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?*

Under UK patent law, the scope of protection afforded by a claim is a matter of statute as interpreted by the courts.

Section 125(1) of the Patents Act 1977 (which is the counterpart to Article 69 of the European Patent Convention (the EPC)) provides that "for the purposes of this Act an invention for a patent … shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification … as interpreted by the description and any drawings contained in that specification …".

Section 125(3) requires that the claim be interpreted in accordance with the Protocol on interpretation of Article 69 of the EPC. The Protocol provides as follows:

> Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.

In applying the Protocol the English courts recognise that the Protocol outlaws both a strict literal interpretation and a liberal interpretation using the claims merely as a guideline. They consider that the correct approach is to achieve a position between those extremes, but the language of the claims cannot be disregarded. The terms of a claim must be interpreted through the eyes of the skilled addressee. The court must ascertain what meaning the words were intended to convey.

As an aid to this exercise the Court of Appeal relies heavily on the approach established by the House of Lords in *Catnic v Hill & Smith* [1982] RPC 183. The Court emphasised
that in a patent specification the patentee addresses those skilled in the art and informs them of what he claims to be the essential features of the new product or process concerned. In determining what these essential features are, the specification must be given a "purposive" construction, rather than a purely literal one. It must be asked whether the skilled addressee would understand that the patentee intended as an essential requirement of the invention that there must be strict compliance with a particular descriptive word or phrase appearing in a claim such that any variant would fall outside the monopoly claimed, even though it would have no material effect on the way the invention worked.

The Court said that the question did not arise where the variant would in fact have a material effect on the way the invention worked.

Nor would it arise unless at the date of publication of the specification it would be obvious to the skilled reader that this was so. Where it would not have been obvious in the light of the existing knowledge the reader is entitled to assume that the patentee intended to limit his monopoly.

This was later formulated into 3 separate questions by the Patents Court in Improver v Remington [1990] FSR 181. Although based on a decision under the UK Patents Act 1949, pre-dating the Patents Act 1977 and the incorporation of the Protocol, these so-called "Improver questions" have been adopted by the Court of Appeal as an aid to the application of the Protocol. It now calls them the "Protocol questions" (Wheatley (Davina) v. Drillsafe Ltd [2001] RPC 7).

To put this approach and the questions in context, the English courts have said that there is no independent "doctrine of equivalents" in UK patent law but that "in the end the question is always whether the alleged infringement is covered by the language of the claim" (Improver v Remington (supra)). The scope of protection must be based on the language of the claims. The question to be asked is whether the alleged infringement is one which the skilled man would have regarded as being "within the ambit of the language" of the claim. (Anchor Building Products v. Redland Roof Tiles [1990] RPC 283).

The "Improver" or "Protocol" questions are formulated as follows:

1.1 Does the variant have a material effect on the way the invention works? If yes, the variant is outside the claim. If no -

1.2 Would this (i.e. the fact that the variant has no material effect) have been obvious at the date of publication of the patent to a person skilled in the art? If no, the variant is outside the claim. If yes -

1.3 Would the reader skilled in the art nevertheless have 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 claims. If no, the variant infringes.

The first two questions are questions of fact. Note in relation to the second question that it is not whether the variant is an obvious alternative to the thing denoted by the literal meaning. The question presupposes that the skilled man is told of both the invention and the variant and asked whether the variant would obviously work in the same way. The level of "obviousness" in this context as applied by the Courts goes far beyond what we are used to in the context of assessing inventiveness. The Courts require that it be clear or apparent, just by looking at the variant, that it will work in the same way as the invention. It is not enough even for it to be highly likely that it will work if the variant needs to be tested to make sure (see American Home Products v. Novartis Pharmaceuticals UK Ltd [2002] RPC 8). The Court of Appeal has also held that all the skilled man is entitled
to know is what the variant is. He cannot be told that the variant works. This very strict approach limits the application of the rules for chemical and biological inventions. It is very seldom that it will be immediately apparent simply by looking at, say, a chemical or biological material, that it will work. There will always be a chance that even a slight change will result in a loss of activity.

There is some controversy as to what is the relevant date for assessing question 2. In the Catnic case the House of Lords said it is the date of publication and this was confirmed relatively recently by the Court of Appeal ([Sarah Lee v. Johnson Wax (CA 20/11/2001, unreported). However, in McGhan Medical UK Ltd v. Nagor Ltd & Anor. (Patents Court, 28/02/2001, unreported) Fysh QC sitting as deputy judge suggested that the patent as granted should be construed as at the application date (since that is also the date for assessing sufficiency).

Question 3 is a question of construction and is the key question. What would the skilled reader have understood to be the patentee's intention from the words used? Although the court has said that it must adopt the mantle of the skilled person in coming to this decision it has traditionally jealously guarded for itself the prerogative of construing the claim. It will commonly reject as inadmissible evidence by an expert witness as to how a skilled person would have read the claim (although it is nevertheless sensible in practice to lead evidence by an expert explaining how the skilled addressee would have understood the words used and the patentee's intention and why).

Although the Protocol predominates and the "Protocol Questions" have been described by the Court of Appeal as an "aid", they have in a series of cases come to be treated as decisive. See for example:

- Wheatley (Davina) v. Drillsafe Ltd [2001] RPC 7
- Amersham Pharmacia Biotech AB v. Amicon Ltd [2001] IPD 24078
- Dyson Appliances Ltd v. Hoover Ltd [2002] RPC 8
- Sara Lee Household & Body Care Ltd v. Johnson Wax Ltd [2002] IPD 25008
- Kirin Amgen Inc. v. Transkaryotic Therapies Inc (previously Roche Diagnostics GmbH) [2002] RPC 1 (Neuberger J), [2003] RPC 3 (CA)
- Macaferri v. Hesco Bastion (CA, 7 March 2002, unreported)
- City Technology v. Alphasense Limited (2002) 25(6) IPD (CA)

In one recent pharmaceutical case (Pharmacia Corporation and Others v. Merck [2002] RPC 41) the Court of Appeal did however relax this approach. It recognised that although the Protocol questions "are normally a useful tool to arrive at the middle ground required by the Protocol", this was a case where "the difficulties in application outweigh the advantages" and the Protocol questions could not be used "without modification". The wording used in the claim was clear and unambiguous - it had a "precise chemical meaning". Its meaning could not under the Improver tests be "stretched" to cover the alleged infringement. So the tests failed. Nevertheless, the Court considered the "effect" of the words on the skilled person, and applying the balancing act required of the Protocol by consideration of the respective positions of the patentee and third parties found infringement. It decided that it would in all the circumstances be unfair to deprive the patentee of protection and there was sufficient certainty for third parties.
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 scope of patent protection does not change in time. According to our courts' current approach (see above) the assessment of infringement is at the publication date (Catnic).

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?**

   There is no recognised doctrine of "file wrapper estoppel" in UK patent law. Furthermore, the current English patent judges, at least, are strongly opposed to any such doctrine. However (as observed in the working guidelines to this question) the English Court of Appeal has recently suggested that there is no reason why in principle statements made in the prosecution history could not be helpful to resolve an ambiguity (Rohm & Haas Co v Collag [2002] FSR 28).

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

   In the absence of any doctrine generally, this is not an issue.

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

   It is not clear what is meant here. What sort of actions by third parties? In any case once again in the absence of any English doctrine of "file wrapper estoppel", no issue arises.

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

   The UK recognises a general concept of estoppel. The courts will deny relief where in all the circumstances it is "unconscionable" that the claimant should be entitled to the relief sought. For example mere delay in instituting infringement proceedings would not normally prejudice the patentee. However, if by his words or action the patentee led the alleged infringer to believe that he would not be sued the court could well later decide to refuse relief on the ground that it would be "unconscionable" to allow the patentee relief. This however would of course only apply inter partes and would not affect the scope in general of any claim (unless perhaps the patentee had adopted a public position and lulled third parties into believing that they were safe, and later sought relief).

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

   5.1 **Approach to Claim Construction**

   The purpose of the Protocol is to achieve in Europe a harmonised middle ground for determining the scope of patent protection between a strict literal reading of the wording used in the claims (a caricature of the traditional UK approach) and a broader inquiry as to what the patentee must have contemplated, the claims serving only as a guideline (a caricature of the traditional German approach). While there is still some way to go, the Protocol has indeed achieved some convergence in the approach of the different European national courts and the trend continues. AIPPI UK believes that the general principle (of seeking the "middle ground") laid down in the Protocol is sensible and could be a useful model to adopt internationally.
Guidance is desirable, however, as to the correct approach courts should take to apply the Protocol and this should be consistent. Currently in Europe, different approaches are still sometimes taken by the different courts, and this may lead to different results. Indeed, different judges in the same court sometimes reach different findings, even when purporting to apply the same approach.

It is not obvious that any one approach is better than another. However, AIPPI UK believes that the UK “Protocol questions” have served as useful guidelines, and could provide useful models for harmonisation provided that they are not too rigidly applied and subject to some refinements (discussed below). Approaches similar to the third Protocol question have recently been adopted in other European jurisdictions, for example by the Court of Appeal of Milan in its judgment in June 2000 (Forel Spa v. Lisec) and, more recently, by the German Federal Supreme Court in its combined judgments of 12 March 2002 (IIC Vol 33 p 873 at p 876-7).

The availability of guides like the Protocol questions assists parties and their legal advisers to assess without recourse to the courts whether a product or process is likely to infringe.

Any guidelines adopted need to be applied with some flexibility, while retaining sufficient certainty for third parties. It must not be forgotten that the Protocol dominates and that guides like the Protocol questions are mere aids and not decisive. There are cases (as the English Court of Appeal has now demonstrated) where the Protocol questions do not give the right answer and the court must substitute its own.

Furthermore, some refinement of the way in which the questions have been applied so far in the UK is required.

In particular, in relation to the second question, AIPPI UK believes that it should be enough to satisfy the requirement that an immaterial variant is “obviously” so if it would have been apparent that it was highly likely that the particular variant would have no material effect on the way the invention works and simple tests could have been performed to confirm this. To put the test higher requires certainty and potentially excludes variants from protection in most chemical and biological cases. The Protocol after all requires reasonable certainty for third parties, not absolute certainty.

In applying the third Protocol question, AIPPI believes that it should be assumed that the patentee intended to cover obviously immaterial variants unless it is clear from the specification that he did not. The UK courts currently tend to require that the relevant term or terms in a claim must be descriptive or otherwise capable of being “stretched” in meaning to cover the obviously immaterial variant concerned.

### 5.2 Date for assessing infringement

The UK Protocol questions presuppose that the date for assessing infringement is the publication date. In the second Protocol question, the skilled person is given the variant and asked whether, in the light of the common general knowledge at the publication date, it would have been obvious that the variant would not materially effect the way the invention works. This therefore allows for future developments not contemplated at the publication date to be covered. If (as has been suggested as discussed above) the date were the filing date the Protocol questions would work equally well. If, as in the US, infringement were assessed at the date of infringement the Protocol questions would need appropriate modification (without detracting from the application generally of the approach dictated by the Protocol).
5.3 File Wrapper Estoppel

AIPPI UK does not favour introduction of a formal doctrine of file wrapper estoppel. The patent specification and claims should be read as they stand and construed accordingly.

Complete harmonisation of the law in this area can and will however not be achieved through application of a strict statutory formula. Harmonisation can only be achieved through a consistent approach of the judiciary which retains some flexibility to ensure that the fair balance is achieved in each case. Such a consistent approach may in Europe be achieved one day through the creation of a single court (e.g. the CPC). Meanwhile judges should be encouraged to continue to consult with one another, and to take into account the need for harmonisation and consistency in Europe in their approaches. Seeking harmony internationally beyond Europe will require moves to greater harmony in claim drafting, examination and judicial practices generally.

Summary

UK patent law provides for protection of "equivalents" by requiring claims to be interpreted in accordance with the Protocol on interpretation of Article 69 of the EPC. As an aid, the UK courts ask three "Protocol questions", derived from the House of Lords case, *Catnic v. Hill & Smith*. AIPPI UK believes that the Protocol could be a useful model to adopt internationally. Guidance is desirable on the correct approach to applying the Protocol. AIPPI UK believes that the UK's Protocol questions could provide useful models for harmonisation provided that they are not too rigidly applied and subject to some refinements. The Protocol questions presuppose that the date for assessment is the publication date, possibly the filing date. AIPPI UK does not favour introduction of a formal doctrine of file wrapper estoppel.

Résumé

Le droit des brevets du Royaume Uni prévoit une protection des "équivalents" en exigeant que les brevets soient interprétés en accord avec le Protocole sur l'interprétation de l'Article 69 de la CBE. Pour y aider, les tribunaux du Royaume Uni posent trois "questions de Protocole", provenant de l'affaire *Catnic v. Hill & Smith* de la Chambre des Communes. Au Royaume Uni, l'AIPPI estime que le Protocole pourrait représenter un modèle utile qu'il serait bon d'adopter au niveau international. Il est désiriable que des conseils soient offerts quant à la manière exacte d'appliquer le Protocole. Au Royaume Uni, l'AIPPI pense que les questions de Protocole du Royaume Uni pourraient fournir un modèle d'harmonisation utile, pourvu qu'elles ne soient pas appliquées trop rigoureusement et qu'elles fassent l'objet de quelques perfections. Les questions de Protocole présupposent que la date d'évaluation est la date de publication, ou éventuellement, la date de dépôt. Au Royaume Uni, l'AIPPI n'est pas en faveur de l'introduction d'une doctrine formelle de l'estoppel.

Zusammenfassung

UK meint, daß die britischen Protokollfragen bei der Harmonisierung als nützliches Modell gelten könnten, sofern sie nicht zu eng angewendet und an einigen Stellen ausgefeilt werden. Die Protokollfragen gehen davon aus, daß das Datum der Veröffentlichung, oder das Datum der Ertellung bei der Prüfung ausschlaggebend ist. Die AIPPI UK ist nicht für die Einführung einer formellen Doktrin des "File Wrapper Estoppel".