Spain
Espagne
Spanien

Report Q175

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

Questions

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?**

   It cannot be asserted that Spain has an elaborated doctrine of equivalents. However, the doctrine of equivalents has been dealt with in the Spanish specialist literature and is generally considered applicable in patent infringement cases heard by Spanish courts.

   In 1986 there began in Spain a new patent system based on the European Patent Convention (EPC) and a new Spanish Patent Law (PL), the latter ruling the granting of national patents and utility models (hereinafter jointly referred as "national patents"). Since then, "equivalents" have been mentioned only in very few patent infringement decisions (none from the Supreme Court), and always without reference to the Protocol on the Interpretation of Article 69 EPC, which is the only legal text in force in Spain which provides the guidelines for a non-literal interpretation of claims.

   Currently, European patents represent about 70% of the approximately 17,000 new industrial property titles granted every year to protect inventions in Spain. Concerning scope (or extent) of protection, the PL is also applicable to national patents granted under the previous law, the Industrial Property Statue (IPS). Since Article 60.1 PL parallels Article 69.1 EPC, by statute the scope of protection of all Spanish patents, both national and European, is determined by the claims, and description and drawings must used when interpreting said claims. Besides, Article 26 PL parallels Article 84 EPC, both stating that the claims define the matter for which protection is sought. Finally, according to Rule 29.1 EPC and Article 7.1 of the PL Implementing Regulations, the claims define the matter for which protection is sought in terms of a combination of technical features or elements (simply "elements" hereinafter). Although the Spanish PL has not explicitly incorporated the Protocol on the Interpretation of Article 69 EPC, all specialists who have published on the doctrine of equivalents agree that the Protocol should be considered applicable also to national patents, because it would be natural that the scope of protection of all Spanish patents was determined in the same way regardless of the granting office.

   As Spanish courts are bound by the legal texts summarised in the previous paragraph, the wording of the claims -including all their elements- should be not only the starting
point but also the decisive basis to determine the scope of protection. However, in most judicial practice this is not the case, partially because of the lack of specialisation among Spanish courts dealing with patent infringement at any instance. Among the relatively small number of post-1986 judicial decisions on patent infringement in Spain, very few mention Article 60.1 PL, and virtually none determines the infringement by assessment of the scope of protection through an element-by-element analysis of the claims, and a comparison with the elements in the alleged infringing embodiment, in order to decide whether this embodiment falls within that assessed scope. Actually, most Spanish judicial decisions are still based on some sort of "doctrine of essence"; i.e. the presence or absence of "essential differences" between the patented invention and the accused embodiment. This is understood to imply that there is an essential difference when the modification/elimination affects an element of the patent that is essential rather than one that is secondary or complementary. The presence or absence of essential differences is decided by the judge taking into account the (often contradictory) opinions of expert witnesses as to which elements of the invention would have been considered essential by a person skilled in the art, and which would have been considered secondary, without needing to abide by the wording of the claims. Judgements based on such a doctrine of essence, with different formulations, have been made in Spanish case law, mainly in the context of patentability cases, but rarely in patent infringement cases. Besides, in most decisions on infringement, only classical (literal) infringement has been considered. It is only a short time ago that infringement under the doctrine of equivalents has been argued before Spanish courts.

The doctrine of essence was mainly based on two articles about patentability in the Spanish Industrial Property Statute (IPS) of 1929, namely: Article 46 IPS, which states: "Any improvement to modify the essential conditions of a process can be patented..."; and Article 48.3 IPS: "Changes in shape, size, proportion and materials of the patented object cannot be patented, unless said change essentially modifies the quality of the object, or its use involves a new result." The patent-related part of this Law, including these two articles, was repealed in 1986. Thus, it is not surprising that, despite being an everyday judicial practice, some Spanish commentators have recently considered that the doctrine of essence is contrary to the Spanish and the European patent systems and that it stands against the general trend (in EPC countries and in the US), according to which claims are to be interpreted on an element-by-element basis, and all elements (as such or as equivalents) must be present in the infringing embodiment. Besides, it is difficult to understand how the doctrine of essence could be compatible with the incoming principle that "for the purpose of determining the extent of protection conferred by a patent, due account shall be taken of any element which is equivalent to an element specified in the claims" (new Article 2 -Equivalents- of the Protocol on the Interpretation of Article 69 EPC; not yet in force).

Equivalents defined as "variants of shape, material, size, element position and even replacement of elements by others, when it is not altered the fundamental principle of the invention disclosed, claimed and protected by the patent or the utility model" were mentioned in a Supreme Court decision of 1968 (Third Section, 10.06.1968), in the context of assessing the patentability of a utility model in an *ex parte case* (note that the wording of the decision was very similar to that of the old Article 48.3 IPS mentioned above). One of the very few Spanish courts that is partially specialised in patent cases, Section 15 of the Barcelona Court of Second Instance, issued on 18.09.2000 a decision in which the absence of literal infringement was decided on the basis of an essential difference between the patented process and the questioned one. However, judges cited *obiter dictum* the above-mentioned Supreme Court decision of 1968 as well as the concept of "equivalent means" as "means that, despite having different embodiments, fulfilled the same function
"with regard to the same result", a definition taken from a fragment of a Boards of Appeal (BA) decision (T 697/92, unpublished in the Official Journal), cited under the heading "Equivalents" in the chapter "Patentability-Inventive step" of the last three editions of the book "Case Law of the BA of the EPO". It is worth noting that such unpublished BA decision mentioned *obiter dictum* the definition of "equivalent means" taken from the chapter on patentability of a 1974 book by the French author Paul Mathely ("Le droit français des brevets d'invention", p. 63), in the context of assessing the inventive step of an invention.

Given the scarcity of Spanish case law and tradition on the doctrine of equivalents for infringement purposes, the above-mentioned 2000 decision of the Barcelona Court of Second Instance has been cited since then in several judicial decisions of first and second instance, and in some specialist writings, despite the fact that the two cited definitions of equivalents refer to patentability and not to infringement. Several commentators consider that the important conclusion derived from all these decisions is that the doctrine of equivalents is applicable in Spain. But it cannot be said that there is any basis to justify either an approach to equivalents based on a double identity (bearing in mind function and result) similar to that traditionally adopted in France, or an approach based on a triple identity (bearing in mind function, way and result) similar to that traditionally adopted in the USA.

Very recently a series of lawsuits based on the same chemical patents have begun in several courts, arguing patent infringement only under the doctrine of equivalents, and not literal infringement. Up to this day, only judicial decisions of first instance have been issued. One of them (Barcelona Court of First Instance nº 37, 10.09.2002) addresses the issue of the doctrine of equivalents in a modern way, and refers to the new Article 2 of the Protocol on the Interpretation of Article 69 EPC. This decision is in favour of an obvious equivalents approach, similar to the current one in German courts, and against an approach based on a triple identity (function, way, result).

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)?**

   The first instance decision referred to at the end of the previous paragraph is the only decision addressing this issue so far. In that specific case the court considered that the relevant date for the skilled person to assess the issue of equivalents was the application date; but to this day no general consensus on this matter has emerged in Spain.

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?**

   In Spain there are no patent infringement judicial decisions in which a "prosecution history" or "file wrapper" has explicitly been crucial for the decision. However, most Spanish specialists believe that all waivers and limitations made before patent offices, as well as any other act made by the applicant, can be alleged before a Spanish court in order to assess the scope of patent protection. This is so because in Spain there is a principle of law known as "doctrine of own acts", according to which no one can contradict his or her own acts (*venire contra factum proprium*); i.e. no one is allowed to ignore or deny his own acts, or the consequences thereof, and claim a right in opposition to such acts or consequences. In fact, this doctrine (hereinafter "doctrine of estoppel") is very similar to the "estoppel" common-law principle.

   As a general legal principle, the doctrine of estoppel can and should be taken into account in industrial property proceedings. In fact, said principle has been applied
in proceedings related to industrial property, and the Supreme Court has had the opportunity of making pronouncements on its acceptance or dismissal in several of its judgements related to trademarks and trade names.

The Supreme Court has construed the estoppel stating that the rule "nemine licet adversus sua facta venire" is based on the good faith and the protection of the trustfulness that the actions produce. Because of this, such actions must be binding, having legal status and intended to create, define, modify, extinguish or clarify a right, and they cannot be ambiguous, but formal acts.

None of the Supreme Court decisions has explicitly referred to the prosecution history of a patent. However, in view of the legal principle that prevents someone from acting against his own acts, it is understood that the prosecution history of a patent should be taken into account to assess the scope of its protection.

According to this doctrine, if the applicant for a patent made any statement capable of limiting the scope of the claimed subject-matter of such a patent during its prosecution, either expressly excluding some of the features initially claimed or specifying the elements specially claimed, for the purpose of avoiding possible objections to the granting of the patent, in principle the applicant should not be allowed to allege, at a later date, that those elements that he or she specially disclaimed or waived constitute an infringement of such patent.

According to the above, although a concept of "file wrapper estoppel" as legal and automatic preclusion based on the prosecution history does not exist, it can be stated that, on the basis of the doctrine of estoppel, one could argue that the patentee has no right to extend the claimed subject-matter to elements that, being potentially equivalent to those claimed in the patent, were (either explicitly or implicitly) excluded from the patent scope during prosecution in order to overcome obstacles of lack of novelty or inventive step.

Therefore, for the purpose of assessing the protection scope of a Spanish patent, an applicant's actions made before foreign patent offices and referred to patents with the same priority may be important, especially when made before patent offices of countries with a similar patent system.

b) Is there a difference between formal (e.g. oppositions) and informal (e.g. discussions with examiners) actions in the patent office?

Spanish law does not recognise the notion of "informal actions", and all the documents in the file are considered to be "formal". For the purpose of application of the doctrine of estoppel, the documents within the file, as formal actions made by the applicant, can be used to oppose a claim for patent infringement.

For that purpose it will be necessary that such actions fulfil the requirements established by case law for the doctrine of estoppel; i.e. said actions must be unequivocal in the sense of creating, defining, modifying, extinguishing or clarifying without any doubt a specific legal situation which affects their author, and also there must be a contradiction between the prior action and the subsequent demand of the patentee. The application of this doctrine would be consistent with the patent case law in countries like Germany.

c) Is there a difference between actions taken by the patent office and by third parties?

Although there is no case law about this in Spain, for the purpose of the doctrine of estoppel it should be irrelevant whether the statements were made as a consequence of objections raised by the patent office or by any third party. It is only
required that the actions are unequivocal and that the subsequent claim of the patentee against any third party is inconsistent with said prior actions. The justification for this is that the aim of the Law is not only to guarantee fair protection for the patentee but also to offer a reasonable certainty for third parties as to the scope of patent protection, in accordance with the principle of legal certainty, as it is reflected in the Protocol on the Interpretation of Article 69 EPC.

4. *Is there any way the scope of claims can be limited outside prosecution, e.g. by estoppel or admissions?*

According to the principle by virtue of which nobody can contradict his own acts, it can be stated that any unequivocal admission made by the patentee in the sense of limiting the scope of the patent could be taken into account when assessing the protection scope of said patent, even if such admission is not reflected in its prosecution. For example, statements or admissions by the patentee could be taken into account when made to limit the patent scope in order to overcome a nullity objection.

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

We recommend that the AIPPI supports the following ideas or actions:

- No additional legislation is necessary to interpret the scope of patent protection by courts. However, it would be convenient for the Spanish parliament to modify the Spanish Patent Law (PL) by including a direct reference to the applicability of the Protocol on the Interpretation of Article 69 EPC to national patents and utility models. For as long as this modification of the Spanish PL does not occur, it would be highly desirable for Spanish case law to recognise such applicability of the Protocol to the above-mentioned national industrial property titles.

- All EPC member states should ratify as soon as possible the Revision of the EPC approved in the Diplomatic Conference of 2000, so that the amendments of Article 69 and the Protocol on the Interpretation of Article 69 may come into force.

- Both in relation to European patents and to national patents, it would be convenient to establish a uniform approach to the non-literal (i.e. by equivalency) construction of patent claims for all EPC countries.

- As it is recognised in several judicial decisions of German and British courts, deep down the obvious equivalents approach as currently applied by German courts (according to the teaching of the patent, according to his common general knowledge, and according to his interpretation of applicant’s purposes at claim drafting, the person skilled in the art would have considered that the equivalent element was an obvious alternative to the claimed element, to obtain a similar result to the same technical problem) and the approach as currently applied by British courts (based on the answers to the famous three Catnic/Improver questions, now referred to as the "Protocol questions"), are consistent with the Protocol on Interpretation of Article 69 EPC, including its recently added Article 2. Therefore, these two deep down coincident approaches should form the basis for reaching uniform standards of claim interpretation by equivalency in all EPC countries.

- An applicant-accepted limitation derived from a suggestion made by any patent office (PCT, European, or national) that participates in the granting proceedings of a patent, or an unambiguous waiver made by the applicant during the corresponding proceedings, should be taken into account by the court when assessing the protective scope of the patent.
Résumé

On ne peut pas affirmer que l'Espagne ait une doctrine des équivalents élaborée. Cependant, la doctrine des équivalents a été traitée par la doctrine scientifique espagnole et elle est considérée applicable en Espagne, étant donné que les articles pertinents de la Loi de Brevets (LB) sont parallèles à ceux correspondants à la Convention sur le Brevet Européen (CBE) et, bien que la LB n'en fasse pas mention, le Protocole Interprétatif de l'Art. 69 CBE est considéré applicable aux brevets et aux modèles d'utilité nationaux.

L'approche aux équivalents par évidence telle qu'elle est appliquée actuellement dans les tribunaux allemands est très proche dans le fond à celle appliquée dans les tribunaux britanniques. Les deux sont cohérentes avec le Protocole et doivent être prises comme un standard d'interprétation des revendications par équivalence dans tous les pays de la CBE. Il doit être ainsi particulièrement en Espagne, où encore aujourd'hui on utilise une espèce de "doctrine de l'essence" que les commentaires les plus récents considèrent contraire au système de brevets actuel.

Zusammenfassung

Es kann nicht behauptet werden, dass es in Spanien eine ausgearbeitete Doktrin der Äquivalenzen gibt. Die Äquivalenzdoktrin wurde nichtsdestotrotz von der wissenschaftlichen spanischen Doktrin behandelt, die als in Spanien anwendbar gilt, da die entsprechenden Artikel des spanischen Patentgesetzes (LP) parallel zu den entsprechenden Artikeln des Europäischen Patentübereinkommens (EPÜ) gestaltet sind. Und auch wenn das LP dies nicht erwähnt, so kann doch auch das Protokoll zur Auslegung des Art. 69 EPÜ als für Patente und nationalen Gebrauchsmustern als anwendbar gelten.


In Spanien gibt es keine Gerichtsentscheidungen aufgrund von Patentverletzungen, in denen die Gesichtspunkte des Erteilungsverfahrens ausdrücklich entscheidend in der Urteilsfindung wäre. Trotzdem ist man der Auffassung, dass alle Verzichte und Beschränkungen, die vor den Patentämtern getätigt werden, sowie jede weitere eigene Handlung des Antragstellers, bei einem spanischen Gericht angeführt werden kann, um den Umfang des Patentschutzes festzulegen. Dies ist deshalb so, weil es in Spanien das allgemeine Prinzip, das unter dem Namen "Doktrin des eigenen Verhaltens" (venire contra factum proprium) gibt, gemäss welchem es niemanden
gestattet ist, seine eigenes Verhalten bzw. die Konsequenzen desselben zu ignorieren oder zu verleugnen, und ein Recht zu beanspruchen, das diesem Verhalten bzw. den Konsequenzen widerspricht.