AIPPI Study Question Q284 – Doctrine of equivalents

Report of the Swiss Group

I. Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

In the questions below:

«**4a function test**» means that the elements under consideration in the allegedly infringing product perform substantially the same function to produce substantially the same result as the corresponding claim element,

«**4b difference test**» means that 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,

«**5a exclusion**» means that a person skilled in the art would at the filing date have understood an element to be excluded from the equivalent scope of protection,

«**5b exclusion**» means that as a result of adopting the equivalent scope of protection, the scope of protection covers the prior art or that which is obvious over the prior art,

«**5c exclusion**» means the patentee expressly and unambiguously excluded an element from the claim during prosecution of that patent to overcome a prior art objection, and

The «**Q175 Approach**» means that the scope of protection shall include those elements that meet the 4a function test and 4b difference test, provided that they are not excluded under the 5a, 5b or 5c exclusions.

1.

Is the current law and practice in your jurisdiction generally in line with the Q175 Approach?

a) **Is there a distinction between the scope of protection and the scope of claims?**
YES.
Due to the doctrine of equivalents, the scope of protection of a patent is broader than the scope of claims.

b) **Is the current law and practice in your jurisdiction following the 4a function test?**
YES
The first question to establish equivalent infringement asks whether the replacing element performs the objective same function as the claimed element (*Gleichwirkung*, Swiss Federal Patent Court, decision O2014_002 – «*Urinal-Ventil*»). The replacing element must produce the same result, not just «substantially» achieve the same result.

c) **Is the current law and practice in your jurisdiction following the 4b difference test?**
YES
The second question to establish equivalent infringement asks whether the replacing element and its objective same function are evident for the skilled person starting from the teaching of the patent, knowing that the element has been replaced (*Auffindbarkeit*, Swiss Federal Patent Court, decision O2014_002 – «*Urinal-Ventil*»).

d) **Is the current law and practice in your jurisdiction following the 5a exclusion?**
UNRESOLVED.
Although there is no case law directly addressing this issue, Swiss courts refer to the decision by the German Federal Court of Justice (Bundesgerichtshof) X ZR 16/09 – «*Okklusionsvorrichtung*» and would most likely follow this exclusion.

e) **Is the current law and practice in your jurisdiction following the 5b exclusion?**
YES
The exclusion is followed in Switzerland; the *Formstein* defence is applicable when the allegedly infringing embodiment would lack novelty or inventive step over the prior art (Swiss Federal Supreme Court, decision 115 II 490).

f) **Is the current law and practice in your jurisdiction following the 5c exclusion?**
UNRESOLVED
The exclusion is subject to heated debate. The argument advanced is that claiming an element explicitly excluded from the claim during prosecution due to prior art would constitute an abuse of right, but there is no case law on the matter (Swiss Federal Supreme Court, decision BGE 143 III 666 – «*Pemetrexed*», explicitly leaving this question open).

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The english translation of the summary is included on Swisslex and legalis only.

2.

Whether (unclaimed) alternative embodiments disclosed in the specification should be excluded from infringement by equivalence

a) **Under the current law and practice in your jurisdiction, does equivalent infringement categorically exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims, i.e. are such alternative embodiments implicitly disclaimed from the equivalent scope of protection?**
YES
See the answer to question 1d) above.

b) **Under the current law and practice in your jurisdiction, does equivalent infringement exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims if the patentee excluded them from the claim during prosecution of that patent to overcome a prior art objection?**
YES
See the answer to question 1d) above. In Switzerland, if there is a 5a exclusion situation, the 5c exclusion is not relevant.

3.

Under the current law and practice in your jurisdiction, does one consider the equivalent scope of protection conferred by a patent when assessing validity and/or patentability of that patent? In other words, is it possible that, considering the equivalent scope of protection of a particular patent, this patent is deemed to

a) **lack novelty, and/or**
NO
Validity and patentability are assessed independently of the equivalent scope of protection of a patent.

b) **lack inventive step (non-obviousness), and/or**
NO

c) **lack sufficiency of disclosure, and/or**
NO

d) **lack plausibility, and/or**
NO

e) **claim added matter?**
NO

If your answer to any of the questions 3a) to e) is YES, please address the following questions:

4.

When assessing validity and/or patentability against the equivalent scope of protection, are the relevant embodiments limited to those embodiments which are attacked as «equivalent infringement» in a specific case by the patent owner (or an otherwise entitled person)?
Please answer YES or NO and you may add a brief explanation.
[N/A]

5.

If the answer to question 4 is YES, is anyone be entitled to attack the validity and/or patentability of the patent based on such argument, or only the alleged infringer?
Please answer YES or NO and you may add a brief explanation.
[N/A]

6.

If the answer to question 4 is NO, what is the appropriate approach to identify the relevant equivalent embodiments when assessing validity and/or patentability? Is there, for example, a requirement that relevant equivalent embodiments must be likely being used in practice?
Please answer YES or NO and you may add a brief explanation.
[N/A]

7.

If the answer to question 4 is NO, does the patent office consider the equivalent scope of protection when assessing validity and/or patentability, or is such discussion limited to post-grant proceedings?
Please answer YES or NO and you may add a brief explanation.
[N/A]

II. Policy considerations and proposals for improvements of your Group's current law

8.

According to the opinion of your Group, is your current law regarding the doctrine of equivalents adequate and/or sufficient?
YES.

9.

According to the opinion of your group, is there (still) a need for a doctrine of equivalents under your law, i.e. in that there needs to be a distinction between the scope of protection and the scope of claims?

YES.

10.

According to the opinion of your group, what is the principal justification of the doctrine of equivalents? What factor does legal certainty for third parties play in this regard?

A technical inventive concept cannot be expressed conclusively through language. Language allows only to a limited extent the capturing of the full content of an invention in a patent claim in words. The patentee is only adequately rewarded if the scope of protection goes beyond the mere wording.

The scope of protection must not be extended too excessively. Sufficient legal certainty is ensured if any knowledgeable third party can determine the scope of protection with some reliability on the basis of the wording of the patent claims in light of the description and the drawings.

11.

Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

NO.

III. Proposals for harmonisation

12.

Do you consider harmonisation regarding the doctrine of equivalents as desirable in general?

If YES, please respond to the following questions without regard to your Group's current law or practice.

YES.

Harmonisation would increase legal certainty and avoid diverging judgments in different jurisdictions.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

13.

Do you see any need to amend and/or change the Q175 Approach?

NO.

a) **Is there (still) a need for doctrine of equivalents, i.e should there be a distinction between the scope of protection and the scope of claims?**
YES.
See the answer to question 10 above.

b) **Alternatively, instead of a doctrine of equivalents, would it better to require more comprehensive claim drafting, or would you prefer any other alternative approaches to address the material issues underlying the doctrine of equivalence, such as e.g. an exhaustive list of equivalents set forth in the specification?**
NO.
This would unduly diminish the fair protection for the patentee. It is very difficult to draft fully comprehensive claims or to list equivalents exhaustively.

c) **Do you see any need to amend and/or change the 4a function test in Q175?**
NO.
The AIPPI might consider examining whether the produced result must be «substantially the same result» or rather «the same result» (i.e. fully identical).

d) **Do you see any need to amend and/or change the 4b difference test in Q175?**
NO.
The AIPPI might consider examining whether the «difference» refers to the replacing element or the effect of the replacing element.

e) **Do you see any need to amend and/or change the 5a exclusion in Q175?**
NO.

f) **Do you see any need to amend and/or change the 5b exclusion in Q175?**
NO.

g) **Do you see any need to amend and/or change the 5c exclusion in Q175?**
NO.

14.

Whether (unclaimed) alternative embodiments disclosed in the specification should be excluded from infringement by equivalence

a) **Should equivalent infringement categorically exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims, i.e. are such alternative embodiments implicitly disclaimed from the equivalent scope of protection?**
NO.

b) **Should equivalent infringement exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally**

mentioned in the granted claims if the patentee excluded them from the claim during prosecution of that patent to overcome a prior art objection?
YES.
Either exclusion 5a or 5c should be sufficient.

15.

Should one consider the equivalent scope of protection conferred by a patent when assessing validity and/or patentability of that patent? In other words, should it be possible that, considering the equivalent scope of protection of a particular patent, this patent is deemed to

a) lack novelty, and/or
NO.
Validity and patentability should be assessed independently of the equivalent scope of protection.

b) lack inventive step (non-obviousness), and/or
NO.

c) lack sufficiency of disclosure, and/or
NO.

d) lack plausibility, and/or
NO.

e) claim added matter?
NO.

Even if your answer to question 15 is NO, please address the following questions:

16.

When assessing validity and/or patentability against the equivalent scope of protection, should the relevant embodiments be limited to those embodiments which are attacked as «equivalent infringement» in a specific case by the patent owner (or an otherwise entitled person)?

YES, for practical reasons. Establishing an exhaustive list of equivalent embodiments is impossible.

17.

If the answer to question 16 is YES, should anyone be entitled to attack the validity and/or patentability of the patent based on such argument, or only the alleged infringer?

NO, only the alleged infringer.

18.

If the answer to question 16 is NO, what should be the appropriate approach to identify the relevant equivalent embodiments when assessing validity and/or patentability? Should there be, for example, a requirement that relevant equivalent embodiments must be likely being used in practice?

[N/A]

19.

If the answer to question 16 is NO, should the patent office consider the equivalent scope of protection when assessing validity and/or patentability, or should such discussion be limited to post-grant proceedings?

[N/A]

20.

Please comment on any additional issues concerning any aspect of equivalents that you consider relevant to this Study Question.

The existing gap between the assessment of equivalent infringement and inventive step should be *reduced* as much as possible.

Within the Swiss Group, some Members would like the AIPPI to consider the following proposal: Taking the equivalents into account during the grant procedure would make the doctrine of equivalents and inventive step more symmetric. In practice, the patent office would first define the scope of protection (i.e. a broader object than the one defined merely by the scope of the claims wording) of a patent application. This scope would be based on the teaching of the complete patent application and consider equivalents as exhaustively as possible (albeit the Swiss Group is aware of the practical difficulties in implementing such measure and the additional responsibility on patent examiners). The patentability review (novelty, inventive step/non-obviousness, sufficiency of disclosure, clarity, etc.) would be carried out for each equivalent scope of protection. Such an approach would certainly avoid or reduce the time spent on the assessment of at least the 5a and 5b exclusions during an infringement action. The comprehensive examination would in any case provide more clarity on the scope of protection of the patent.

21.

Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.

Test and measurement equipment; Pharmaceutical industry

Zusammenfassung

Die Schweizer Arbeitsgruppe führte eine ausführliche Untersuchung der aktuellen Gesetzgebung und Gerichtspraxis, politischen Erwägungen und Harmonisierung der Äquivalenzlehre durch.

In der Schweiz entsprechen sowohl die Gesetze als auch die Gerichtspraxis im Wesentlichen den von der AIPPI erarbeiteten Funktions- und Differenztests. Nichtsdestotrotz sind mehrere Ausschlüsse der äquivalenten Patentverletzung von den Gerichten nicht geprüft worden, insbesondere bezüglich (nicht beanspruchten) alternativen Ausführungsformen und der Geschichte des Erteilungsverfahrens. Die Rechtsbeständigkeit und die Patentierbarkeit werden unabhängig des äquivalenten Schutzbereichs eines Patents beurteilt.

In Bezug auf politische Erwägungen ist die Schweizer Arbeitsgruppe der Ansicht, dass der Schutzumfang weiterhin vom Umfang des Patentanspruchs zu unterscheiden ist. Technische erfinderische Konzepte können nicht schlüssig durch Sprache ausgedrückt werden, sodass die Äquivalenzlehre dem Patentinhaber einen angemessenen Anreiz bieten muss, indem ihm ein über den blossen Anspruchswortlaut hinausgehender Schutzbereich eingeräumt wird.

Im Sinne der Rechtssicherheit und zur Vermeidung unterschiedlicher Entscheidungen in verschiedenen Rechtsordnungen sind weitere internationale Harmonisierungbestrebungen im Bereich der Äquivalenzlehre sehr erwünscht. Besonders die bestehende Kluft in der Beurteilung der äquivalenten Verletzung und der erfinderischen Tätigkeit sollte soweit wie möglich geschlossen werden.

Résumé

Le groupe de travail Suisse a réalisé une étude approfondie de la législation et des pratiques actuelles, des considérations politiques et des propositions d'harmonisation de la doctrine des équivalents.

En Suisse, les lois et pratiques actuelles sont généralement conformes aux tests de fonction et de différence tels que définis par les travaux antérieurs de l'AIPPI. Il faut noter toutefois que quelques exclusions de la contrefaçon par équivalence n'ont pas été testées par les tribunaux, notamment en ce qui concerne les modes de réalisations alternatifs (non revendiqués) et de la prise en compte du dossier de délivrance. La validité et la brevetabilité sont déterminées indépendamment de l'étendue de protection équivalente d'un brevet.

Pour les considérations politiques, le Groupe de travail suisse est d'avis qu'il est toujours nécessaire de faire une distinction entre l'étendue de la protection et l'étendue des revendications. Étant donné que les concepts inventifs techniques sont limités par la portée des mots, la doctrine des équivalents est nécessaire pour inciter de manière appropriée le titulaire du brevet en lui accordant une étendue de protection au-delà du simple libellé de la revendication.

Afin d'augmenter la sécurité juridique et éviter des jugements divergents dans chaque juridiction nationale, une harmonisation internationale plus poussée concernant la doctrine des équivalents est souhaitable. En particulier, l'écart existant entre l'appréciation de la contrefaçon équivalente et de l'activité inventive devrait être réduite autant que possible.