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The Doctrine of Equivalence at the UPC

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The Unified Patent Court (UPC) recently issued its first decision, in case UPC_CFI_239/2023, addressing infringement by equivalence. The patent in suit (EP2137782) was determined not to be infringed by the 'literal' scope of the granted claims. The UPC, therefore, applied a new four-step test for the assessment of infringement by equivalence. The steps – set out below – were 'based on the case law in various national jurisdictions', but do not appear to be identical to any national approach.

For a variation to be equivalent to an element specified in a claim, the following four questions must be answered in the affirmative:

1. Technical equivalence: Does the variation solve (essentially) the same problem that the patented invention solves and perform (essentially) the same function in this context?
2. Fair protection for patentee: Is extending the protection of the claim to the equivalent proportionate to a fair protection for the patentee?
3. Reasonable legal certainty for third parties: Does the skilled person understand from the patent that the scope of the invention is broader than what is claimed literally?
4. Is the allegedly infringing product novel and inventive over the prior art?

This approach does appear to be patentee-friendly overall with a fairly low bar to finding equivalence compared to some national courts. However, step #3 of the four-step test appears to create a potential point of tension with the European Patent Office's Examining Division's continuing insistence that descriptions be amended in line with the claims once they are considered allowable. It is not uncommon to see European examiners insert a statement to the effect that the invention is defined in the appended claims, and that embodiments not falling within the scope of the claims do not form part of the invention. It is foreseeable that such a statement could be used in support of the answer to step #3 being 'no'.

It also is worth noting that the Agreement on a Unified Patent Court (UPCA) does not contain any specific provisions on the doctrine of equivalence, and that, at the UPC, case law is nonbinding. As such, there is scope for the above test to be disregarded or modified. Nevertheless, this decision gives a good indication of how equivalence will be assessed at the UPC in the future – and of a potential prosecution pitfall to be avoided where a unitary patent is potentially of interest.

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Key Contacts

Dr. Oliver Ware London	oware@cooley.com +44 20 7556 4433

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