



## Fordham 2017

Some literal infringement and equivalence - Dutch position

Edger F. Brinkman, Senior Judge, Court of The Hague

## The law - Article 69 EPC

- (1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

## The law - Protocol 69 EPC (1970 and 2000)

- No: strict, literal meaning wording claims, description and drawings only for ambiguity.
- No: claims only as a guideline and protection the patent proprietor wanted.
- Yes: position in between so that fair protection patentee and reasonable degree of legal certainty for third parties.
- due account any equivalent element (Art. 2)

## Some history I

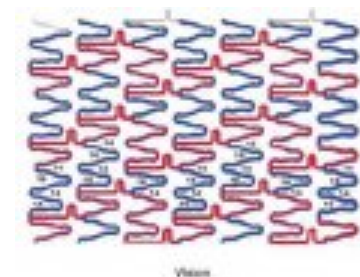
- DSC 27 January 1989, NJ 1989, 506 (Meyn/Stork):
  - Protection according to “Wesenlehre”= starting point is inventive concept, essence of the invention
  - Forfeiture of protection by patentee if clear statement, taking into account patent and other data (inter alia public prosecution file)
  - Much criticism, too wide construction

## More history II:

- DSC Ciba Geigy/Oté Optics (13-1-1995, NJ 1995, 391):
  - Wesen (essence of the invention) = viewpoint (more clearly in DSC12-3-2004 and 7-9-2007)
  - Other viewpoints are:
    - Fair protection patentee
    - Reasonable certainty third parties
    - Degree innovativeness of patent
  - Due account that unclear wording in principle problem patentee.

## SC Medinol/Abbott para 3.5.2

## SC Bayer/Sandoz 5 Feb 2016, para 3.3.8



- Infringement, two questions:
  1. Interpretation of patent to determine scope of protection (i.e. claim construction)
  2. Determination if a product/process falls within that scope
- Re (1): various viewpoints (i.a. essence of invention: what is contribution of the patent, file wrapper estoppel) **at filing or prio date**
- Re (2): may consider also knowledge skilled person at **infringement date**
  - (2) especially relevant for equivalents

## Dutch equivalence approach I

- FWR's insubstantial difference triple test:  
Equivalent, if the accused means
  - performs substantially the same function
  - in substantially the same way
  - yields substantially the same result
- FWR = US doctrine
  - applied in NL without proper theoretical foundation:  
criticised in literature, but applied in practice and  
largely non problematic:
- Context-bound claim construction rule is  
paramount: Art. 69 + Protocol and viewpoint-  
approach of Dutch SC

## Dutch equivalence approach II

- resembles UK purposive construction and no clear distinction between literal and equivalent infringement
- Main differences:
  - Assessment possible at time of (awareness of) infringement
  - Influence of file due to file wrapper history estoppel (DSC Dijkstra/Saier '06) → prevent “Angora cat”-schemes



## Equivalence limited by file wrapper history estoppel in NL

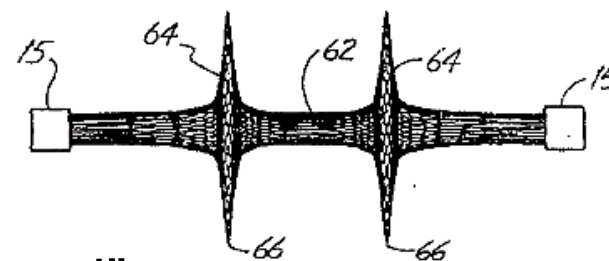


- Cannot see how to prevent Angora-schemes otherwise
- Forfeiture of protection by patentee only if **clear statement**
- (almost) never used to advantage patentee
- Not in Art. 69 EPC? How about **fair** protection for the patentee or **reasonable certainty** third parties?
- Argument “life is too short?” flawed as it is (virtually only) used to advantage 3rd party so if they take the time to read the file, why not?
- Not done in UK and DE, which is unfortunate, but all Scandinavian, AU, BEL, US, China, JP do, like NL (and FR?)

## How about inventive equivalents?

- DE: No, 2nd Schneidmesser question
  - The skilled person must be able to find (auffinden) the modified means
- UK: No?
- NL: No: see inter alia CoA Zilka/Ruegg (6-10-2009) “substantial difference” as skilled person would need inventiveness for variant as a new patent was granted (similar to DE?)
  - Often also: not substantially the same result (ie: better result)

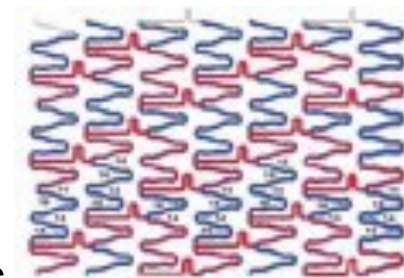
## What is “disclosed but not claimed is disclaimed”



- “disclosed but not claimed is disclaimed” see DSC AGA/Occlutech and Bayer/Sandoz
  - same in DE and UK
- MBI/Shimano District Court 18-6-14: Only non foreseeable variants at prio date can be equivalents
  - “**Foreseeable** but not claimed is disclaimed”

## Some more case law

- DSC Medinol/Abbott: description and drawings can limit literal wording claims
- Bayer/Sandoz DSC 5-2-16:
  - not only test if patentee had “good ground for excluding protection” for equivalent
  - Clear decision in patent for certain variant
  - Reasonable certainty third parties: no infringement with different variant
    - Even if not essential for invention which variant is used
  - Also not the same result → FWR confirmed?



## Forfeiture of protection - Definition in patent

- Claim: rosuvastatin acid or non-toxic pharmaceutically acceptable salt thereof
- [0007] definition (list) of “a non-toxic pharmaceutically acceptable salt”
  - Infringer: different salt of rosuvastatin
- CoA (Shionogi v Resolution 16-2-16):
  - essence of invention is rosuvastatin anion, not new salt of rosuvastatin, no salt screen, no formulation patent so definition of [0007] was not intended to be limited definition
  - Not sufficient ground that patentee wanted to exclude protection



## What will the UPC do?

- Relevant date for equivalence?
- “disclosed but not claimed is disclaimed”;
  - foreseeability at prio/application date?
- FWR/insubstantial difference or other test?
- Debate about file wrapper estoppel