



beau de Loménie

**SOME ASPECTS
OF THE DOCTRINE OF
EQUIVALENTS**

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I. INTRODUCTION

Considering a patent claim which is valid in view of the prior art, the simplest case of infringement is the case where the infringing object literally reproduces the invention, as defined in the claim.

However, should this situation be the only one in which infringement exists, this would be excessively unfavourable to the patentee, since it is very difficult to draft claims at the date of filing a patent application which foresee all possible future infringements. Further a patent system shall prove efficient if it prevents that one easily escapes patent enforcement by merely distinguishing from the invention claimed without departing from its spirit.

This has led Patent Courts throughout the world to consider that the scope of the claims should not be limited to the literal wording thereof, but be somewhat broader.

The doctrine of equivalents has been developed in line with this consideration and has been constructed in a view of avoiding both an excessive limitation of the scope of a patent for preserving the patentee's rights and an undue extension of the scope of patents so that third parties may have a reasonable degree of certainty.

The concept of equivalents is recognised in many countries but its application differs from one country to the other.

The present study aims at explaining the definition of infringement by equivalent means and at giving some indications on the application of the doctrine of equivalents in France. Emphasis will be laid upon some peculiarities of the French approach and a view on infringement by equivalence within the frame of the European Patent Convention will be given.

II. DEFINITION OF INFRINGEMENT BY EQUIVALENT MEANS

1. Definition of a technical equivalent means

Two means are technically equivalent if they fulfil the same function with a view to obtain the same result or a result of similar nature, while having a different form or structure.

A technical equivalent element, which is to replace or be substituted for an element of a claim must primarily perform the same function, within the context of the claim, as the element that it replaces.

2. Infringement by equivalence

A technical equivalent means as defined above shall be held as infringing if the claim has not been restricted to the particular definition of the claimed element that the equivalent replaces for reasons of patentability.

More precisely, a product or a method incorporating a technical equivalent means infringes a patent if the patent covers the function which is fulfilled both by the technical equivalent means and by the corresponding element in the claim.

The claimed element that the equivalent replaces is defined in the claim by its structure. Its function is covered by the patent if a claim defining this element by its function [means for achieving the function] would also have been valid.

III. APPLICATION OF THE DOCTRINE OF EQUIVALENTS

Considering a patent claim comprising features A, B, C and D and an allegedly infringing product or method comprising features A, B, C and D', feature D' having a form or a structure which is different from feature D, deciding on infringement by equivalence will consist in establishing whether feature D' is a technical equivalent as defined above and whether the patent covers feature D, not only in its form but also in its function.

1. Is feature D' a technical equivalent?

In this respect, the main issue is to check that feature D' has the same function as feature D which it replaces in the allegedly infringing product or method.

The function of an element is its direct technical effect; the function is not the global result of the invention. Indeed, whereas a result cannot be patented, the technical means for obtaining a result can be. The technical means may however be defined with a wording such as "means for carrying out a given function" (functional wording of the claims).

Deciding on an alleged infringement by equivalence, the Court of Appeal of Paris noted that "the direct technical effect and the result are different" (Transagra vs. Aerograin; February 8 1994).

In an other case, the same Court of Appeal indicated that "the technical result shall not be taken into consideration" for studying a possible infringement by equivalence [Bennes Saphem vs. Guima and Paris Sud Hydraulique; December 1st, 1998).

Determining the function of a given means is more a practical question than a theoretical one. In cases of alleged infringement by equivalence, debates often focus on this issue.

In Re Moulinex vs. Seb (Court of Appeal of Paris, December 1, 1992), the Court stated that there was no infringement by équivalence since the function foreseen in the patent was not achieved by the allegedly infringing object.

In the latter case, the patent was directed to an electric fryer comprising a metal vessel surrounded by a plastics skirt spaced from the vessel by a layer of air, so that the skirt did not reach as a high temperature as the vessel in order for the user to be able to touch the fryer without contacting hot parts.

According to the invention, the connection between the skirt and the vessel was made by means of a ring which closed the air-filled space between the skirt and the vessel.

The allegedly infringing fryer had its skirt connected to the vessel by means of a series of links which did not constitute a continuous ring.

The Court stated:

"Two means are considered as equivalent means when, although they have a different form, they achieve the same function in view of a similar result.

In the present case, the means are different and they do not achieve the same function. In the patent, the ring made of a heat insulating material closes the air space defined between the vessel and the skirt, and prevents any air circulation.

In the allegedly infringing fryer, [...] the air can circulate between the vessel and the skirt. Consequently, claim 1 of the patent is not infringed."

2. Does the patent cover the function of feature D?

The patent claims a product or a method comprising features A, B, C and D. One can consider that the patent covers the function of feature D if a product or a method comprising features A, B, C and "means for achieving the function of feature D" instead of feature D itself would have been patentable at the time the patent was filed.

If the prior art shows that means, associated with features A, B and C, were already known which carry out the same function as feature D to provide a similar result, then there cannot be any infringement by equivalence. Indeed, the claim may then only cover a product or a method incorporating feature D in its particular form or structure (as literally defined in the claim) and the scope of the claim cannot be extended to cover a product or a method comprising, instead of particular feature D, any element having the same function.

In *Re Bennes Saphem vs. Guima and Paris Sud Hydraulique* (mentioned above), the Court stated as follows:

"Considering that an invention is characterised by its form, by the way it is applied and by its function, when the function of the means in question is not new and when, by way of consequence, the patent does not cover such function, then a means having a different implementation form than the claimed means and carrying out the same function as this claimed means cannot constitute an infringement by equivalence, the result not having to be taken into consideration".

This case was submitted to the Supreme Court (Cour de Cassation, December 4, 1990), which declared:

"A decision has rightfully dismissed an allegation of infringement by equivalence, having stated that the combination of means of the invention carries out a known function and that the patent covered this combination in its form only, and having checked that the alleged infringing device, although having the same function, had a structure different from the one claimed by the patent".

In Re. Duthoit and Coopérative Ouvrière de Production Agricole vs. Ruffié, the Supreme Court (Cour de Cassation, March 31, 2004) confirmed this appreciation while stating that, for an infringement by equivalence to be acknowledged, the function achieved by the technical equivalent must be new and inventive.

IV.SOME PECULIARITIES OF THE FRENCH APPROACH

1. Improvements

According to French Patent Law, a product or a method may infringe a patent regardless of whether it constitutes an improvement to the patented invention.

This conforms with the provision of Article L.613-15 of the Law, which states that the owner of a patent concerning an improvement of an invention already patented on behalf of another person may, under certain conditions, obtain a license to the extent necessary for working his invention, as far as the improvement represents substantial technical progress and economical interest in relation to the prior patent.

In a situation of an alleged infringement by equivalence, it may happen that feature D' which is substituted for feature D represents a technical improvement with respect to the claimed invention.

Existence of such an improvement shall not prevent the Court from stating in favour of infringement and there is no requirement that the equivalent means be obvious or readily at the disposal of the skilled man, for infringement by equivalence to be acknowledged in France.

In Re Shellag Estates vs. Laloyeau and Transport Système France (Tribunal de Grande Instance de Paris, 3è Ch., September 21, 1984), the Paris Court of First Instance indeed stated:

"The fact that the sliding system [of the infringing device] is more complex [than the system of the patent] and that the tensioning system of the vertical straps is simultaneous [which was not the case with the invention, in which sliding and tensioning were operated separately] is not to be considered; these are improvements lying within the dependency of the invention."

This consideration led the Court to consider that the patent was infringed.

2. Essential constitutive elements

A French patent is infringed if the essential constitutive elements of the patented invention are reproduced.

The essential constitutive elements of the invention are those claimed means which, when considered together, are new and inventive in view of the prior art and which are necessary for the invention to solve the technical problem.

These elements are deemed essential from a technical and a functional point of view.

The Supreme Court has stated that a Court of Appeal had conformed to the Law on Patents when it had extracted the essential constitutive elements of the invention defined by the claims and given them their complete significance (Cour de Cassation, January 3, 1985).

On this basis, some very minor features which do not provide a specific technical effect can be disregarded while stating on infringement, which means that the patent can be infringed by a product or a method missing a minor feature or comprising a minor modification with respect to the patented product or method.

According to the doctrine of equivalents, an equivalent means is technically equivalent to an essential constitutive element of the invention. It is neither a minor modification nor related to a minor feature.

V. INFRINGEMENT BY EQUIVALENCE UNDER THE EUROPEAN PATENT CONVENTION

Article L.613-2 of the French Law on Patents and Article 69 of the European Patent Convention both state: "The scope of a patent is determined by the content of the claims. However, the description and the drawings serve to interpret the claims."

The EPC contains a Protocol on the Interpretation of Article 69, which aims at providing some guidelines for the application of Article 69 and for its transposition into the national laws of the Contracting States.

The Protocol, as amended in the EPC2000, comprises two articles.

Article 1 states that the claim interpretation has to be conducted as a reasonable compromise between a first extreme position which would consist in considering that the description and the drawings may be used only for the purpose of resolving a possible ambiguity found in the claims and a second extreme position which would consist in considering that the claims serve only as a guideline and that the actual protection may extend to what the patentee may have contemplated, based upon the description and the drawings.

Clearly, the doctrine of infringement by equivalence calls for an interpretation of the claims which is a compromise and according to which the description and the drawings serve to define the function of the means as claimed by the patentee.

Article 2 is indeed directed to equivalents, mentioning:

"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."

This was the result of a compromise, since the participants at the Diplomatic Conference preparing the EPC2000 could not agree on a common definition of a technical equivalent. A proposal stating that "a means shall generally be considered as being 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" was not adopted.

Article 2 of the Protocol does not seem to have an impact on Court decisions.



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