

Working Guidelines

by Luis-Alfonso DURAN, Reporter General,

Jochen E. BÜHLING, Deputy Reporter General and
Ian KARET, Deputy Reporter General
Dariusz SZLEPER and Thierry CALAME,

Assistants to the Reporter General

Question Q175

The role of equivalents and prosecution history in defining

the scope of patent protection

Introduction

The latest revision of the European Patent Convention and recent court decisions in Germany, the Netherlands, UK and US have highlighted the importance of the role of equivalents and prosecution history in defining the scope of patent protection.

Patent owners are often faced with the challenge of drafting claims which are broad enough to offer an invention protection in practice, while meeting the test of sufficiency. This has been particularly relevant in the field of biotechnology. By way of example, in the US the doctrine of equivalents broadens the literal scope of patent claims so that there can be infringement when an integer of the claim is replaced by something which constitutes an obviously immaterial variant or, put another way, which provides substantially the same function in substantially the same way to obtain the same result.

The application process gives applicants the opportunity to enter into a dialogue with the patent office, which may result in amendments to the claims, opinions of the office and the applicant on the invention and its place in the art. This may be of interest if the matters discussed in the prosecution arise in an opposition or during an infringement or validity action. In the US, in particular, the file wrapper of the patent plays a role in claim interpretation.

This question seeks to:

- identify the ways in which countries provide for non-literal infringement of patent claims and infringement by equivalents;
- consider the role of prosecution history in the final scope of patent protection and in the assessment of equivalents; and
- encourage proposals for harmonisation in this field.

It does not concern questions of validity of patent claims in the light of prior art which is alleged to be “equivalent” technology.

AIPPI Studies

AIPPI has considered matters touching on this question in a number of earlier questions.

In Q142 (Breadth of Claims, support by disclosure and scope of protection of patents) the Summary Report (Yearbook 1998/VII, page 5) touched upon the influence of the examination file on national courts. The Rio de Janeiro Congress of 1998 resolved (Yearbook 1998/VIII, 403-404) that:

“5. Material filed during examination or in the course of inter partes proceedings to justify any generalisation in the claims of specific disclosures in the description shall not:

(a) have any effect on the scope of the disclosure of the patent application as filed:

(b) form part of the patent;

(c) serve to remedy any inadequacy in the description as filed.

...

8. Where an alleged infringement achieves substantially the same result as that claimed in a patent by means that differ from the language of a claim, in deciding the issue of infringement a reasonable balance must be maintained between ensuring:

(a) fair reward to the patentee; and

(b) sufficient predictability for the public as to the scope of the claims.”

In Q60 (Interpretation of patent claims)(Yearbook 1980/I, page 56) AIPPI approved the ‘middle way’ for determining the scope of protection. A further resolution at the Buenos Aires Congress (Yearbook 1981, page 73) added that “ *the extent of the protection conferred on an invention by a patent is defined by the claims. However, the description and drawings serve to interpret the claims*”.

In Q69 AIPPI considered the conditions for sufficient description of an invention (Yearbook 1978/II, pages 72-74).

Equivalents

The scope of patent claims is of the utmost importance both to patent owners and to those who wish to work around them. While the literal wording of claims may present problems when considering infringement, allegations of infringement by embodiments that do not fall within the literal wording are usually harder to assess. There are significant differences in the ways national courts interpret such questions and it is sometimes alleged that even those countries which are meant to apply the same test (e.g. the member states of the EPC) do not do so (see, for example, the *Epilady* cases in which different national European Courts reached different findings based on counterpart patents).

In the countries of the EPC, Article 69 EPC and the Protocol on Interpretation of Article 69 (“the Protocol”), provides a general legal framework for interpretation of claims and determination of the scope of protection of claims. Article 69 provides that the extent of protection provided by a European patent or application “*shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims*”.

Further general guidance on the interpretation of claims is provided by the Protocol which states:

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

Although the goal is clear (to achieve a result which combines fair protection for the patentee with reasonable certainty for third parties), it is left to the discretion of the national courts to determine the principles to be applied in order to achieve the goal in any particular case. In the absence of any detailed guidance, there is a risk that national courts may tend to apply traditional principles of claim construction that were developed in their jurisdictions prior to implementation of the EPC and the Protocol, or which echo those principles.

Recent case law has highlighted the difficulties faced in applying the Protocol. These cases include *American Home Products v Novartis* (Rapamycin) and *Pharmacia v Merck* (Cox II inhibitors) in the UK Court of Appeal and *van Bentum v Kool* in the Hague Court of Appeal. In particular, cases concerning the scope of protection of pharmaceutical patents seem to raise problems.

The issues of claim construction and equivalence (and prosecution history estoppel) were the subject of discussion at the Diplomatic Conference on the EPC in November 2000. On 28 June 2001 the Administrative Council of the EPO adopted a new text of the Protocol. Article 1 of the new Protocol differs from the current Protocol as follows:

Article 1 - General Principles

Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the words used in the claims, the description and drawings being used only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims only serve as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

In addition, a new Article 2 was added:

Article 2 - Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

What constitutes an equivalent, how it is to be assessed and at what point in time, were apparently issues which the delegates believed required further consideration. Accordingly, the amendments which will be introduced some time after 2003, are unlikely to assist in the harmonisation of claim construction in Europe.

An earlier draft specified that equivalency was to be judged "at the time of the alleged infringement". It also specified that a means "*shall generally be considered as an equivalent if it is obvious to a person skilled in the art that using such means achieves substantially the same result as that achieved through the means specified in the claim*".

These more detailed provisions were apparently rejected due to the general view that further consideration was needed before adopting such important principles. The Swedish delegation, for example, welcomed discussions concerning equivalence in the context of the EPC Revision Act, stating that it is important that harmonisation on the issue is achieved within the EPC and even more important that we continue to search for a global solution to the problem. However, the Swedish delegation considered that there had been insufficient time to properly study and discuss the issue.

The French delegation considered that words such as “generally”, “using” and “substantially” were too vague and could give rise to differences of interpretation. It also expressed concern that the definition of equivalent “means” referred only to the result, making no mention of function; and considered that this seemed to lead to unacceptable protection of the former. A decision on this important issue without discussion amongst all interested user circles was considered premature.

In the US the test of an equivalent is whether the integer ‘performs substantially the same function in substantially the same way to obtain the same result’. The doctrine is limited in a number of ways. The claim cannot be extended to cover anything old. This means that ‘pioneering inventions’ have a greater potential for equivalents than small advances in well-known areas. The file wrapper of the patent also has a role in the doctrine, discussed below.

In Japan the Supreme Court has set a test for non-literal infringement which provides that non-literal infringement can occur where a non-essential feature is replaced by an element which achieves the same effect in the same way, so long as it is obvious that this is the case, the alleged infringement is not old and there is no file wrapper estoppel.

The question of when equivalents should be judged is also difficult. On the one hand, it may be argued that equivalence should be assessed at the date of infringement, so that a later devised equivalent (which the patentee was not in a position to claim at the date of filing) should be caught. Indeed, the US appears to be moving towards a position where only later devised equivalents can be claimed - for variants known at the date of the patent, the approach seems to be that what is not claimed is disclaimed. On the other hand, it may be argued that there should be some cut off date for assessing equivalents (such as the priority date, the publication date, the date of grant or something else) so that patents do not grow in width during their life.

Prosecution history

Statements made by the patentee and the patent office may have an effect on the scope of protection.

This principle appears most well developed in the US. If the patentee limits the claims e.g. to avoid a prior art objection and argues that the patent is thus valid, the doctrine of equivalents will not cover the disclaimed matter. This is also known as ‘file wrapper’ or ‘prosecution history’ estoppel. In the recent *Festo* case the US Supreme Court reconsidered the scope of narrowing amendments “made to secure” a patent in the USPTO. *Festo*, decided on 28 May 2002, held that a narrowing amendment made for any reason related to patentability can create an estoppel limiting what a patentee can assert as a scope of equivalents under the doctrine of equivalents. That estoppel, however, does not bar all equivalents for the narrowed limitation unless the patentee fails to overcome a presumption of surrender; see www.supremecourt.us.gov/opinions.

In Europe, the position is less clear. The EPC is silent as to whether representations made by the applicant/patentee during prosecution of a European patent application may, in subsequent litigation, be used as an aid to construction of the patent. National Courts have adopted various approaches which remain unsettled.

In The Netherlands, explicit waivers by the patentee of specific embodiments during prosecution can be and are effective against him in subsequent infringement actions (*Walter Dreizler v. Remeha International*). The prosecution history may also be taken into account where the meaning of claims would not otherwise be clear to the skilled reader (*Ciba-Geigy v. Ote Optics*). Explicit waivers also apply in Germany if the alleged infringer is a party to the opposition proceedings in which the patentee waives its right to the relevant embodiment (*Softening Device II case*). The position in the UK is stricter: no reference can be made to the prosecution history unless the patentee himself puts the prosecution file in evidence and relies on it (*Furr v. Truline*). However, it has recently been suggested that reference to the prosecution history can be made where necessary in order to resolve an issue of construction (*Rohm & Haas Co v. Collag*). France seems to fall somewhere in between but the law is not yet settled.

The issue of file wrapper estoppel was addressed (but not resolved) in the context of the EPC Revision Act. During the diplomatic conference in Munich in November 2000, the contracting states considered a provision to be included in the amended Protocol on the Interpretation of Article 69. That provision read as follows:

“For the purpose of determining the extent of protection, due account shall be taken of any statement unambiguously limiting the extent of protection made by the applicant or the proprietor of the patent in the European patent application or patent, or during proceedings concerning the grant or the validity of the European patent, in particular where the limitation was made in response to a citation of prior art.”

This provision was deleted in the final text of the EPC Revision Act. Some delegations, apparently concerned by recent developments in the US regarding prosecution history estoppel, culminating in the controversial decision of the Court of Appeal of the Federal Circuit in *Festo*, argued that further consideration of the issue was needed and a decision should be postponed.

Those against introducing a doctrine of file wrapper estoppel claim that it would achieve little, and would lead to increased costs as well as the lengthening of patent infringement trials. According to this view, it is the task of the EPO to ensure that the scope of the claim as it appears in the specification accurately reflects the patentee’s representations as to its scope. Third parties should not be required to consult the entire file (some of which may need to be translated) in order to determine the scope of protection.

There are, however, a number of arguments in favour of introducing a notion of prosecution history estoppel. First, it is common practice in many jurisdictions to rely upon the history of a document, such as a contract, when construing the document. Secondly, it should not place an undue burden on potential defendants to have to read the file history as, in most cases, parties will review the file history anyway. Thirdly, since the EPO often amends patent claims while making only minimal amendments to the description, and often upholds patents on the basis that words or phrases in the claims have a particular meaning without defining the word or phrase in the description, it would appear reasonable to look to the prosecution history to determine the basis on which the patent was granted or upheld. To allow the patentee after grant to seek to broaden the scope of the claims could be argued to be contrary to the spirit of the Protocol insofar as it requires “fair” protection for the patentee and reasonable certainty for third parties.

In Japan, the file wrapper plays a role in the doctrine of equivalents similar to that seen in the US.

In Canada, the file wrapper cannot be used to show that the patentee disclaimed certain material during prosecution or to show that the patentee considered certain features to be essential. The inadmissibility of the file wrapper in Canada was recently confirmed in *Whirlpool*.

Questions

National Groups are invited to answer the following questions under their national laws:

1. If your country has a doctrine of “equivalents”, what is it and how are equivalents assessed? Is it provided for by statute or case law?
2. Can the scope of patent protection change with time, or is it fixed at a particular date? If it is fixed, at what date (e.g. priority, application date or date of alleged infringement)?
3. Does the prosecution history play a role in determining the scope of patent protection? If so, how does it work? In particular:
 - a) Is there ‘file wrapper estoppel’ and if so in what circumstances does it arise?
 - b) Is there a difference between formal (e.g. oppositions) and informal (e.g. discussions with examiners) actions in the patent office?
 - c) Is there a difference between actions taken by the patent office and by third parties?
4. Is there any way the scope of claims can be limited outside prosecution, e.g. by estoppel or admissions?

5. Do you have recommendations for harmonisation in this area?

Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and cite the questions and numbers for each answer.