

Mexico

Applying the doctrine of equivalents in patent litigation

The scarcity of patent litigation cases in Mexico as compared to other jurisdictions has resulted in a lack of case law in several key areas of patent litigation. One such area is the situation where a product does not have all of the features of the claims of a granted patent, but is so close that it appears that a feature was changed to circumvent patent coverage through the incorporation of an equivalent feature. Under US practice, this is known as the ‘doctrine of equivalents’.

Concept of equivalent features

In addition to the legal definition that every jurisdiction gives to the term ‘claim’, in patent practice this term is understood to be a technical description of certain features that are considered essential in a patented invention, and which by virtue of such essential nature define the invention as unique. Such features are what make the invention special and are thus protected by the patent. Consequently, only those products or processes having all of the essential features recited in at least one of the claims of a patent would be considered to infringe that patent.

However, the interpretation of a claim is dependent on how it is written; the skill and experience of the drafter of a claim and the knowledge available to him or her at the moment of drafting determine the writing of the claim.

Accordingly, a badly written claim will make it harder to enforce that claim, thus giving infringers an opportunity to circumvent patent rights by making modifications that still fall under the teachings of the patent at issue. Therefore, under the doctrine of equivalents, the patent should be considered to be infringed if some of the claimed features were substituted by other features that are ‘equivalent’ or perform the same function as the claimed feature.

Sections XI, XII, XIII and XIV of Article 213 of the Industrial Property Law state that an infringement occurs when a patented product or process is exploited

through means reserved to the patent holder. However, the law is vague in the sense that there are no rules for determining what constitutes a ‘patented product’ or a ‘patented process’; rather, there is only the indication that the rights conferred by a patent shall be determined by the granted claims (Article 21 of the law), and that such claims should be interpreted by the description and drawings.

This lack of clarity in the interpretation of patent infringement, which mostly affects the patent holder (which must prove the strict violation of the patent claims), should allow for the application of the doctrine of equivalents without the need for amendment of the Mexican law.

Conceptually, the doctrine of equivalents is necessary to protect the patent holders from copies of their patented inventions that are expressly designed to avoid the language of the granted claims, but, at the same time, use the fundamental principles described in the patent.

Express exclusion of features during prosecution

The use of the doctrine of equivalents can, however, lead to abuse by patent holders by broadening the scope of the originally granted claims to features that the patent holder did not originally consider for protection. Under this approach, the public will never be able to read the claims and determine the actual scope of the granted exclusivity, thus potentially leading to abuse and a lack of clarity under the patent system.

Accordingly, a necessary tool for a defence to infringement under the doctrine of equivalents is prosecution estoppel, which is equally applicable under Mexican law due to the vagueness described above.

Thus, the patent rights must cover – under the doctrine of equivalents or otherwise – any form in which an invention could be copied, unless the patent holder has previously expressed the clear intention to exclude any such form.

The ‘unforeseeable’ feature and equivalents

More recently, the criteria adopted and broadly studied in the United States, derived from cases such as *Jonson & Johnston Ascots Inc v RE Serv Co* (2002) and their further clarification in *Festo Corp v Shlketsu Kinzoku Kogyo Kabushiki Co* (2003), have shown the evolution of the doctrine of equivalents:

- If the equivalent feature is the result of a technology that was developed on a date later than the filing date of the patent, it would have been impossible for the patent holder to include such feature in the patent.
- Once the new technology has been developed, those skilled in the art can combine the knowledge of the patent with the new technology, thus obtaining a result which those skilled in the art would expect based on the later developed knowledge, by virtue of which such a feature would be considered equivalent and should be considered as infringement. If the feature that is allegedly equivalent was part of the prior art, the analysis must show whether those skilled in the art could have inferred or foreseen that the feature in question could be substituted by another feature.

As infringement is an act that occurs after a patent application has been filed and granted, the modification for the sake of equivalence always happens after the event. Therefore, if the possibility of modifying the feature was evident before the event to those skilled in the art, a product with features that were foreseeable but not claimed would not be covered by the patent because the patent holder had the will to exclude such foreseeable features or variations from protection, given that he or she is a person skilled in the art.

However, unlike in the United States, in Mexico, patents can be filed and prosecuted by any person, and inventors commonly file patents on their own without using a patent agent. Furthermore, there are no certifications available for patent prosecutors in Mexico, and therefore the quality of prosecution and drafting of certain patents is questionable. The criteria described above are certainly good for a jurisdiction that has an advanced level of development in the patent system, led by certified professionals in patent prosecution.

Equivalence under Mexican law

Literal approach to infringement

Several articles of the Industrial Property Law are relevant for interpreting the claims of a patent in case of infringement. Article 12 defines the term ‘claim’ as the essential feature of an invention which defines the scope of the patent (under Article 21).

Similarly, Article 25 expressly sets out the rights that are reserved to the patent holder, including the possibility of preventing others from using patented products and processes and from manufacturing, selling, offering for sale or importing patented products or processes. The law uses the vague expression ‘patented product’ or ‘patented process’, which refers not to the claimed invention, but rather to the protection given by the patent.

The interpretation of patents in Mexico is also affected by Article 12 of the Agreement Establishing the Rules for Filing Applications before the Mexican Institute of Industrial Property (IMPI). This article expressly governs the practice of drafting claims in two parts by stating that, when applicable, the claims of a Mexican patent must contain a first part describing features of the prior art that are essential for the practice of the invention, followed by the words ‘characterised in that’ or a similar phrase, after which the novel and inventive features for which protection is sought must be listed.

This legal framework makes it clear that Mexican law requires a literal approach to be taken in order to determine infringement. In other words, in order to determine whether a product infringes a patent under Articles 213 and 21 of the Industrial Property Law, an infringing product must contain every feature of at least one patent claim. Accordingly, technically it must be proven that all of the essential features of the claim are present in the infringing product in order for it to be considered an infringement. Here, the essential nature of the features in a claim must be emphasised, because this means that the number of features in the claim is the minimum number of features that must be present in a product or process in order for it to be considered to be the ‘patented product’ or the ‘patented process’, depending on the specific writing of the claim itself with regard to the terms ‘comprising’, ‘consisting of’ or similar.

Consequently, if the allegedly infringing product lacks at least one of the essential features of a claim, under a literal approach it cannot be considered to infringe the patented invention, as it lacks one of the features defining its essence.

Infringement when one essential feature is substituted by another

One of the main requirements for the doctrine of equivalents to apply is that at least one of the features in a claim not be present in the infringing product. This means that the literal approach to infringement must have led to a negative result.

“ In order to determine whether a product infringes a patent under Articles 213 and 21 of the Industrial Property Law, an infringing product must contain every feature of at least one patent claim ”

Strictly speaking, given that the Industrial Property Law does not establish a specific criterion for determining whether a process or product is patented, and given the failure of the literal infringement approach, the first conclusion could be that there is no infringement.

However, Article 21 of the law clearly states that the claims can be interpreted in light of the description and drawings; therefore, it is clear that under the law the claims can be interpreted beyond the way in which they are actually written.

Accordingly, where infringement could not be established under the literal approach because at least one of the essential features was not present in the allegedly infringing product, the nature of such feature must still be analysed in order to determine the possibility of infringement through an equivalent feature in the context of the description and drawings of the patent.

Under the IMPI filing rules, when a patent is drafted in two parts it is also important to consider that not all of the features in the claim are novel and inventive, but only those after the characterising phrase. This involves consideration of the balance to be achieved by the public in understanding what is known and what is new and can be substituted by an equivalent.

Accordingly, if an allegedly infringing product is different from the patent claims in a feature that is part of the prior art portion of the claim and not part of the characterising portion, it could be understood that the inventor sees these features not as novel and inventive, but rather as necessary to practise the invention. Therefore, the lack of such a feature in the infringing product must clearly be considered equivalent if all of the features in the characterising portion are present in the same product. This is consistent with the doctrine of equivalents because in this case, clearly the novel and inventive features of the invention are being used by the

infringing product even though the prior art features were substituted or even eliminated.

The characterising portion supposedly includes the features that are intended to be protected and that are therefore novel and inventive. In principle, the absence of these features could lead to a fundamental difference from the infringing product. Therefore, under the traditional approach to equivalent features, such a feature must be analysed according to its function and in the context of the description in order to determine whether it has been substituted by an equivalent feature.

Although the IMPI filing rules provide an initial guide to the interpretation of claims, the analysis of equivalents in Mexico cannot be reduced to this type of claim because some patents do not include such drafting, and the fact that a product does not have a certain feature it does not mean that it has not been substituted by another equivalent feature.

Therefore, the same analysis of whether a person skilled in the art could substitute such a feature for an equivalent feature in light of the description and drawings must be carried out for all features in the claim, just as in the case of the features in claims drafted in two parts with a characterising portion.

Evidently, this criterion is inconsistent with some US decisions in terms of foreseeable features, but two differences justify this criterion under Mexican law and practice with regard to the United States.

First, as mentioned above, the Mexican patent system has no registry of certified professionals qualified for patent prosecution before the IMPI. Accordingly, many patents are filed directly by inventors or by legal professionals who are not necessarily skilled in patent prosecution. Therefore, the holders of such patents would be unable to use the doctrine of equivalents and would have no recourse against copies of their inventions with obvious and insignificant variations or changes.

In addition, if the claim included a feature which the patent holder had expressly excluded from protection during prosecution, it would have been either excluded from the claim or put in the prior art section of a two-part drafting. Both these issues must be corrected through a nullity action before the same patent office, which is a separate proceeding – unlike in the United

States, where validity and infringement are analysed by the same court concurrently.

Therefore, it appears that for Mexican practice, an approach similar to that taken in *Graver Tank & Manufacturing Company v Linde Air Products Company* (1950) and later in *Warner Jekinson v Hilton Davis Chem* (1997) would be more suitable.



Juan Carlos Amaro

Partner

camaro@bcb.com.mx

Becerril, Coca & Becerril, SC

Mexico

Juan Carlos Amaro is an attorney at law. He joined Becerril, Coca & Becerril, SC in 2004 and became a partner of the firm in 2010. He is a member of the International Trademark Association, the American Intellectual Property Law Association, the International Association for the Protection of Intellectual Property Mexico, the International Chamber of Commerce, the *Barra Mexicana Colegio de Abogados* and the Intellectual Property Owners association, where he participates in the litigation and international trademark law and practice committees. Mr Amaro has participated in several forums on IP matters and has published various articles in different media. He focuses his practice on IP and administrative litigation, anti-counterfeiting and constitutional law. He is mainly involved in representing pharmaceutical clients in patent litigation.



Héctor Chagoya

Partner

hchagoya@bcb.com.mx

Becerril, Coca & Becerril, SC

Mexico

Hector E Chagoya is a chemical engineer. He joined Becerril, Coca & Becerril, SC in 1997 and became a partner in 2010. He is in charge of the firm's technology transfer activities and advises on patent strategies, patent litigation and licensing. He is international vice president of the Licensing Executives Society International 2011 and part of various other national and international associations related to Intellectual Property and Chemical Engineering. Mr Chagoya is the first person in Mexico to achieve the Certified Licensing Professional™ certification and is recognised as a leading patent practitioner.