



THE DOCTRINE OF THE EQUIVALENTS THROUGHOUT THE WORLD

The situation today

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There is presently no international rule governing the interpretation of claims in view of infringement. Therefore, these rules must be considered country by country. Moreover, generally, in each country, there is no detailed article of the law for such interpretation. Claim construction is mostly based on case law or jurisprudence.

There are important differences from country to country. However, claim construction requires generally a two-step analysis:

First step: determine the meaning of the terms in view of the specification.

Second step: if the claim is not literally reproduced by a device, product or process, it must be determined whether the accused device, product or process is equivalent or not to the corresponding claim.

Besides, the topics on which discussion about equivalents are involved is, according to a country,

- whether a structure-function-result approach or the like is considered
- whether a file wrapper estoppel is considered
- whether the fact that a replacement mean is obvious is considered
- whether inessential means may be neglected.

Here below a brief summary for some countries. Although this information has been checked, new contributions should be studied.

1/ FRANCE

With regard to a French patent, a characteristic should be said to be an equivalent if it has a structure different from a claimed structure, but this different structure performs a same function, and leads to similar results.

In France, some elements of the claim may be considered as inessential because they do not participate to the solution of the problem solved by the claimed invention, and in that case, these inessential elements are not taken into consideration for the infringement analysis.

2/ GERMANY

Purposive construction as in United Kingdom seems generally to lead to a narrower scope of protection than that which would be found in Germany, because in Germany the third question is not asked. In Germany it is unimportant what the patentee intended. Just the patent itself is decisive. The remaining statements for United Kingdom apply to Germany as well.

3/ ITALY

The Court of Appeal in Milan has issued a fundamental decision about the "doctrine of equivalents" on November 7, 2000. This Decision is known as the "Forel vs. Lisec" case and is in line with the "Festo" case law. Here is a brief headnote: the voluntary amendments to a pending patent claim cannot be considered without effect in order to apply the "doctrine of equivalents". Moreover, an alleged infringement product cannot be considered equivalent to a patent claim if it has a different technical structure or requires a different technical manufacturing phase. However, Italy is not a Common Law country and even if the above Decision has a great importance, and will be taken in due consideration when deciding future lawsuits involving the doctrine of equivalent, Italian Patent Law has not yet been amended in line with such a Decision and each legal case must be evaluated under the protocol of interpretation of Art. 69 EPC.

There are a lot similarities between Germany and Italy with reference to the infringement litigation procedure and the interpretation of the claims. This statement is supported by the recent favourable conclusion of corresponding infringement actions.

4/ JAPAN

In Japan, the whole element rule prevails, i.e. if the accused product (or device, or method) does not reproduce an element (literally or by equivalence), it is not considered as an infringement.

The doctrine of equivalents has been introduced recently by a Supreme Court decision of February 1998.

Regarding the Japanese practice of the interpretation of claims in view of infringement, the Supreme Court has introduced requirements for applying the doctrine of equivalents as follows:

- 1 - An element causing a difference between the accused product (or method) and a construction defined by the patented claim is insubstantial.
- 2 - The patent invention can accomplish the same purpose or object and achieve the same operation and effectiveness as the accused one even when the patented invention should have been changed by substituting the accused element regarding the particular difference for the corresponding element of the accused product (or method).
- 3 - The particular substitution is readily conceivable by a person skilled in the art at the production of particular accused product (or method).
- 4 - The particular accused product (or method) is neither the same as an art publicly known in the art or readily conceivable by a person skilled in the art, at the time of filing of the particular application.
- 5 - There are not any specific circumstances that the accused product (or method) has been intentionally excluded during the prosecution of the particular patent application.

5/ KOREA

Claim construction in Korea is similar to the one presently prevailing in Japan.

6/ UNITED KINGDOM

In the UK Art. 69 EPC and the protocol are implemented using "purposive construction". "Variants" which do not fall within the purely literal scope of a claim may be considered to still constitute an infringement by virtue of purposive construction. This involves asking the following three questions:

- 1 - Does the variant have a material effect upon the way that the invention works? If yes, the variant is outside the claim.
- 2 - Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader

skilled in the art? If no, the variant is outside the claim.

- 3 - Would the reader have nevertheless understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes the variant is outside the claim.

Purposive construction seems generally to lead to a narrower scope of protection than that which would be found in Germany.

In UK law there is no general principle that an inessential feature may be ignored for infringement purposes. However, in some circumstances use of purposive construction can lead to a situation where it appears as though a feature has been ignored.

Lastly, at least from an theoretical/academic point of view, it is not really true to say that there is a two step analysis in claim construction in the UK. There is no separate of step of determining if the accused device etc is equivalent to the invention claimed. In the UK, the scope of the claim is determined using purposive construction and the accused in United Kingdom device either falls within the claim or it does not.

7/ USA

In USA, the whole element rule prevails, i.e. if the accused product (or device, or method) does not reproduce an element (literally or by equivalence), it is not considered as an infringement.

1) The claim construction

- 1.1 - According to the most recent case law ("Festo"), the whole file story may be considered in order to interpret the claim language.
- 1.2 - "Means + function" are not interpreted as broadly as they look like. Such means are interpreted according to the embodiment described in the specification and to the equivalents thereof. However, the "equivalents" are more restricted in that case than in the frame of the "doctrine of equivalents".

2) Comparison with an infringing product (or device, or method)

- 2.1 - The "whole element" rule : Generally, if an element of the claim is absent from the product (or device, or method), it is considered that there is no infringement.
- 2.2 - The doctrine of equivalents : If an element of the claim is not reproduced literally by the product, there is nevertheless

infringement if the product uses an equivalent of this element. According to the US case law in order to be equivalent, an element must be such that it provides the same result, by using the same function and with similar means.

In the November 29, 2000 decision in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. the Federal Circuit announced an absolute bar by amendment rule that fundamentally contracts the availability of the patent law doctrine of equivalents. Under this rule, no scope of equivalents survives for any claim limitation that was narrowed during prosecution for any reason related to patentability; such limitations may only be met literally. The law is evolving and no doubt changes will be made in the near future.

8/ EUROPE

Claim construction is governed by article 69 of EPC and by the protocol for interpretation of such article. Although the file story may be considered for claim construction, it has generally less weight than in USA. Infringement is determined country by country even for European patents. There is no European Court having jurisdiction for the European countries.

In spite of the protocol for interpretation of article 69, claim construction in view of infringement may differ notably from one country to the other. Discussions are held between European countries to complete the protocol for the interpretation of article 69 by rules relating to equivalence and to prosecution history estoppel. These discussions aim at establishing an equivalent analysis on a basis of a similar result only (without necessity for an equivalent mean to perform a same function), and an estoppel.

Anyway, for claim construction and the doctrine of equivalents, contrary to USA, there is no difference between functional and structural claims.