

# PATENT PRACTICE IN JAPAN AND EUROPE

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# **INTERPRETATION AND DETERMINATION OF THE SCOPE OF PATENTS BY THE FRENCH COURTS**

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## **I. INTRODUCTION**

Infringement of a French national patent should not be decided differently from the infringement of a European patent validated in France. Whereas the infringing acts are defined in each contracting State by the applicable national laws and not by the European Patent Convention, the scope of protection, however, is defined by Article 69 and the Protocol on the Interpretation of the European Patent Convention which states that the extent of protection shall be determined by the terms of the claim with a possible interpretation by the description and drawings. EPC 2000 introduced in the Protocol on the Interpretation of Article 69 EPC when determining the extent of protection of a European patent, due account must be taken of any element which is equivalent to an element specified in the claims. However, when considering the diverging interpretations of the “equivalency” concept, no definition was retained and today the national courts have the freedom to apply their own “doctrine of equivalency”.

We will analyze below the basic principle guiding the French courts in their determination of the scope of patents and therefore the infringement and the doctrine of equivalency as applied by the French courts as well as the latest developments, taking into account the prosecution history to determine the scope.

## **II. PRINCIPLE OF DETERMINATION OF SCOPE OF PATENTS IN FRANCE**

### **1. The Applicable Law:**

The interpretation of the claims of a patent is the subject of Article L. 613-2 of the French Patent Act:

“The extent of the protection afforded by a patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.”

“Where the subject matter of the patent is a process, the protection afforded by the patent shall extend to the products obtained by such process.”

The interpretation of the claims of a European patent validated in France is governed by Article 69 EPC and the Protocol on the Interpretation. According to Article 64 (3) EPC, the interpretation has to be done by the national courts.

“Any infringement of a European patent shall be dealt with by national law.”

This means that for European patents validated in France, the interpretation should in principle be the same as that by other courts. However, while the basic principle of Art. 69 EPC applies, there is still room for different interpretations by the national courts. One of these differences is their approach when applying the doctrine of equivalency. This difference in approach has led the group working on the revision of the EPC to propose an additional requirement concerning the definition of “equivalency” covered by a European patent. This definition has unfortunately not been adopted.

## 2. Basic Concepts for Interpretation

The interpretation of claims is made by the French courts but these are not composed of technically trained judges. The same court has to decide also the counterclaim of revocation of the patent. This means that the courts have to decide at the same time both the validity and the infringement of the patent. Therefore the interpretation of the claims is often influenced by the decision of whether the claims are valid.

Infringing a patent claim means reproducing said claim. When reproduction is carried out using all of the details, there is no difficulty of interpretation. However, the situation is more difficult when the alleged infringement contains some variations or differences as regards the claimed technical features. The general principle, however, is that infringement must be judged by taking into account the similarities between the alleged infringement and the claim and not by taking into account the differences. In other words, and as recited in many decisions of the French courts, there is an infringement as soon as the essential features of the invention claimed are reproduced. The alleged infringement may therefore differ from the content of the claims by non-essential differences, i.e. variations concerning non-essential technical features.

This principle has been applied in a decision by the Paris Court of Appeal of June 28, 2006.<sup>1</sup> The invention concerned an implement for milking cows automatically, comprising an automatically operable cleaning member for the cleaning of the teats of an animal before milking, a milking robot with an arm for the connecting of teat cups to the teats of the animal and successively milking of the animal and disconnecting the teat cups from the teats of the animal, characterized in that the implement further comprises an automatically operable after-treating device for after-treating the udder and/or the teats of a milked animal included in the robot arm.

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<sup>1</sup> *Lely v Delaval*.

The alleged infringer did not reproduce the different functions of the robot arm considered as an essential feature. The Court therefore rejected the infringement claim.

The Court of Appeal of Paris in a decision of October 27, 1988<sup>2</sup> indicated also:

“The patentee was bound by the claim he has drawn up and that he has to invoke as it stands without adding anything on the pretext of interpreting that claim.”

The Court of Appeal of Paris in a decision of January 27, 2010<sup>3</sup> specified the general principle of interpretation. A pioneer invention may be interpreted in a broad way on the condition that the claims are not drafted in a restrictive way.

“It is permissible, in the face of a pioneering invention, for the patent to describe one embodiment of the invention and to claim quite a different possible embodiment. It would not be possible, even if it were pioneering, for the invention to be afforded a general scope if its claims are drafted in restrictive terms”.

Interpretation of narrow claims cannot justify the broadening of the scope. Interpretation as provided in Article 69 EPC is essentially applied to clarify ambiguities in the claim.

“An unambiguous claim with a narrow scope cannot, under the cover of interpretation, be afforded a more general scope ...”.

### III. THE DOCTRINE OF EQUIVALENCY

If there is no literal infringement, the French courts apply, as in most of the countries, the doctrine of equivalency to determine infringement.

#### 1. Basic Principles:

To determine an infringement, the French courts use the term of “means” (“*moyen*”) which encompasses any technical feature and thus either process or product features.

“Means” are characterized by (a) their form or structure, (b) the function they fulfill which is also called the first or immediate result and (c) the technical result which is enabled to be achieved, i.e. the final result.

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<sup>2</sup> *La Viguerie v Lafarge*.

<sup>3</sup> *Hewlett Packard v Waters*.

According to French case law, two means are considered to be equivalent if despite their different form or structure they fulfill the same function in order to provide a result of the same nature or same degree.

## 2. Case Law

The above principles have been applied in the some recent cases.

One of these was a case heard by the Court of Appeal of Paris<sup>4</sup> and covered a rehydrating composition for animals comprising lactose and a complement based on chloride, acetate and/or propionate anions and sodium, potassium and/or magnesium cations. The product of the alleged infringer did not contain magnesium cations nor acetate and/or propionate anions but contained citrate and chloride anions. The Court considered that the combination of chloride with citrate metabolized in the same way as the anions of the invention and therefore has the same function with lactose for a result of the same nature, and was therefore an equivalent.

Another such case was also heard by the Court of Appeal of Paris.<sup>5</sup> The patent covered a device for regulating the heating of electric radiators, which was based on electric switches. The alleged infringers replaced those switches by devices operating by optical reading. The Court of Appeal decided that there was an infringement as the means used, even of a different structure, exercised the same function in order to obtain an identical result and were therefore equivalent to the means claimed. This decision was confirmed by the Supreme Court on April 28, 2004.

Another case was one heard by the Supreme Court.<sup>6</sup> The Supreme Court confirmed the decision of the Court of Appeal that there was no equivalency between a patent covering a boat hull, characterized by the combination of a monoblock construction forming in their lower part three small hulls arranged into a triangle, the one being central and in front and the two others being lateral and in the rear, the three hulls lining on the water, whereas the boat of the company Hoverspeed was a catamaran comprising two hulls linked to a third central hull which was clearly above the flotation line and did not line on the water in normal conditions. The Court of Appeal considered that the floatability conditions of the two boats were different and therefore the function of the three hulls was different and therefore there was no infringement by equivalency.

And in still another case was heard by the District Court of Paris.<sup>7</sup> The invention concerned a universal tool carrier for a de-brancher. The Court indicated that “two means having a different ‘form’ but having

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<sup>4</sup> *INRA v Fort Dodge*, May 28, 1999.

<sup>5</sup> *Applimo v Atlantic*, May 13, 2003.

<sup>6</sup> *Piana v Hoverspeed*, October 20, 1998.

<sup>7</sup> *Pellenc v Robineau*, November 24, 2009.

the same function i.e. the same immediate technical effect and providing a similar result” are considered as equivalent.

### 3. Date of Recognition of Equivalency

The date by when equivalency has to be considered, according to French case law, is the date of the infringement. This means that infringement may exist even if means are used which did not exist at the filing date of the patent.

### 4. Obviousness of the Means Used

The question of obviousness of the alleged equivalent means is not considered. This has been decided by the Court of Appeal of Colmar<sup>8</sup> and confirmed by the Supreme Court.<sup>9</sup> According to the Court, it was not possible to escape infringement by filing a patent application on the embodiment or improvement. In that case the alleged infringer tried to argue that it was not infringing since the knee prosthesis comprised in addition a screw, thus avoiding the dislocation of the prosthesis and its separation when implanted

### 5. Condition for the Application of the Doctrine of Equivalency

The function must be new:

The French doctrine of equivalency is used and applied by the courts only if it can be shown that the function of the means covered by the patent is novel. If the function is not novel, the French courts consider that the patent should be limited to the specific form claimed and cannot extend to the equivalent means. The Supreme Court<sup>10</sup> confirmed a decision of the Court of Appeal of Paris which considered that the combination of means of the alleged infringement was not an infringement since the means used were different in their form (structure) but fulfilled the same function for a similar result, for the reason that the function of the patented combination was not novel.

The same reasoning was applied by the Court of Appeal of Paris<sup>11</sup> relating to the building of roads. The patent covered a watertight complex to be used in road building, comprising a lower layer comprising a bituminous binder with elastomers and an upper layer with a bitumen rich in elastomer. The alleged infringer used a lower layer comprising asbestos fibers instead of the elastomer. Both the elastomer and the asbestos fibers increased the cohesion of the layer.

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<sup>8</sup> *Aesculab v Link*, January 8, 1996.

<sup>9</sup> *Aesculab v Link*, October 20, 1998.

<sup>10</sup> *Safem v Guima*, December 4, 1990.

<sup>11</sup> *Jean Lefevre v Screg*.

The Court of Appeal decided, however, that in view of the fact that it was known from the prior art that the elastomer could be used in a structure for its cohesion effect, the function was not novel and therefore the patent was limited to the specific form covered, i.e. the structure with the lower layer containing the elastomer. The use of asbestos fibers in a similar road structure was considered as not infringing.

This principle has been applied in several recent decisions:

First, by the District Court of Paris.<sup>12</sup>

“The infringement by equivalency can only be admitted in that the claimed means does not exercise a known function”.

In that case the function of the feature claimed was already disclosed by the prior art.

Secondly, by the District Court of Paris.<sup>13</sup>

The patent concerned the preparation of taxol or “paclitaxel”. The claim covered the use of derivatives of phenyl-3 isosterine with an acidic function protected by specific protecting groups, whereas the alleged infringer used a  $\beta$ -lactam having a cyclic amide group (not acidic) protected by a different protecting group. The Court decided that since the protecting function was not novel, the patent was limited to the specific combination claimed and therefore was not infringed under the doctrine of equivalency.

## 6. The Prosecution History

While in the past the French courts considered that the file wrapper estoppel doctrine does not apply, the latest case law of the French courts seems to admit some kind of file wrapper estoppel by taking into account the limitation or amendments made during prosecution of the patent.

a) File Wrapper Estoppel Doctrine does not Apply:

The Court of Appeal of Paris in a decision of July 5, 2002 (*La Johnson Française v Sarah Lee*) applied the principle that “the interpretation of the patent cannot be oriented in function of the declarations made during the prosecution of the grant procedure”.

The same approach was taken in a decision by the Regional Court of Paris,<sup>14</sup> where “Institut Pasteur rightly argues that only these provisions (i.e. Article 69 and the Protocol on the Interpretation) govern the

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<sup>12</sup> *Pellenc v Robineau*, November 24, 2009.

<sup>13</sup> *Aventis Pharma v Bristol Myers Squibb*, March 27, 2002.

<sup>14</sup> *Institut Pasteur v Siemens Healthcare*, May 28, 2010.

interpretation of the wording of the claims and that the 'file wrapper estoppel' theory, which consists in also taking into account, to interpret a patent, the statements made by the applicant during the grant or opposition proceedings, cannot be applied."

b) The Consequences of the Limitations and Amendments Carried out During the Grant or Opposition Proceedings

The prosecution history was the key element for judging an infringement in several recent decisions concerning a patent of the Institut Pasteur covering diagnostic tests for HIV. The patent was a divisional of the patent series of Professor Montagnier et al. who obtained the Nobel Prize for their discovery of the HIV virus.

c) Exemplary Cases

aa) HIV Diagnostic Kit:

In the above case of *Institut Pasteur v Siemens Healthcare*, the claims involved the following:

Claim 8 was directed at "A method for the in vitro detection of viral infection due to the LAV viruses which comprises contacting a biological sample originating from a person to be diagnosed for LAV infection and containing RNA in a form suitable for hybridization with the probe of claim 7 under hybridizing conditions and detecting the hybridized probe."

This claim was linked to claim 7 covering "A probe for the in vitro detection of LAV which consists of a DNA according to any of claims 1 to 6."

Claims 1 to 6 had been limited during the grant and opposition proceedings to a cloned DNA containing a DNA corresponding to the retroviral genome of LAV and contained in  $\lambda$ J19, said DNA comprising elements U3, R and U5 of this retroviral genome. More particularly claim 5 was limited to "A cloned DNA fragment which sequence corresponds to the part of the DNA of  $\lambda$ J19, which extends from approximately Kpn I (3500) to approximately Bgl II (6500) thereof" and claim 6 to "A cloned DNA fragment which sequence corresponds to the part of the DNA of  $\lambda$ J19, which extends from approximately Pst I (800) to approximately Kpn I (3500) thereof".

Claim 11 was directed at "The purified RNA of LAV virus which has a size from 9.1 to 9.2 kb and which corresponds to the cDNA contained in  $\lambda$ J19 (CNCM I-338)."

The Institut Pasteur considered that, due to the pioneering nature of the invention relating to the detection of HIV, the patent claims 5, 6, 7 and 8 cover all DNA probes, even though they may not be expressly disclosed, provided only that they are hybridizable with the RNA of the AIDS virus to guarantee detection. Furthermore, the Institut Pasteur stressed the pioneering nature of the invention and maintained that, for the first time, the patent concerned allowed the detection of very small quantities of AIDS-causing virus, within very brief periods of time, which has been decisive in halting the risks of contamination and favoring the establishment of an anti-retroviral treatment and the follow-up of its effectiveness.

They argued that claim 8 protects a new general means for detecting and quantifying the AIDS virus by hybridizing DNA probes labeled with the viral RNA and considered that the patent covered therefore all DNA probes, even though they may not be expressly disclosed and notwithstanding all the forms of variations or improvement, provided only that they are hybridizable with the RNA of the AIDS virus to guarantee detection.

The Regional Court referred first to Articles 1 and 2 of the Protocol on the Interpretation of Article 69 EPC to justify that a proper claim construction combines “a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties”. The Court thereafter turned to the prosecution history of the patent before the European Patent Office and to the limitations and amendments made by the patentee to obtain the grant of the patent. The Court held that “It follows that the amendments made to the claims by Institut Pasteur during the examination and opposition proceedings – which must be taken into account failing which legal certainty for third parties would be violated – resulted in limiting the scope of the invention, which was voluntarily limited in order to obtain the grant then the maintenance of the patent at issue”.

In that case, the limitations, which were made by the Institut Pasteur during examination in view of the prior art, concerned the DNA sequences of claims 1 to 6 defined by their restriction sites and corresponding to the retroviral genome contained in  $\lambda$ -J19. Claim 8 directed at the diagnostic method requires the use of the probe defined in claim 7, which depends on claims 1 to 6 protecting cloned DNA fragments.

The Institut Pasteur contended in addition that claim 8 covers any diagnostic method, whichever the probes used, on the ground that this claim indirectly refers to claim 1, which, because of the use of the word “corresponding” would continue to cover any DNA fragment.

The Court referred to the opposition proceedings before the Board of Appeal and held:

“Indeed, the Board of Appeal of the EPO, with regard to claim 1, indicated that the word ‘corresponding’ appears to be in the narrow sense of base to base correspondence, subject to the allowable variations which would not substantially alter their capability of also hybridizing with the LAV retroviral genomes, as understood by a person skilled in the art. Thus, without distorting this decision, it cannot be alleged that the protection of the allowable variations would also extend to the protection of all equivalent DNA fragments.”

The alleged infringement:

The Institut Pasteur alleged that the Versant HIV-1 RNA 3.0 Assay (bDNA) kits of Siemens Healthcare for the quantitative diagnosis of the HIV as well as the reagents implemented the features of the invention of the patent. Having found that the target probes and the capture probes used in the Versant HIV-1 RNA 3.0 Assay (bDNA) kit are made of synthetic oligonucleotides and not of cloned DNA, the Court rejected the literal infringement of the claims 5, 6, 7 and 8.

The Institut Pasteur also contended that the Siemens Healthcare Diagnostics kit infringed claim 8 of EP '798 under the doctrine of equivalency. The Court did not admit the infringement under the doctrine of equivalency and held:

“Claim 8 does not protect a new general means for detecting and quantifying the AIDS virus by the hybridization of DNA probes labeled with the viral RNA – such a detection method being already disclosed in the prior art – but a method using probes composed of cloned DNA fragments corresponding to the retroviral genome contained in  $\lambda$ -J19, considering the limitations made by the patentee to the wording of the claims during the examination and opposition proceedings before the European Patent Office”.

“It follows that the patented means, that is the use of probes composed of DNA fragments, is only new in its form, as the fulfilled function of hybridization with the viral RNA for detecting the disease is known”.

“The infringement by equivalency, which, in the present case, cannot result from the identity of functions, can be constituted only if the very form of the patented means is implemented in an equivalent form and in what characterizes its patentability, namely, in the present case, probes composed of cloned DNA fragments defined by their restriction sites and corresponding to the retroviral genome contained in clone  $\lambda$ -J19”.

The Paris Court of Appeal<sup>15</sup> held that the same patent as above was involved and the litigation dealt with the infringement of claims 8 and 11 by the PROCLEIX kit sold by Chiron Healthcare. The Institut Pasteur contended that the patent constitutes a first order innovation making this patent a pioneering one, so that, according to it, claims 8 and 11 have a scope going beyond their literal meaning. The Court of Appeal rejected this argument by stating:

“However, if in the presence of a pioneer invention, the patent may describe one embodiment of the invention and claim any other possible embodiment, on the other hand, even a pioneer patent cannot be granted a general scope if its claims are drafted using restrictive words”.

The patentee alleged in addition that the claim should be interpreted in a broad way. The Court of Appeal applied the principle of interpretation of the claims by stressing two reasons:

- Interpretation does not mean generalization beyond the scope of the claims.

“A non-ambiguous claim with a narrow scope cannot be granted a general scope on the pretext of an interpretation”

- The prosecution history has a legal effect on the interpretation as recalled in the above referred decision.

“When, in particular, the patentee was forced to limit the scope of the claim during the grant and opposition procedures in order to be distinguished from the prior art. “

The Court of Appeal rejected the infringement of claim 11 by taking into account again the prosecution history.

“The patentee, which amended its claims to confer them a restricted scope, cannot, without damaging the legal certainty of third parties, allege that the amendments were not necessary, that the restricted claims would have the same scope as the initial broader claims and that the prior art documents having motivated the amendments would not be relevant.”

Finally infringement under the doctrine of equivalency was not admitted for following reason:

“The Institut Pasteur cannot use the doctrine of equivalency since claim 8 does not cover the general means but the specific means”.

With regard to claim 8, the Institut Pasteur alleged that the method covered by this claim protects a novel general means for the detection of the viral charge of AIDS, characterized by the hybridization of DNA probes with the viral RNA and that it cannot be limited by the choice of the probe according to claim 7.

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<sup>15</sup> *Institut Pasteur v. Chiron Healthcare c.s.*, March 4, 2009.

The Court referred again to the prosecution history:

“It should be noted that the amendments, which were made by the Institut Pasteur during the examination procedure, led to the limitation of the scope of claim 8 in that it requires using the probe, the subject-matter of claim 7, which depends on claims 1 to 6 protecting cloned DNA fragments defined by their restriction sites and corresponding to the retroviral genome contained in  $\lambda$ -J19.”

In addition the Court stressed the responsibility of the patentee in amending the claims:

“It was the responsibility of the Institut Pasteur, during the examination and opposition procedures, to amend the process claim or the probe claims in order to dissociate them from the fragment claims.”

Finally the Court rejected also the infringement under the doctrine of equivalency by holding:

“The Institut Pasteur cannot use the doctrine of equivalency since claim 8 does not cover the general means of hybridization but the specific means of hybridization of viral RNA with a probe composed of a DNA fragment which corresponds to the genome contained in the clone  $\lambda$ -J19.”

This decision of the Court of Appeal has been confirmed by the Court of Cassation (Supreme Court) on November 23, 2010.

#### bb) Pumping Device of HPLC Chromatograph Case

The same position was taken by the Paris Court of Appeal.<sup>16</sup> This case gave rise to parallel decisions in the UK and in Germany. All three courts decided that the pumping device claimed by Agilent (initially Hewlett Packard) was infringed by Water's first device having an automatic adjustment of the stroke length of the pump in response to the flow rate. Thereafter the software of the pumping device was modified in such a way that there was no longer an automatic adjustment, the adjustment could be made by the operator. All three first instances decided, as was also decided upon appeal, that the modified device did not infringe the patent.<sup>17,18,19,20,21</sup>

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<sup>16</sup> *Agilent GmbH v Waters*, January 27, 2010.

<sup>17</sup> High Court of Justice, December 21, 2004.

<sup>18</sup> Court of Appeal, July 29, 2005.

<sup>19</sup> Regional Court Düsseldorf, August 29, 2006.

<sup>20</sup> Higher Regional Court Düsseldorf, February 2, 2008.

<sup>21</sup> TGI Paris, December 17, 2007.

Agilent alleged that the patent was the first to teach a device allowing the volume per stroke of the pistons to be modified according to the desired flow rate and that accordingly it should be accorded a scope far broader than that adopted by the French Regional Court and that claim 1 should thus be interpreted as covering any device in which the volume per stroke of the pistons is adjusted either automatically or manually in response to the desired flow rate, the volume reducing when the flow rate reduces and vice versa, restricting the scope of the patent to automatic adjustment of the volume per stroke of the pistons neither being expressly stated in the wording of the claims nor implied in the description of the patent.

The French Court of Appeal applied the basic principles of determining the scope of patents by holding:

“Whereas it is permissible, in the face of a pioneering invention, for the patent to describe one embodiment of the invention and to claim quite a different possible embodiment, it would not be possible, even if it were pioneering, for the invention to be afforded a general scope if its claims are drafted in restrictive terms”.

The Court referred also to the prosecution history by stating:

“Whereas in particular an unambiguous claim with a narrow scope cannot, under the pretext of interpretation, be afforded a more general scope, particularly when the patentee has been forced, in order to distinguish itself from the prior art, to restrict the scope of the claim in part of the grant procedure ...”.

The Court noted that the feature: “in response to the desired flow rate of the liquid discharged at the outlet of the pumping device, the volume per stroke (that is to say the amount of liquid displaced during a pumping cycle) reducing when the flow rate reduces and vice versa” had been added to the wording of the claim during the examination at the European Patent Office in order to have the patent granted. The Court concluded therefore:

“The patentee who modified his claims to give them a restricted scope cannot, without jeopardizing the safety of third parties, maintain that the modifications had not been necessary any more than he can maintain that the restricted claims have the same scope as the broader original claims”.

The Court justified its non-infringement finding by indicating that the patent is to be regarded as covering the device in which the control means adjusts the stroke lengths of the pistons in response to the desired flow rate, the volume per stroke reducing when the flow rate reduces and vice versa, so that pulsation at the outlet is reduced; in fact, the reduction in pulsation is the result of the action of the control means of the device which, connected to the drive means, adjusts the stroke lengths of the pistons in response to the

desired flow rate, this last feature, previously mentioned as having been added during the patent grant procedure, unambiguously implying that it is the control means that adjusts the stroke length as a function of the desired flow rate.

The Court finally held “that the invention protected by the patent relates only to an automatic operation of the control means claimed and does not cover manual operation which might define the adjustment of the stroke length as a function of the desired flow rate”. It should be noted that only the French courts referred to the prosecution history to support their narrow interpretation of the claims.

## 7. The Case of Combination Inventions

The French courts have a tendency to adopt a literal interpretation in cases where the invention is presented as a combination of several means or features. The Supreme Court<sup>22</sup> affirmed the decision of the Court of Appeal which indicated that the patentee himself had decided the protection which he wanted to obtain. In this case, the invention concerned a fireproof concrete formulation with specific ranges for each component. The Court considered that the ranges of those components were an essential feature of the claimed combination. The patent indicated in its description that the common result of the combination, i.e. the result obtained by the specific concrete formulation, could not be obtained if those specific ranges were not chosen. Even if it could be proved afterwards that identical results could also be obtained by modifying one range of a certain component, the Supreme Court affirmed what was stated by the Court of Appeal which decided that the reproduction of only a part of the claimed formulation was not an infringement of the claimed invention.

Such a decision therefore illustrates a case of a pure combination claim or at least a case where the patent presents the invention as a real combination of means. The Court of Appeal of Paris<sup>23</sup> in a case relating to a patent covering a medical device for the rachis considered that the invention concerned a combination of five features, whereas the patentee argued that two of the features were not necessary. The Court decided that the five features cooperated together for the common result disclosed in the patent. This combination could not be divided out and could therefore not protect sub-combinations. The patent was considered to be not infringed even if the competitor used three of the five features.

More recently the Paris Regional Court<sup>24</sup> decided that in order to be infringing, the constitutive elements of the combination should be reproduced in an identical way, except in a situation where it can be shown that the feature not reproduced in an identical way is an equivalent of that used in the combination. The patent covered protecting equipment comprising: a non-woven polyolefin substrate, an outer layer made of a polyolefin film, an intermediate layer made of ethylene/vinyl acetate coated with polyvinylidene

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<sup>22</sup> *Lafarge v Viguerie and AGS* (Cour de Cassation), February 19, 1991.

<sup>23</sup> *JBS v Procerati*, January 15, 1997.

<sup>24</sup> *Sopralil v Matisec*, May 17 2006.

chloride. The alleged infringement used a non-woven polyester layer instead of the polyolefin substrate. Infringement was rejected as the polyester did not fulfill the same function as the polyolefin more particularly for the welding of the material.

#### IV. CONCLUSIONS

Whereas the interpretation of the scope of patents when there is literal infringement or reproduction of the essential features does not raise difficulties within the Member States of the EPC, the application of the doctrine of equivalency, the principle of which has been introduced into the EPC 2000, still raises questions. The French courts have traditionally required that the function of the patented means should be new in order to allow a finding of equivalency of an embodiment that deviates from the literal meaning of the claim(s). The latest development of the French case law seems to follow the recommendation of the Resolution Q175 of AIPPI in 2003:

“Notwithstanding that an element is regarded as an equivalent, the scope of protection conferred by a patent claim shall not cover the equivalent if,

...

c) the patentee expressly and unambiguously excluded it from the claim during prosecution of that patent to overcome a prior art objection.”

This does not, however, go as far as the U.S. approach of the “file wrapper estoppel”.

At the time of retirement of Dr Rahn, he leaves us with this subject of discussion, interpretation and, hopefully, future harmonization within the Member States of the EPC.