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LUNG TIN IP ATTORNEYS

NEWSLETTER
知产快报

Doctrine of equivalents is a long term topic. It is always a difficulty to determine patent infringements with appliance of doctrine of equivalents, even in a well developed patent system of the United States. Moreover, the judicial community has no consensus in many aspects of appliance of doctrine of equivalents. When the courts in China proceed the trials of patent infringement, the courts in China learn the experience of western countries, especially the experience of the United States. With the case increment of patent infringement in recent years, the courts in China then have accumulated rich experiences in trials of doctrine of equivalents. In the near future, we believe that the courts in China will have more understanding and matured appliance of doctrine of equivalents.

Appliance of Doctrine of Equivalents in Trials of Patent Infringement

Doctrine of equivalents, originated in the United States, is an important legal rule in patent infringement judgments. It prevents the infringer taking actions of changing some subtle and non-substantial technical features for escaping from the legal liability of patent infringement and provides an effective remedy to the patentee.

Patent infringement, in the early years, was judged according to literal infringement, which means the alleged infringement was judged as an infringing product according to literal analysis of the comparison of the features of the alleged infringement and the claims. In practice, the literal infringement is rarely happened. In most cases, the infringer only needs to replace one/ some of the components with infringing features of the alleged infringement. The replacements are easily achieved by a person with ordinary skill in the art. In other words, the infringer adapts non-substantial changes to avoid the literal infringement. The patentee will be lack of enthusiasm of creativity if the behavior of the replacements is not able to be prohibited. Therefore, in judicial practice, doctrine of equivalents is then established.

Doctrine of equivalents was originated in the judicial practice in the United States. The four landmark classic cases, Winans v. Denmead, 1853, Graver Tank & Mfg Co. v. Linde Air Products Co., 1950, Hughes Aircraft Company vs. United States, 1983 and Hilton Davis Chemical Co. v. Warner – Jenkinson, 1997, witnessed the development of doctrine of equivalents in the United States which provide significant references of doctrine of equivalents in judicial practice in other countries, especially in China, of the world.

Doctrine of equivalents of patent infringement determination in China is established in judicial practice and is earlier than legislation, which presents the hysteresis of doctrine of equivalents in legislation. In the mean time, it also shows importance and necessity of doctrine of equivalents in judging patent infringements.

Doctrine of equivalents is firstly in a judicial interpretation to be determined as a judicial principal in patent infringement judgments in the Article 17 of "The Regulations of Legal Issues Adapted in Trials of Patent Disputes", published by supreme people's court of China. In the judicial interpretation, "Doctrine of equivalents is referred to features that substantially perform the same features, described in the patent, to substantially achieve the same function, and substantially achieve the same effect, and the person with the ordinary skill in the art can be thought without creative works". Doctrine of equivalents is applied on two aspects: 1. Objective aspect: The technical features of the alleged infringement, compared with the features disclosed in the claims of the patent, are replaced by the features that substantially perform the same features, described in the patent, to substantially achieve the same function, and substantially achieve the same effect. 2. Subjective aspect: For person with ordinary skill in the art, the technical features of the alleged infringement can be thought without creative work after reading the claims and the specification of the patent.

In appliance of doctrine of equivalents, the courts in China have gradually had same opinion on some issues relevant to doctrine of equivalents. The consensus of these issues is undoubtedly a summary of experience in trials of doctrine of equivalent infringement cases of the courts in China. The consensus mainly includes:

1. In determining the protection coverage of the patent, the description of the claims shall prevail. The specification and drawings are used to explain the features of claims. The specification and drawings are used to support the features in the claims when the features of the claims are not clearly disclosed. Moreover, the specification and drawings are not allowed to be used to limit the coverage, clear and no doubt, of the claims.

2. In the determination of infringement, all features disclosed by the claims are compared

18th Floor, Tower B, Grand Place, No 5, Huizhong Road, Chaoyang District, Beijing 100101,P.R. China
Tel: 0086-10-84891188 Fax: 0086-10-84891189
LTBJ@lungtin.com www.lungtin.com

with all features of the alleged infringements (a product or a method) one by one.

3. The definition of the term "a person with ordinary skill in the art" is quite clear. The person is a hypothetical role who knows all prior arts in the technical field of the invention, and has the knowledge of those skilled in the art. The knowledge level of the person is timely different.

4. The boundary of appliance time for doctrine of equivalents is generally set on the infringing date, which means the technical means, tools or devices existed before or on the infringing date is treated as equivalent means or equivalents.

5. Estoppel and prior art defense are considered as restrictions for appliance of doctrine of equivalents which will prohibit the patentee from arbitrarily expanding the coverage of the patent right and protect the public interests.

We should follow certain standards when applying doctrine of equivalents to determine patent infringement. Otherwise, it is easy to abuse doctrine of equivalents and draw the wrong conclusion. The followings show the standards.

1. Doctrine of equivalents should be filed by the plaintiff instead of the court.

Doctrine of equivalents, as the main prosecution reason of the plaintiff, should be filed by the plaintiff. The court, as a neutral role, is not allowed and should not participate in litigation in either one of the parties. If the plaintiff only files literal infringement without considering infringement of doctrine of equivalents, the court will only follow standards of literal infringement to proceed the trial, and will not file an infringement of doctrine of equivalents for the plaintiff and actively introduce a technical appraisal agency to make the judgment of doctrine of equivalents.

2. The technical features of the alleged infringement are correctly summarized.

The technical features of the alleged infringement are the comparison objects for being compared with the features, disclosed by the claims of the patent, one by one instead of being compared with the full technical scheme of the alleged infringement. Thus, the technical features of the alleged infringement should be correctly summarized.

3. The technical features of the alleged infringement whether are identical or equivalent to the existing technology.

If the technical features of the alleged infringement are identical or equivalent to the existing technology, prior art defenses may be applied to exclude doctrine of equivalents. The prior art defense should be assuredly filed by the defendant.

4. The comparison objects should be correctly selected.

This is the premise of appliance of doctrine of equivalents. The comparison objects should be all features, disclosed by the claims, of the technical schemes of the patent and all features of the alleged infringement (products or methods), and the features of the patent are compared with the features of the alleged infringement one by one.

5. Estoppel has priority appliance.

Estoppel should be actively filed by the defendant and the defendant should provide the relevant evidence. In the meantime, estoppel appliance excludes the appliance of doctrine of equivalents.

6. Prevent overriding of the judicial power of judges

In order to prevent overriding of the judicial power of judges, the coordination of the judges and the technical appraisal people should be optimized in determining patent infringement with appliance of doctrine of equivalents.

Doctrine of equivalents is a long term topic. It is always a difficulty to determine patent infringements with appliance of doctrine of equivalents, even in a well developed patent system of the United States. Moreover, the judicial community has no consensus in many aspects of appliance of doctrine of equivalents. When the courts in China proceed the trials of patent infringement, the courts in China learn the experience of western countries, especially the experience of the United States. With the case increment of patent infringement in recent years, the courts in China then have accumulated rich

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experiences in trials of doctrine of equivalents. In the near future, we believe that the courts in China will have more understanding and matured appliance of doctrine of equivalents.

The newsletter is not intended to constitute legal advice. Special legal advice should be taken before acting on any of the topics addressed here.

For further information, please contact the attorney listed below. General e-mail messages may be sent using LTBJ@lungtin.com which also can be found at www.lungtin.com

Xiaobing Wang, Attorney-at-Law, Patent Attorney, Partner at Lung Tin Law Firm (Shanghai): LTBJ@lungtin.com

Sam Y. Lin, Foreign Patent Department Manager at Lung Tin Law Firm (Shanghai), Patent Engineer: LTBJ@lungtin.com

Xiaobing Wang

(Attorney-at-Law, Patent Attorney, Partner at Lung Tin Law Firm (Shanghai))

Mr. WANG has high proficiencies in Intellectual Property Litigation and Arbitration, Patent/Trademark Invalidation, IP Administrative Enforcement Cases, IP Legal Counsel, Unfair Competition and Anti-monopoly. After obtaining the Master of IP Law from SJTU, Mr. Wang has represented hundreds of Intellectual Property Litigation cases, among which includes Top 10 Typical Cases of IP Judicial Protection elected by Supreme People's Court and Shanghai IP Court. He was interviewed on hot IP issues by CBN, China IP News, CNR and ASIA IP. He has published the Monograph of Strategies and Skills on Handling IP Cases and academic articles, which earned him the awards as "Top 10 best cases", "Top 10 best treatises "and "Outstanding Writing". Mr. Wang has provided services for CITIBANK, Semir, Markor furnishings, TianNeng Group, Dow Corning, Abdul Samad Al Qurashi, etc.

Sam Y. Lin

(Foreign Patent Department Manager at Lung Tin Law Firm (Shanghai), Patent Engineer)

Mr. Lin is experienced in drafting specifications in Chinese/English (first draft), coordinating global patent prosecutions, patent litigations, patent invalidation, patent harvesting, and providing patent global deployment opinions and prosecution strategy. Mr. Lin has served clients in the mobile communication, 3GPP protocol, IC design, artificial intelligence, semiconductor, LED, network, power system, automobile electronics and mechanic industries.

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