

QUESTION 175

The role of equivalents and prosecution history in defining the scope of patent protection

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Q175

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Resolution

AIPPI

Considering that:

- Uniform interpretation of claims is a desirable part of patent harmonisation;
- The WIPO Standing Committee on Patents is seeking common ground for future harmonisation in substantive patent matters;
- However, these discussions at WIPO do not give hope for a common understanding leading to a Substantive Patent Law Treaty in the near future;
- The Diplomatic Conference for the revision of the European Patent Convention in 2000 introduced language on equivalents into the Protocol on the Interpretation of Article 69 EPC;
- However, the delegates to the Diplomatic Conference did not agree on either a definition of equivalents or on the role of prosecution history for the determination of scope of claims.

Noting that:

In most countries the protection conferred by a patent may be broader than the literal wording of the claims (whether described as "equivalents" or by other approaches to interpretation in a "non-literal" manner) and harmonisation of the national approaches seems possible, since they point in the same direction.

Resolves:

1. Claims should be interpreted to give fair protection to the patentee while preserving reasonable certainty for third parties.
2. Protection should not be limited to the strict literal meaning of words used in the claims, nor should the claims serve only as a guideline.
3. In determining the scope of protection conferred by a patent claim, due account shall be taken of any element which is equivalent to an element specified in that claim.
4. An element shall be regarded as equivalent to an element in a claim, if, in the context of the claimed invention:
 - a) the element under consideration performs substantially the same function to produce substantially the same result as the claimed element; and
 - 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.
5. Notwithstanding that an element is regarded as an equivalent, the scope of protection conferred by a patent claim shall not cover the equivalent if:
 - a) a person skilled in the art would at the filing date (or where applicable the priority date) have understood it, from the description, drawings and the claims, to be excluded from the scope of protection, or
 - b) as a result the claim covers the prior art or that which is obvious over the prior art, or
 - c) the patentee expressly and unambiguously excluded it from the claim during prosecution of that patent to overcome a prior art objection.