

# Italy jurisdiction report: Application of the doctrine of equivalents in Italy

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When confronted with the question of whether a technical solution infringes a patent, it is crucial to assess the scope of protection of the patent.

Article 52 CPI (the Italian Patent Law) rules that the scope of protection of a patent is determined by the claims, and further explains that (i) the description and the drawings may be used for the interpretation of the claims; (ii) the scope of protection should balance a fair protection for the inventor with a reasonable legal certainty for the third parties; and (iii) that for assessing the scope of protection, elements which are equivalent to those recited in the patent claims must be considered.



Indeed, article 52 CPI is aligned to the Protocol on the Interpretation of Article 69 of the European Patent Convention (EPC), which expressly refers to the doctrine of equivalents.

Hence, patent infringement may occur either literally or under the doctrine of equivalents. It is generally acknowledged that “literal infringement” occurs when every limitation recited in a claim is literally reproduced by the allegedly infringing device or process, thus requiring each feature included in the claim to have identical correspondence in the allegedly infringing device or process.

In this context, “infringement under the doctrine of equivalents” is a less strict requirement to be met and expands the coverage of the patent claim.

## Two approaches

To assess whether a feature of an allegedly infringing device or process is equivalent to a corresponding feature of the claim, the two main approaches are as follows:

- The function-way-result approach, derived from US case law, requires that the equivalent element performs substantially the same function in substantially the same way and produces substantially the same result as the corresponding claimed element.
- The obviousness approach, derived from German case law, requires that it be obvious to a person skilled in the art that the same result as that achieved by means of the claimed element can be achieved by means of the equivalent element.

According to the US case law, the doctrine of equivalents does not apply to those features that have been added to the claims through substantive amendment, to overcome the examiner’s objections; this limitation of the application of the doctrine of equivalents is called “prosecution history estoppel”.

In recent years, there have been several decisions in the Italian courts that seemed to adopt a prosecution history estoppel, similar to US practice.

For example, decision N. 54470/2016 (September 10, 2017) of the Milan Court ruled that, if a patent is subject to substantive amendments, the doctrine of equivalents should not apply to those features.

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On June 10, 2015, the Appeal Court of Bologna held that the Italian fraction of European Patent EP1027120B1 in the name of Proras was not infringed by Nuova Rivart, arguing that the doctrine of equivalents should not be applied to features that were added by the patentee through amendments before the European Patent Office.

It is noteworthy to observe that these features added during the examination phase included (i) a step of preliminary filtration (ii) for stopping particles larger than 10 microns; apparently, limitation (i) was arguably enough to overcome the prior art, whereas the addition of limitation (ii) in the claim had been necessitated to comply to the requirement of not adding new subject matter, set out in article 123(2) EPC. However, this decision has been appealed before the Supreme Court.

The Supreme Court, with decision N. 2977, dated February 7, 2020, reversed the decision of the Appeal court, arguing that the doctrine of equivalents should have been applied to all the claim features, regardless of the arguments set forth by the applicant before the patent office during the examination phase, in compliance to article 52 CPI.

For the discussion of the technical equivalence, the Supreme Court kept the choice of the approach open, although it adopted the obviousness approach and argued that, to assess infringement, one should ask whether the person skilled in the art, having regard to his common general knowledge, would have seen the feature of the accused product as an obvious alternative to the corresponding feature recited in the claim.

Thus, it appears that the Italian Supreme Court expressly ruled out the application of the “prosecution history estoppel” doctrine to infringement assessment.

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