

## Netherlands

### Report Q 175

in the name of the Dutch Group  
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#### **The role of equivalents and prosecution history in defining the scope of patent protection**

##### **Subquestion 1**

*If your country has a doctrine of "equivalents", what is it and how are equivalents assessed? Is it provided for by statute or case law?*

##### **Short Answer**

In the Netherlands the concept of infringement by equivalence does exist. There is no statutory basis, however, and there is no Supreme Court case law which clearly defines the concept. In the event that one or more features of the patent claim is/are not literally present in the variant, the lower court will establish whether or not use has been made of equivalent measures. If the latter is established, the variant may be considered as an infringement. The so-called "function-way-result test"<sup>1</sup> has been upheld<sup>2</sup> as a means to establish equivalence. In lower decisions<sup>3</sup> mention has been made that in chemical cases use may also be made of the so-called "insubstantial differences test"<sup>4</sup> or the test that it must be assessed whether it is "obvious to a person skilled in the art that substantially the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element"<sup>5</sup>. Furthermore, it has been held in recent lower court decisions that so-called inventive variants do not qualify as an equivalent.

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<sup>1</sup> I.e. equivalent measures are measures which perform essentially the same function, in essentially the same way to lead to essentially the same result.

<sup>2</sup> Dutch Supreme Court (*Hoge Raad*) 13 January 1995, NJ 1995, 392 re Drezler vs. Remeha.

<sup>3</sup> E.g. District Court of The Hague, 28 October 1998, docket no. 98/0398 re Yamanouchi vs. Biogen.

<sup>4</sup> The District Court refers to Court of Appeal for the Federal Circuit in *Hilton Davis Chem. Co. vs. Warner Jenkinson Co.*, 114 F.3d 1161, 43 USPQ2d 1152 (CAFC 1997).

<sup>5</sup> The District Court refers to article 21 (2) of the WIPO Harmonisation proposal.

## Answer

Since 1930 the Dutch Supreme Court has applied the so-called “essence of the invention” doctrine to the interpretation of the scope of protection of a patent<sup>6</sup>. According to this doctrine, the scope of protection of a patent was not so much found in the claims, but rather by interpreting the claims in the light of that which constituted the “essence of the invention” as revealed in the document as a whole. The application of this doctrine usually led to a quite broad scope of protection.

The “essence” doctrine came to be criticised both in decisions by the lower Courts and in the literature after the ratification of the EPC in the Netherlands in 1978 as it was considered not to be in conformity with article 69 and the Protocol. The Dutch Supreme Court finally responded to this criticism in 1995 in the decision re Ciba Geigy vs. Ote Optics<sup>7</sup>. In this decision the “essence of the invention” is still taken as a starting point but no longer as the only decisive factor. The Supreme Court held as follows:

*"The aforementioned point of view, developed in Dutch case law, applied with consideration of Article 30(2) of the Dutch Patents Act 1910, comes down to that when the claims are interpreted, also against the background of the description and the drawings, also now that which is essential to the invention for which protection is sought must be taken into account - in other words: the inventive idea underlying the wording of the claims - in order to avoid an interpretation which would be based exclusively on the literal meaning of the wording and which would therefore be too narrow (or unnecessarily wide) to provide indications as to how, in that interpretation, the middle as meant in the Protocol can be found between a fair protection for the patentee and a reasonable degree of certainty for third parties. The judge called to interpret the claims of the patent will therefore also have to consider whether the result of his research sufficiently does justice to a reasonable degree of certainty for third parties. This last point of view may justify a restrictive interpretation, i.e. an interpretation which follows more closely the wording of the claims, in the sense that lack of clarity for the average person skilled in the art wanting to assess the limits of the protection afforded by the patent shall, in principle, operate to the detriment of the patentee. All of this should, however, be regarded in the light of the nature of the case*

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<sup>6</sup> Dutch Supreme Court 20 June 1930, NJ 1930, 1217 re Philips vs. Tasseron.

<sup>7</sup> Dutch Supreme Court 13 January 1995, NJ 1995, 391.

*at hand, including also the extent to which the patented invention brought about innovation."*

In its recent decision re Van Bentum vs. Kool<sup>8</sup> the Supreme Court reinforced its Ciba Geigy decision.

The Ciba Geigy decision has to some extent been criticised in the literature<sup>9</sup>. One of the points of criticism was that the Supreme Court did not make a proper distinction between literal infringement and infringement by equivalence. This would lead to a lack of predictability.

Whilst it is true that the Supreme Court has never made a clear distinction between literal infringement and infringement by equivalence, it has upheld lower Court's decisions where that distinction had been made, by putting these decisions within the context of the "essence" doctrine (as in Ciba Geigy). In fact, this happened on the very same day as Ciba Geigy was rendered, in the decision re Dreizler vs. Remeha<sup>10</sup>. In Dreizler vs. Remeha the Court of Appeal had considered that when there is no literal infringement the question of whether there is infringement under the doctrine of equivalence has to be answered. According to the Court of Appeal equivalent measures are measures which perform essentially the same function, in essentially the same way to lead to essentially the same result (the so-called "function-way-result" test). According to the Supreme Court this approach was in conformity with the "essence" doctrine given in Ciba Geigy. In its decision re Stamicarbon vs. Dow<sup>11</sup> the Supreme Court also upheld a Court of Appeal decision where the Court of Appeal had made a distinction between literal infringement and infringement by equivalence. As to the latter the Court of Appeal had applied the function-way-result test. The Supreme Court in addition held that a measure that leads to a much less than optimal result (less than intended by the invention) is not an equivalent measure.

A question which has been considered by the District Court in The Hague was whether the "function-way-result" test is an appropriate test for judging equivalence when the patent protects a chemical compound. In its decision re Yamanouchi vs. Biogen<sup>12</sup> the District Court held that in these cases instead of the "function-way-result" test use may be made of the so-

<sup>8</sup> Dutch Supreme Court 29 March 2002, NJ 2002, 530.

<sup>9</sup> *Inter alia* J.H.J. den Hartog, *De beschermingsomvang van octrooien*, BIE 1996, pages 83-85. A very nice overview of literature and case law can be found in the thesis of H. Bertrams, *Equivalentie in het octrooirecht*, Utrecht 1998.

<sup>10</sup> Dutch Supreme Court 13 January 1995, NJ 1995, 392.

<sup>11</sup> Dutch Supreme Court 5 September 1997, NJ 1999, 410.

<sup>12</sup> District Court of The Hague, 28 October 1998, docket no. 98/0398.

called “insubstantial differences test<sup>13</sup>” or the test that it must be assessed whether it is “obvious to a person skilled in the art that substantially the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element<sup>14</sup>”.

A topic on which no final answer has yet been given is that of the so-called “inventive equivalents”. An inventive equivalent has been defined as a variant at which the skilled person could only arrive by using inventive activity, to such an extent that the variant appears to be patentable. The Court of Appeal in The Hague has held that these variants, although perhaps equivalents, must not be considered as an infringement, as that would be contrary to the certainty for third parties as required by article 69 EPC and the Protocol<sup>15</sup>. This approach has been criticised in the literature<sup>16</sup> and so far the Supreme Court has not ruled on it.

### **Subquestion 2**

*Can the scope of patent protection change with time, or is it fixed at a particular time. And if fixed, at what time?*

### **Short Answer**

Dutch case law is not clear about which point in time should be the reference time for the skilled reader to assess the scope of protection and, consequently, to assess the equivalence of an alleged variant. In a case by case approach lower Dutch Courts have applied both fixed and variable assessment dates, although there seems a tendency to prefer the (variable) date of (preparation for) the alleged infringement. The Supreme Court, which recently had the opportunity to rule on the issue, chose not to do so.

### **Answer**

What an equivalent is and how it is to be assessed is in essence no other question than the question what extent of protection is conferred by the patent when literal infringement of the patent can not be established. Scope of protection is assessed via the generally accepted person skilled in the art-concept. A concept whereby a certain degree of knowledge is assumed to be available for an average person skilled in the art when assessment

<sup>13</sup> The District Court refers to Court of Appeal for the Federal Circuit in Hilton Davis Chem. Co. vs. Warner Jenkinson Co., 114 F.3d 1161, 43 USPQ2d 1152 (CAFC 1997).

<sup>14</sup> The District Court refers to article 21 (2) of the WIPO Harmonisation proposal.

<sup>15</sup> Court of Appeal of The Hague 12 September 1996, BIE 1997, 319 re Hoffmann LaRoche vs. Organon, see also Court of Appeal of The Hague 5 September 2002, docket no. 02/8 re Nannings van Loen/Van Vuuren.

<sup>16</sup> Bertrams, page 271. See also E.A. van Nieuwenhoven Helbach, *Industriële Eigendom, Deel I*, Deventer 2002, page 215.

(interpretation) of the claims and assessment of the question whether or not an element is equivalent to an element specified in the claims is made.

The Court of Appeal the Hague has repeatedly admitted that it is not possible to define the scope of protection forever “as the scope will depend on the specific infringement at stake and a selection of prior art”<sup>17/18</sup>. Although one has to be reticent at this point, this might indicate that the Court of Appeal The Hague confirms that knowledge will change (usually increase) as time goes by and that assessment by the “reference man” at different points in times might result in different scopes of protection

However, Dutch case law is not at all clear at what precise point in time the reader skilled in the art should assess the patent claims and consequently assess at what time whether or not an equivalent falls within the scope of protection. In assessing the scope of protection, decisions of lower Dutch Courts do apply sometimes a fixed date similar to Germany (knowledge at the filing or priority date) or the UK (knowledge at the publication date). Quantity wise more decisions have been rendered by the Dutch Courts that apply a variable date, in most cases the alleged infringement date.

The Dutch Supreme Court has not decided to date on the question what date is the relevant reference date in determining the scope of protection. The last known opportunity to decide on this question was brought before the Supreme Court in 2000<sup>19</sup>. An opinion was rendered by the Advocate-General who after careful consideration chose for the variable date (i.e. date of the infringement). The Supreme Court, however, did not deem necessary to render a judgment on the issue.

### **Subquestion 3**

*Does the prosecution history play a role in determining the scope of patent protection? If so, how does it work? In particular:*

- a) *Is there ‘file wrapper estoppel’ and if so in what circumstances does it arise?*
- b) *Is there a difference between formal (e.g. oppositions) and informal (e.g. discussions with examiners) actions in the patent office?*

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<sup>17</sup> Court of Appeal, The Hague, February 20, 1992, BIE 1992, 70 (Epilady/Improver).

<sup>18</sup> Court of Appeal, The Hague, January 30, 2001, BIE 2001/62 (Epenhuysen/Diversey).

<sup>19</sup> Supreme Court, November 2, 2001, NJ 2001/686 (BT vs. KPN and Plumettaz).

- c) *Is there a difference between actions taken by the patent office and by third parties?*

### **Short Answer**

In the Netherlands the prosecution history in theory plays a role in determining the scope of patent protection only if, after consideration of the description and the drawings, reasonable doubt exists as to the interpretation of the claims. A notion similar to the common law "File wrapper estoppel" only applies when it appears from the public record that the patentee had good cause to relinquish part of the scope of protection. Both answers are laid down in Supreme Court case law.

### **Answer**

In principle, third parties should consult the file history to assess the scope of the claims. The Dutch Supreme Court has ruled in 1989 that third parties *only* may assume that the patentee has wanted to limit himself by the chosen wording of the claims if therefore, based upon the content of the patent and possible other known facts, like e.g. the granting file, good reasons do exist<sup>20</sup>.

However, in 1995 the Supreme Court considered that the file history need not be consulted by a third party if he has, based upon the description of the patent and the claims, no reasonable doubt as to the (limited) scope of the claims<sup>21</sup>.

The Supreme Court has confirmed this approach in 1997<sup>22</sup>. It was decided that if it was clear from a claim how its contents should be explained, the Court of Appeal was not obliged to investigate the contents of the file history to determine the closest state of the art (although the parties had referred to the file history) to arrive at a possible broader scope of the claims.

In 2002 the Supreme Court reaffirmed that the general rules given in *Ciba Geigy and Meyn Stork* are (both) still applicable, i.e. that the average person skilled in the art must determine what is the essence of the invention, and that he may *only* assume that the patentee has limited

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<sup>20</sup> Dutch Supreme Court (*Hoge Raad*), 27 January 1989, NJ 1989, 506, re *Meyn vs. Stork*.

<sup>21</sup> Dutch Supreme Court, 13 January 1995, NJ 1995, 391, re *Ciba Geigy vs. Oté Optics*.

<sup>22</sup> Dutch Supreme Court, 5 September 1997, NJ 1999, 410, re *Dow vs. Stamicarbon*.

himself to a certain part of that “essence”, if therefore, taking into account the patent (description) in the light of possible other known facts, and also the facts known to the skilled person from the public part of the file history, good grounds exist, unless no reasonable doubt can exist as to the limited scope of the claims<sup>23</sup>.

- a) There is in the Netherlands no principle as “file wrapper estoppel” as such, as this is a common law principle.  
Based upon case law (which has been outlined above) the scope of a patent does not extend to equivalents if 1) a third party has no reasonable doubt to assume a broader scope of protection based upon the claims and the patent itself, or 2) if a third party can demonstrate that, based upon the patent and upon other facts known to the third party, “good grounds” do exist to assume that patentee had limited himself to a certain variant of the essence of it’s invention.
- b) There is no difference in the value of arguments of formal or “informal” actions<sup>24</sup>. When minutes are made public (e.g. nullity advices before the BIE) these could equally well be used to assess the scope of protection.
- c) Likewise, there is no formal difference between actions taken by third parties or by the Patent Office. What counts is what the Patent Office decides in the end and what the patentee states during examination of the patent. In general, more weight is likely put towards the remarks of the Examiner than to those of a third party.

#### **Subquestion 4**

*Is there any way the scope of claims can be limited outside prosecution, e.g. by estoppel or admissions?*

#### **Short Answer**

Estoppel or admissions during prosecution (unfortunately the working guidelines do not provide a definition of either term) may constitute arguments to be considered by the court to limit the scope of claims. Outside prosecution, the scope of claims can only be limited in a legally

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<sup>23</sup> Dutch Supreme Court, 29 March 2002, RvdW 2002, 64, re Van Bentum vs. Kool.

<sup>24</sup> Under the Dutch Patent Act 1995 no material examination of patent applications takes place, but patentees still have the opportunity to amend their claims after the search report; such amendments could be considered as waiver of protection.

binding manner by court decision or by (partial) statutory abandonment by the patentee.

### **Answer**

#### Court decision

In the Netherlands, the court has the authority to limit the scope of claims after granting.

In an infringement case, the court will determine the scope (of protection) of the claims. In doing so the court can *de facto* and *inter partes* limit the scope of the claims as a result of its interpretation of the claims. In subsequent cases regarding the same patent the court will, in principle, follow the interpretation given in the earlier decision, unless new arguments and facts convince the court to deviate from its earlier interpretation.

In an invalidation case, however, the court may nullify the patent in part, amending and so limiting (the scope of) one or more claims. Such a decision is binding and works *erga omnes*.

When the court is asked to limit the scope (of protection) of claims, it may take into consideration, but is not bound by, e.g. arguments based on prosecution history estoppel, statements or representations by or on behalf of the patentee in or outside court, foreign decisions regarding the national patents deriving from the same European patent or parallel patents.

#### Abandonment

According to article 63 of the Patent Act of the Realm 1995 a patent may cease to exist in whole or in part as a result of the patentee's formal abandonment of the patent in whole or in part. Partial abandonment may constitute a limitation of the scope of the claims. Abandonment is effected by registration of a written statement of the patentee to that effect in the public register.

### **Subquestion 5**

#### **Recommendations**

1. Equivalence

When determining whether a variant may be considered an equivalent – and therefore an infringement – it does not always do justice to a fair protection of the patentee to perform a strict "feature by feature" analysis. Rather, the invention as laid down in the relevant claim should be taken into account when assessing equivalence.

2. Time of assessment

From a legal certainty point of view there is a need for clarity as to the date of reference. In order to avoid that the patentee can not protect his invention against variants he could not have anticipated during prosecution, there is a preference for a reference date at the time of the alleged infringement.

3. Prosecution history

It may in theory be desirable to disregard the file history when assessing the scope of protection of claims granted by the EPO. The reality is, however, that the EPO, when granting amended claims, often disregards its duty to make sure that the applicant amends the description accordingly. Thus, claims are granted which can not or not easily be interpreted with the help of description and drawings, as Article 69 requires.

As long as this EPO practice persists, to rule out the relevance of the file history of a patent when interpreting its scope would not do justice; probably more often to a reasonable certainty, but possibly also to a fair protection; both as mentioned in the Protocol to Article 69 EPC. Consultation of the file history is a natural and practical way of finding the context the applicant and the patent office intended for the interpretation of the claims.

#### 4. Scope Limitation

When interpreting claims of European patents, national courts of EPC countries are well advised not only to take into consideration, but also to refer in their decisions to any decisions – if brought to their attention – by courts of other EPC countries limiting or not limiting the scope of protection of national patents deriving from the same European Patent.