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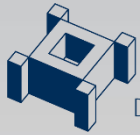
DEFENDING CREATIVITY WITH TAILORED PROTECTION

THE DOCTRINE OF EQUIVALENTS IN THE PATENT INFRINGEMENT

**The doctrine of equivalents
in the software and ICT domain**

MILANO, 15 JUNE 2018

Corrado BORSANO



Art 52 CBE :

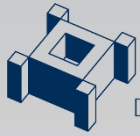
(2) The following in particular shall not be regarded as
(*patentable*) inventions:

(a) discoveries, scientific theories and mathematical methods (*algorithms*);

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

(3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent **relates to such subject-matter or activities as such**.



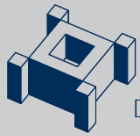
Software-related patentable inventions

- Software as such is not patentable.
- However it could be patentable in the cases of presence of technical results - software-related inventions
- The EPO considers patentability of software in case of presence of further technical effects going beyond the normal physical interaction between HW and SW (G3/08 - EboA decision)
In this case computer program claims are also allowable

Rule 43 EPC

Form and Content of Claims

- The claims shall define the matter for which protection is sought in terms of the technical features of the invention.



Problem-Solution Approach

Is there a technical problem to be solved?



Is there a deficiency in the known solutions rendering them useless to the purpose?



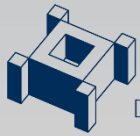
Is there a basic idea
for solving the technical problem
In a non obvious way vis-à-vis the known solutions ?



TECHNICAL SOLUTION



TECHNICAL EFFECT



Patentable aspects

Software architecture aspects

For example:

Network management or service management architecture

Internet or multimedia software architecture

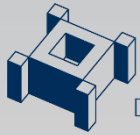
Software methodology aspects

For example:

Method of searching an object in an object library

Method for retrieval of stored graphs

Method to maintain the containment between objects



Patentable aspects

Kernel or System software

Software for:

Operating system

Data base management

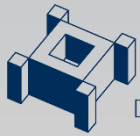
User interface

Application software

Software for:

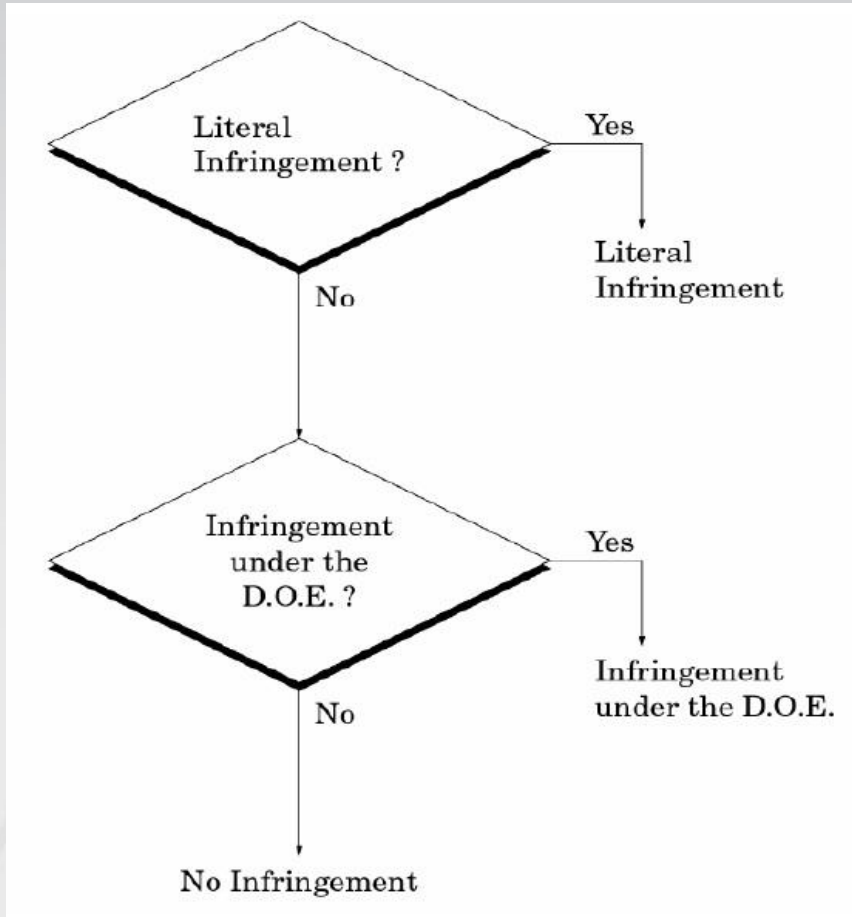
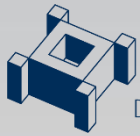
Typical functions for specific applications

Network services

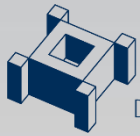


EXAMPLES





INFRINGEMENT BY EQUIVALENTS



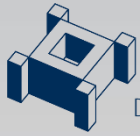
INFRINGEMENT BY EQUIVALENTS

OBVIOUSNESS TEST

.. *for example, Decision of Corte di Cassazione, Sezione I civile, 13 gennaio 2004, n. 257*: "... .. to assess whether the realization accused of infringement can be considered equivalent to the patented one, it is to be considered whether, in allowing the same final result, it presents originality, offering a non-trivial or repetitive answer to the patented one: and this is the one that exceeds the competence of the average technician who is facing the same problem. Only in this case can the solution be considered to be outside the idea of a protected solution "

TRIPLE TEST

..... whether the product elements under test develop
"..... substantially the same function, substantially in the same way, to obtain substantially the same result ... (*as claimed...*) "

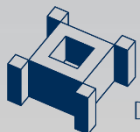


INFRINGEMENT BY EQUIVALENTS

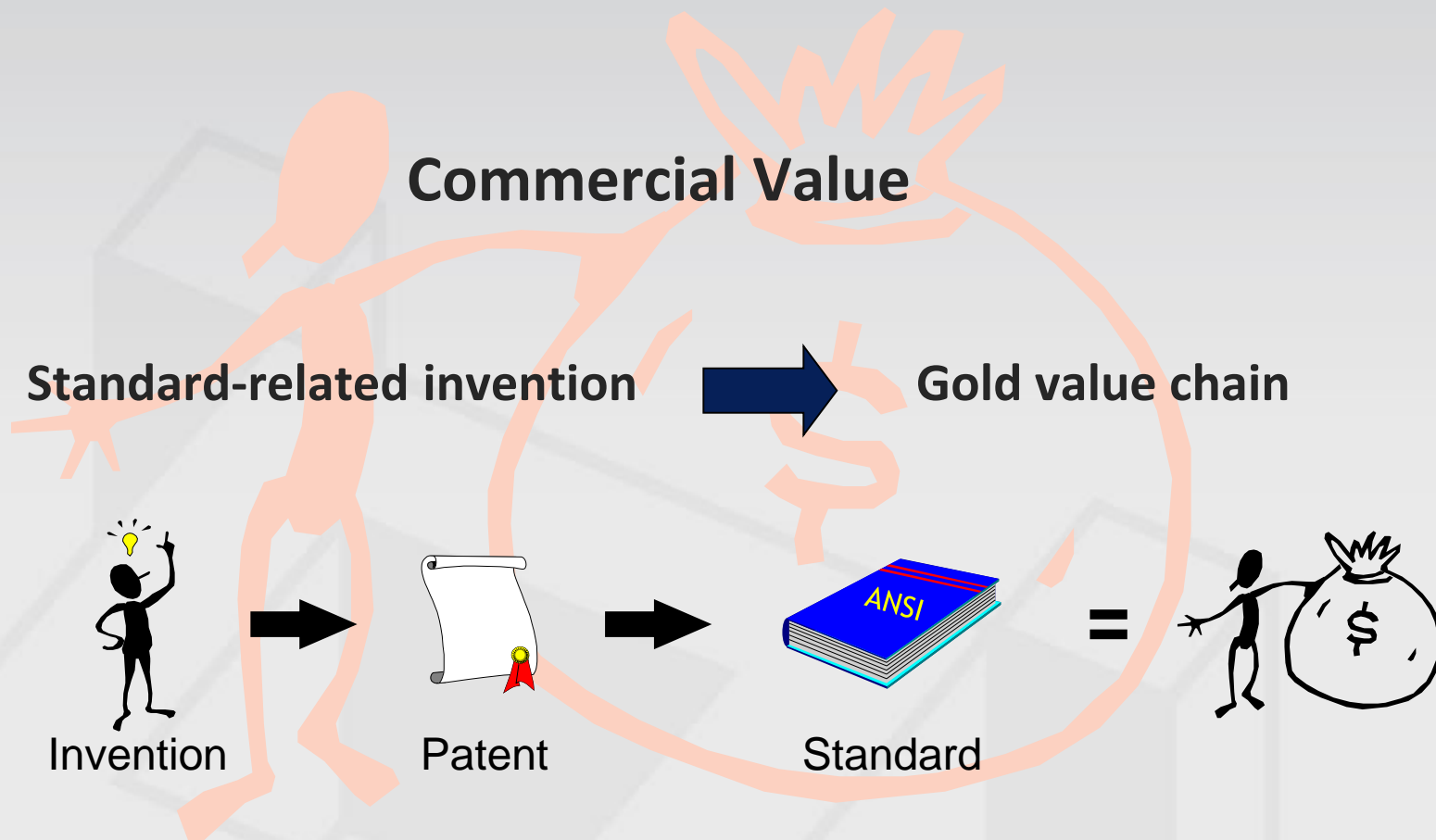
What means equivalent in the software infringement ?

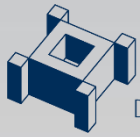
to be checked in the technical results

Claim formulation / wording







Patents vs. Standards

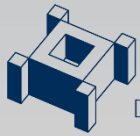




Preparing Claim charts

comparing claim characteristics of a granted patent with:

- features of product under test  reverse engineering necessary ? / description request to the Judge ?
- features of a standard in the ICT domain  reverse engineering necessary ? / description request to the Judge?
- features described in some possibly available documents of the alleged infringer (user manuals....)  reverse engineering necessary ? / description request to the Judge?
- evaluation of the software characteristics/listing/source code/object code necessary ?  description request to the Judge ?



Thank you for your attention!

Additional information and the full version of the presentation could be requested to:

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www.metroconsult.it



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