
Non-literal patent infringement Comparative study

The French perspective

Isabelle ROMET

VÉRON & Associés

PARIS - LYON

Remark about typical French reasoning

- First issue: validity
- Second issue: infringement

Claim construction: Article L 613-2 of the French Intellectual Property Code

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

= provisions of Article 69 of the EPC

Paris Court of Appeal October 11, 1990, Dolle v. Emsens

« Article 69, as completed by its protocol, has chosen a middle way between a literal construction of the claim, in which the description and the drawings should be used only to dissipate ambiguities, and a broad construction in which the claim would be used just as a guideline and in which the protection would extend to what, according to the skilled person, the patentee has intended to protect.

This compromise must ensure a fair protection for the patentee against the skill of the infringer to disguise infringement and enable third parties to know with certainty what is protected.

In view of Article 69, the Judge must construe the claims by reference to the description and to the drawings.

He must give to the claim its full meaning, so that this condensed text is understood.

The construction leads to define the substance of the claimed invention, without adding any element which the claim did not include and did not suggest. »

Conclusion about claim construction

- Compulsory construction of the claim, in view of the description and of the drawings (construction of the terms employed and understanding of the substance of the invention through the problem solved and the essential means of the solution)
- Additions prohibited

General definition of infringement

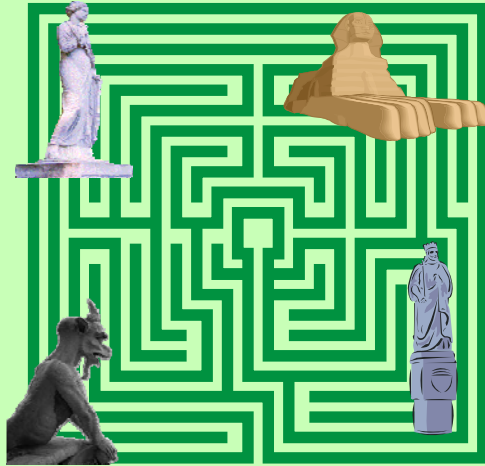
The infringing means are those which reproduce the **essential means** of the patented invention, i.e. the new and inventive means which are necessary and sufficient to perform the function of the invention.

Main forms of non-literal infringement

- Reproduction of the essential means despite minor differences (dealt with as literal infringement by French Courts)
- Equivalents
- “*Improving is infringing*”

And now let's walk
in the French Labyrinth
of Infringement

The Labyrinth of Infringement



The key concepts

- same function = same "primary technical effect"
- same result = result of the same nature, regardless its quality and its degree

The Garden of Literal Infringement



*Statue of naïve
Nymph*

Do you literally reproduce
the claimed means
in their form and
in their function
for the same result?

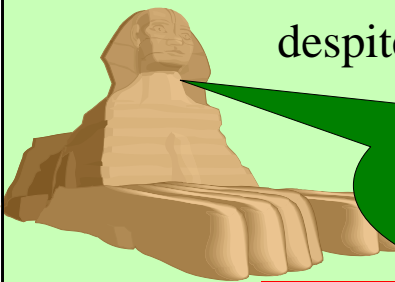
YES!

So, go into the Hell of
Infringement
and pay...

NO!

So you may either an innocent or an infringer
Go into the next Garden

The Garden of infringement by reproduction of the essential means, despite minor differences



*Statue of
impenetrable Sphinx*

Do the differences
between the claimed means
and the accused means
relate to essential means?

NO!

So, go into the Hell of
Infringement
and pay...

YES!

So you can be either an infringer
by equivalence or an innocent
Go into the Garden
of Equivalence

The Garden of Equivalence : prerequisite



Statue of Chimera

Do the claimed means implement a novel function?

YES!

So, the claim scope extends to the function : you may be an infringer by equivalence

Go to the next test

NO!

So, the scope of the claim is limited to particular means
You enter directly the Heaven of public domain

The Garden of Equivalence



Statue of Commander

Do you use means performing the same function for the same result?
(in the same way?)

YES!

Go into the Hell of Infringement
and pay...

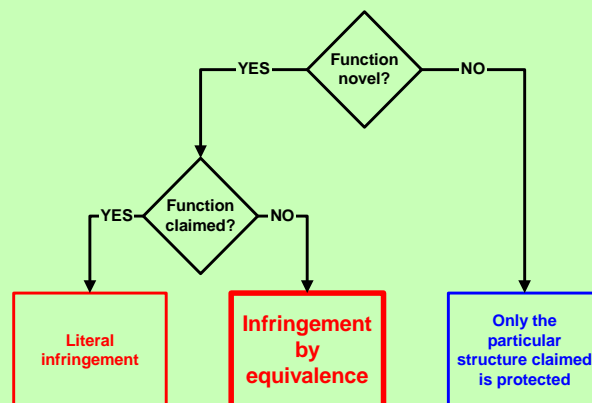
NO!

You enter the Heaven of public domain

Differences with other countries

- The theory of the so-called "*general means*"
- Obviousness
- "*Improving is infringing*"
- Intention of the patentee
- The prosecution history file

The theory of the so-called “*general means*”



Obviousness

- A German and English test
- Not taken into account in France

“Improving is infringing”

- If:
 - reproduction of the function
 - similar result
- Even if patentable

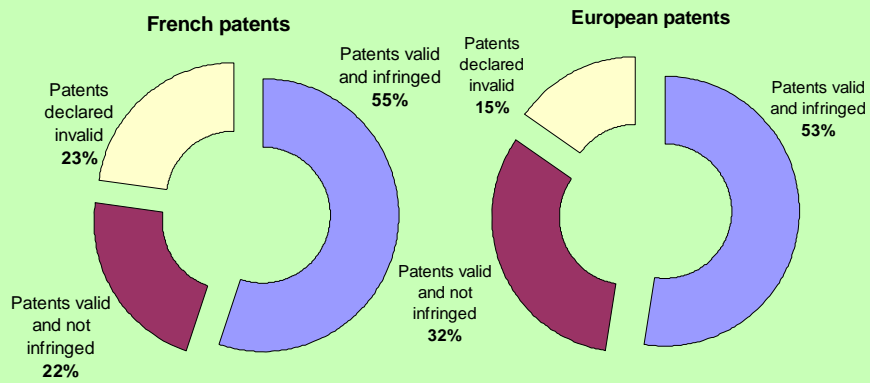
Intention of the patentee

- French appreciation is objective
- But: the teaching of the patent is considered

The prosecution history file

- No estoppel as such under French law
- But: prior statements are taken into account

French statistics



IBC - IP Law Summer School - 20 August 2002 - Isabelle ROMET - VÉRON & Associés

Conclusion

- Broad application
- Criticism
- Evolution?

IBC - IP Law Summer School - 20 August 2002 - Isabelle ROMET - VÉRON & Associés

22

Thank you for your attention