



2023 AIPPI World Congress – Istanbul
Adopted Resolution
25 October 2023

Resolution

2023 – Study Question – Patents

Doctrine of equivalents

Background:

- 1) The doctrine of equivalents was previously considered by AIPPI in resolutions Q175, *The role of equivalents and prosecution history in defining the scope of patent protection* (Lucerne 2003), and Q229, *The use of prosecution history in post-grant patent proceedings* (Seoul 2012). This resolution addresses issues that are not considered by resolutions Q175 and Q229.

- 2) In Q175, AIPPI resolved that an “*element shall be regarded as equivalent to an element in a claim, if: 4.a) the element under consideration performs substantially the same function to produce substantially the same result as the claimed element; and 4.b) the difference between the claimed element and the element under consideration is not substantial according to the understanding of the claim by a person skilled in the art at the time of the infringement.*”

- 3) In contrast, an element shall not be regarded as equivalent to an element in a claim, if 5.a) *“a person skilled in the art would at the filing date have understood it to be excluded from the scope of protection, or 5.b) as a result the claim covers the prior art or that which is obvious over the prior art, or 5.c) the patentee expressly and unambiguously excluded it from the claim during prosecution of that patent to overcome a prior art objection.”* Resolution Q229 re-affirmed the 5c exclusion.
- 4) This Resolution concerns the issue of infringement under the doctrine of equivalents in patent law, and in particular the lack of symmetry between infringement and validity, and the role of (unclaimed) alternative embodiments disclosed in the specification in the assessment of infringement by equivalence.
- 5) 40 Reports were received from AIPPI's National and Regional Groups and Independent Members, providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below). These Reports indicate a broad consensus that harmonization is desirable.
- 6) At the AIPPI World Congress in Istanbul in October 2023, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

- 1) There continues to be a need for a doctrine of equivalents. The doctrine of equivalents should take into consideration legal certainty for third parties.
- 2) Resolution Q175 is confirmed, with the exception that 4.a is to be amended so that:

“an element shall be regarded as equivalent to an element in a claim, if:

- 4.a) *“the element under consideration performs substantially the same function in substantially the same way to produce substantially the same result as the claimed element.”*
- 3) Equivalent infringement should not necessarily exclude embodiments disclosed in the patent specification as possible alternatives of the corresponding element literally mentioned in the granted claims, unless the patentee expressly and unambiguously excluded them from the claims in order to overcome a prior art objection.
 - 4) The doctrine of equivalents shall not be applied in the assessment of patentability during either examination of a patent application before grant, or post-grant re-examination of a patent by a patent granting authority.
 - 5) The doctrine of equivalents shall not be applied in the assessment of validity of a granted claim by a competent authority.
 - 6) An embodiment cannot infringe a claim under the doctrine of equivalents if the embodiment is disclosed in the prior art or is obvious over the prior art.