

MR/13/00

Orig.: English

Munich, 20.11.2000

SUBJECT: Protocol on the interpretation of Article 69 EPC

DRAWN UP BY: United Kingdom delegation

ADDRESSEES: Revision Conference (for consideration)

Proposals

- A. That the texts for Articles 2 and 3 of the Protocol to Article 69 be withdrawn from the Basic Proposal, to allow further time for full consideration of the underlying issues and their likely impact on patent litigation, and re-submission if appropriate of a proposal in the second basket of EPC reforms envisaged for 2001.
- B. Alternatively, if Proposal A is not accepted by conference, that the text of Articles 2 and 3 be amended as set out below, and made subject to provisions for their coming into force, as explained in paragraph 10 below.

Explanation

- 1. The United Kingdom strongly supports the objective of maximising the harmonisation between national courts as to the criteria they apply to interpreting the scope of patent protection in the context of infringement and validity proceedings. The proposal for the Protocol to Article 69, at least in its present form, has however raised serious concerns that it will not work towards that objective, but may actually work away from it. These concerns must be examined.
- 2. It must in any case be acknowledged that a great deal of harmonising progress has already been made, particularly in Germany and in the Netherlands, where the importance of "reasonable degree of certainty for third parties" has been stressed. Judges do not operate in national isolation: apart from the explicit obligation laid upon them by the existing Protocol to Article 69 - to choose the middle way between the extremes of the literal and guideline interpretations - they take cognizance of each others judgments as well as meet to discuss issues (as in the recent Symposium).
- 3. There is a considerable risk that in attempting to overlay the existing Protocol with new detail the present equilibrium will be upset. The courts have until now been able to operate satisfactorily with the most general of guidance from the Protocol. The UK delegation believes that guidance should remain at the level of generality rather than detail.
- 4. A further fundamental principle is that certainty demands that the scope of protection of a patent should be readily apparent from a reading of the specification, with extraneous "interpretation" kept to an absolute minimum.

5. Any new guidance must above all be clear, otherwise it will not be helpful and will not bring about consistency between judgments. The introduction of new and untested doctrines, such as equivalents, can only increase the possibilities for differing conclusions being drawn from the same facts.
6. **Equivalents in general** It is widely accepted that one important way in which the literal scope of a patent claim may be departed from is in the area of equivalents or variants. There are however different views on the basis for accepting such variants: the teaching of the specification may be used to determine whether it was the **intention of the patent drafter** to keep strictly to the claim wording. A different approach is to add in the **view of the skilled man** as to obvious equivalents. There are good arguments for the intentions of the drafter to prevail over purely technical assessments of equivalency, and that substitution of obvious equivalents should be treated with caution. The following are specific areas of concern about equivalents:
 - if a patent specification is unambiguous and consistent that a certain element is to be used, then the patentee should not benefit from equivalents that he might have contemplated, but did not
 - if an element is also at the heart of an invention there is the more reason for not allowing it to be substituted by an equivalent not contemplated by the patentee.
 - if an invention in the chemical or biotechnological area is characterised by utility or function then it may change the character radically for this to be substituted by equivalents
 - it is already the case that drafters embrace equivalents by use of functional terminology in many arts ("means for..."), so there should be no need for later use of equivalents: indeed the introduction of an overriding doctrine of equivalents will mean that drafters need not be so accurate in this respect, and we may see an increase of careless drafting.
7. **Equivalents - date of consideration** Considerable disquiet has been expressed that the choice of the date of infringement as the time at which equivalence should be judged will lead both to uncertainty as to scope, and to a general trend that the scope of any patent will necessarily increase as technology reveals new possibilities for carrying out a function. This will increase uncertainty the older a patent is, because the reader of the specification will not generally know the up-to-date position in the art relating to the element in question. The reader will then have to guess what the court will say.

8. **Prior statements** The proposal will again require consideration of issues that are not evident on the face of the patent specification. More than that it will require an examination of the patent application file before it can be ascertained whether any statements have been made. This is an undue burden for third parties contemplating or involved in litigation, or simply wanting to know the scope of protection that they must operate around. We therefore believe that statements made other than in the specification should not be included.
9. **Implementation** It should be considered what effect there will be on existing patents if the Protocol is changed in this significant manner. There is nothing to prevent existing patents being re-litigated on the new legal basis. It should be evaluated whether this provision should be made subject to a special implementation provision, so that the revised Protocol is applicable only to European patents that are granted on or after the date on which it comes into force.
10. There are therefore difficulties and differences of opinion which there has not been enough time to resolve, and the proposal should therefore be deferred to the second basket of reforms.

The following wording is indicative of the less prescriptive approach that we think should be investigated if it is agreed that we should move in this direction.

Amended wording for Proposal B

Article 2

Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

Article 3

Prior statements

For the purpose of determining the extent of protection, due account shall be taken of any statement unambiguously limiting the extent of protection, made by the applicant or the proprietor of the patent in the European patent application or patent, or during proceedings concerning the validity of the European patent, where the limitation was made in response to a citation of prior art.