

Doctrine of Equivalence (DoE)

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Intellectual Property Practice

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- A device will infringe the claims of a patent if it “performs substantially the same function in substantially the same way to obtain the same result”

Not a statutory provision in the Patent Law, rather a set of rules established by a series of cases wherein the courts decided infringement

What constitutes 'Equivalence'

What, how and when is an element equivalent to a "term" in a patent claim is a matter of National Patent Law

Cannot be defined by a 'formula' and is also not an absolute to be considered in vacuum

Must be determined against the context of the patent, the prior art and the particular circumstances of the case.

"Thereby"

"Function-way-result-test"

does the allegedly equivalent measure perform the same function and achieve the same result in the same way as the measure in the claim also and how important the substitution or the omission is to the claims

Claim needs to be tested 'element by element'

Example:

Cloaks without fastening mechanisms are available. Cloaks whose left and right side cannot be connected together.

- 1. (A) - invents a button to allow the sides of a cloak to be held together.**

“A cloak with a front opening, a row of fasteners down one side of the front opening and a row of holes at corresponding locations down another side of the front opening into which the fastener can be inserted”

Anyone selling cloaks with holes in which buttons can be inserted - can be sued

2. (B) - invents mechanism with metallic hooks and a receptacle for placing the hooks; and obtains a patent

“A cloak with a front opening having at least one metallic hook at one side of the front opening and at least one receptacle for said hook at the other side”

3. (C) - produces cloaks with fasteners, but instead of holes in the other side, provides loops made of string through which rectangular wooden buttons are to be put

4. (D) - produces “shirts” using the same buttons [fastener] as “A” but not “cloaks”

Applying DoE to the scenario

According to DoE, anyone infringes a patent even if he does not use all the measures of a claim, as long as the measures he substituted are regarded as equivalent of the measures in the claim

© literally infringes on all elements of (A) except on “the row of holes down the other side of the cloak” instead provided holes in the form of loops on the other side

1. These loops have the same function [to act as the receptacle for the fastener]
2. Using the loops same result is achieved [closing the cloak]
3. In the same way [by putting the fasteners in the corresponding receptacles]

So, using function-way-result test [DOE] (C) infringes (A)

(D) - Using DoE, (A) can charge (D) stating use of 'shirt' instead of a cloak is equivalent, as the only reason cloak is mentioned is for closing the front opening, the fact of cloak is irrelevant

**(D)'s argument
if cloak is not relevant, why did (A) mention it.**

(A)'s patent provides solution for the problem cloaks blow open in strong winds, not in case of shirts

The easier it is to prove that something is equivalent to a measure in a claim, the broader the scope of the claim gets.

DoE - a potentially powerful weapon to control the scope and usefulness of patents.

According to US Court Decision [FESTO]

'an element of a patent cannot be infringed by an equivalent measure if that element was "amended for reasons of patentability"

**"Prosecution History Estoppel"
or
"File Wrapper Estoppel"**

A legal limit to the 'Doctrine of Equivalents'

any surrender of subject matter during patent prosecution to avoid the prior art, may not be recovered by the patent owner later, even it is equivalent to the matter expressly claimed.

Referring back to “Cloak patent”

Eg. (B)’s patent issued prior to (A) filing a patent.

(A)’s claim using ‘fastener’ is too broad [generalization in patent parlance] and thereby would claim a part of the prior art, not being permitted.

(A) receives PO rejection.

‘Fasteners’ amended to ‘round wooden discs’ and gets the patent issued.

Now, (A) cannot sue (C) with rectangular wooden buttons [further to FESTO decision]

Patent Attorney’s use language as one of the tools to draft to claims and provides a broad coverage.

[Hilton Davis Chemical Co. Vs. Warner Jenkinson Co.]

[Festo Vs. Shoketsu Kinzoku Kogyo]

THANK YOU