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Claimed ranges and patent infringement under the doctrine of equivalents

In the recently published decision of Geratherm Medical AG v Gima SPA (Decision 12657/2015) the Court of Milan ruled that patent protection for a numerical range of values cannot be extended under the doctrine of equivalents to cover a numerical value that falls even slightly outside that range.



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Relevant legal provisions

Article 64(3) of the European Patent Convention (EPC) states that infringement of a European patent shall be dealt with by national law.

Articles 52(2) and (3) of the Industrial Property Code are consistent with Article 69(1) of the EPC, which states that the extent of protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings may be used to interpret the claims.

Article 52(3bis) of the code also requires consideration of any elements equivalent to an element indicated in the claims when determining the scope of patent protection.

Background

When a patent includes an explicit range of numerical values, the assessment of literal infringement is relatively straightforward. However, under the doctrine of equivalents a party may try to enforce its patent even if the allegedly infringing product or process does not fall within the literal claimed range, but is somewhat close. The question then is how close is close enough?

As discussed in "Court of Cassation rules on patent infringement by equivalence", Italian courts have consistently held that a patent is infringed under the doctrine of equivalents when:

- the differences between the allegedly infringing product or process and the patent claim(s) do not make the product or process original over the claimed invention; or
- the allegedly infringing product or process reproduces the “core” of the patented invention, even if it does not reproduce all the features of the patent claim(s).

Facts

Gima SpA marketed and sold clinical thermometers having mercury-free thermometric fluid comprising precisely 62.2% by weight of gallium. These products were produced for Gima by a company based in China.

In 2012 Geratherm Medical AG sued Gima before the Court of Milan alleging, among other things, infringement of European Patent EP 1 477 786 ('EP'786') and European Patent EP0657023 ('EP'023'), both owned by Geratherm. Geratherm's EP'786 claimed mercury-free thermometric fluid containing gallium in a concentration less than 65%, while EP'023 claimed the same type of fluid with the concentration of gallium being between 65% and 95%. With respect to EP'023, Geratherm argued that although the Gima product did not literally infringe EP'023 (because 62.5% was not within the 65%-95% range), there was still infringement under the doctrine of equivalents because the percent gallium weight in Gima's product was close to the lower end of the claimed range and because it allegedly performs the same function in the same way to achieve the same results as the claims of EP'023.

Decision

The Court of Milan found that EP'786 was partially invalid based on prior art grounds and, in any case, that Gima enjoyed the benefit of a licence obtained by the Chinese producer of the product from the original inventor that shielded it from infringement of EP'786.

With respect to EP'023 the Court of Milan agreed with Gima and found that Gima's product with 62.5% gallium weight did not infringe the claimed range of 65%-95% gallium weight because it fell outside the range, and even a small deviation from a specifically claimed range is not negligible. The court further indicated that the doctrine of equivalents did not apply because it should apply only in situations in which the precise boundaries of the claims at issue are not clear. The court noted that a claimed numerical range of values is a clear "statement of intention of the inventor" which could not be redefined during litigation.

The court thus concluded that Gima's product did not infringe EP'023 under the doctrine of equivalents. In so holding the Court of Milan established that, under circumstances such as these, the doctrine of equivalents should not apply because a numerical range associated with a technical feature that is explicitly disclosed in a claim should be construed narrowly.

Further, the novelty and inventiveness of Geratherm's EP'023 patent depends on the selection of the specific gallium concentration values in a thermometric fluid. Both the specification and the claims of EP'023 expressly recited the level of gallium to be between 65% and 95% by weight. Therefore, the Court of Milan refused to extend exclusive rights to a broader range.

Comment

The Court of Milan's decision appears to depart from the general approach established by Italian courts for assessing infringement under the doctrine of equivalents in the mechanical field. More specifically, when the claims of a patent include a specific numerical range as in this case, a challenged product or process does not infringe if the

corresponding value or range presented by the product or process falls outside that which was claimed – even if it misses the claimed numerical range by a relatively small amount.

It remains to be seen whether the court would have taken the same position if the patent description had explicitly stated that the limits of a claimed numerical range were intended to include a measurement tolerance (eg, a tolerance of 5%). In addition, the extent to which the court's invalidity ruling concerning EP'786 may have influenced its analysis with respect to EP'023 is unclear, as the court did not discuss in detail the relationship between these two findings.

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