decision was upheld on administrative appeal, although the application was remitted for renewed prosecution.

The patent application was subsequently granted in 1996 and this decision was appealed by the defendant, but the Danish Board of Appeal upheld the decision to grant in 1998.

In 1999 the claimant filed the infringement suit against the defendant, which entered a plea of both invalidity and non-infringement.

The High Court (Eastern) Division upheld the patent in its decision-in-part of 2001 and only the issue of infringement remained.

It was common ground that the contents of the prosecution file were of relevance in the construction of the claims and this was accepted by the High Court.

The High Court took it as its factual basis that a number of devices similar to the patented existed in the prior art as the Danish Patent Office pointed out on several occasions to the claimant during prosecution. In the course of the prosecution, the claimant – as a result – amended the application with explicit reference to prior art citations and the High Court held that

“A construction of patent claim must in the current case in particular take place taking into account the claimant's statements during prosecution that the claimant's invention differs from the what it is stated in the Degania application [prior art document] which was thus a token of the state of the art at the priority date of the claimant's patent application.”

On this basis, and taking into account the evidence including court-appointed expert statements and testimony, the High Court ruled that the defendant did not infringe the patent-in-suit.

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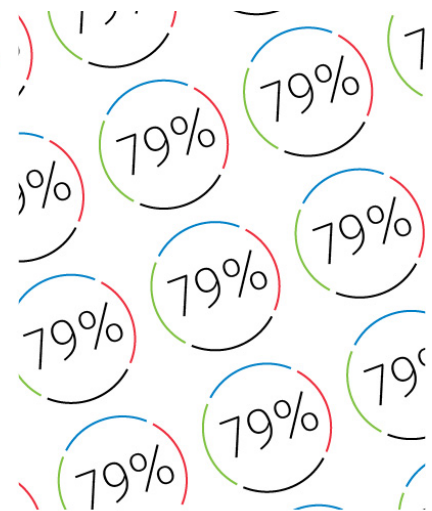
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