

**Sweden**  
Suède  
Schweden

**Report Q175**

**In the name of the Swedish Group  
by**

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**The role of equivalents and prosecution history in defining the scope of patent protection**

Question 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?*

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Swedish courts apply the doctrine of equivalence. It is provided for by case law and is not expressly included in the Swedish Patents Act (Patents Act).

Section 39 Patents Act deals with the scope of patent protection. This section corresponds to Article 69 of the European Patent Convention (EPC). Thus, the Interpretation Protocol to Article 69 is used in Swedish courts as a tool in the evaluation of the scope of the patent protection also in infringement cases.

For evaluation whether the doctrine of equivalence can be applied, a number of circumstances have been identified according to Swedish doctrine and court practice as being of interest:

- Whether the contested embodiment, or the infringing act, solves the same problem or has the same function as the patented invention.
- Whether the contested embodiment provides a solution of the problem similar to the solution as represented in the patent, and whether the similarity between the solutions would be obvious for a person skilled in the art. If differences prevail in respect of more than one feature it indicates that the contested embodiment comprises a solution essentially different from that of the patent.
- Whether the solution of the defendant's embodiment leads to a result, substitutable to the result obtained by the solution according to the patent. If the difference between the contested embodiment and the claims has a

material additional effect on the technical solutions, the doctrine of equivalence does not apply.

- The kind of invention affects the application of the doctrine of equivalence. If the invention is a pioneering invention the scope of using the doctrine of equivalence is wider than would otherwise have been the case.
- The state of the art and actions taken by the applicant can affect the interpretation of equivalence, as stated below in the answer to question 3.

Question 2:

*Can the scope of patent protection change with time, or is it fixed at a particular date? If it is fixed, at what date (e.g. priority, application date or date of alleged infringement)?*

The person skilled in the art is used in Swedish law when measuring the available range of equivalents for a patent. A modification reaching beyond the capabilities of the skilled person is not considered an equivalent. But it is not clear from case law at what time the capabilities of the skilled person shall be measured. However, it has in the legal doctrine been suggested that the priority date should be used to determine the capacity of the skilled person to find equivalents. In addition it has been discussed that also later arising alternatives to features in the claims can be equivalents, if the technical capacity of the skilled person on the priority date would have been sufficient to make him realise the equivalence of such later arising alternative, assuming such alternative would have existed on the priority date.

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

a) It is quite clear from Swedish case law and legal doctrine that the prosecution history can play a role in determining the scope of protection. For example, it is stated in the preparatory document behind the joint Nordic patent legislation, NU 1963:6 p. 186, that "the documents of the prosecution ... may be of relevance" when interpreting unclear claims. It is also mentioned that if the applicant "himself interpreted expressions used in the claims in a restrictive manner it is reasonable that this restrictive interpretation also is considered in subsequent court proceedings". The importance of the information in the patent prosecution file will of course vary from case to case.

The number of Swedish court decisions in this area is quite limited. The subject has, however, to some extent been dealt with in the legal doctrine of the Nordic countries. In these cases the authors frequently rely on statements made in the co-Nordic preparatory works dating back to the 1960's. It is unclear to what extent one should rely on these statements bearing in mind that they were made before Sweden became a party to the EPC and the European Union.

The Swedish Supreme Court has on December 20, 2002, rendered a decision concerning a claim for preliminary injunction. In this case (No Ö 2667-02) most of the arguments put forward by the parties concerned the importance of what had happened during the prosecution stage. The Court did not, however, find it necessary to rely on the prosecution history for its decision. Even so, the question was brought up in an *obiter dictum* where the Court made some remarks as to the use of the prosecution history for interpreting the scope of protection. The Supreme Court hereby seems to confirm the view earlier expressed in the preparatory documents and the legal doctrine by stating that it should be permissible to use also material from the prosecution stage "to interpret unclear points in the patent claims and the specification as far as a limitation of the scope of protection is concerned". The Court noted that a different view previously had been expressed in decisions rendered by Bundesgerichtshof, Karlsruhe, on 12 March 2002, in the case X ZR 43-01, and Patents Court, London, on 11 April 2001, in the case Kirin-Amgen Inc. et al versus Transkaryotic Therapies Inc. et al.

Thus, under Swedish case law, information from the patent prosecution file can be used not only to resolve questions of equivalence but also to interpret unclear points in the claims or the specification in court proceedings where no equivalence is claimed. Accordingly, there is something similar to "file wrapper estoppel" under Swedish law even if it remains unclear to what extent this principle should be applied. It should, however, be mentioned that some of the statements made in the legal doctrine on which the Supreme Court relied could indicate that an absolute estoppel should be applied in cases where the patentee has overcome a reference by arguing that a feature in the claim should be interpreted in a restrictive manner.

b) What really matters is how the applicant or, where applicable, the patentee, according to the file has argued or otherwise acted during the prosecution stage. According to the literature in question, only arguments or actions that a third party would understand as intentionally limiting the scope of protection are of relevance in subsequent infringement proceedings.

c) A similar answer as in the preceding paragraph can be given also to the question whether there is a difference between actions taken by the patent office or third parties. Thus, the relevance of the patent prosecution history more depends on how the applicant argued and acted. This is in accordance with the general principle in Swedish law that there are no restrictions to the sources for the evidence a party may use (free presentation of evidence) and that the Swedish Courts independently have the right to freely evaluate the strength of the evidence (free examination of evidence).

Question 4:

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

The Swedish Group has identified the following situations where the scope of claims in a granted patent for Sweden can be limited outside prosecution of the underlying patent application.

On basis of court practice by:

1. Swedish court decision to formally amend one or more claims at least by combining two or more claims, on request by the patentee. Such request can be made in connection with an invalidation action against the patent. This is standard court practice, confirmed on Appeal Court level.
2. interpretation of the scope of claims by the patentee in an action for invalidation or for infringement concerning the patent in the Swedish Court, even though the claims may not have been formally amended.

On basis of the Patent Law:

3. Swedish Patent Office decision to formally delete one or more claims, on request by the patentee, under Section 54 of the Patents Act. It is clearly stated in the doctrine that this section can be applied for individual claims.

Question 5:

*Do you have recommendations for harmonisation in this area?*

In the opinion of the Swedish Group it is desirable with harmonisation how to apply a doctrine of equivalence.

This is a most important question which should be studied further by the national groups. And the related work within WIPO in the context of the SPLT needs to be followed closely. AIPPI Special Committee Q170 has an important task here.

Within the European framework the Swedish Group notes the amendment of the Protocol on the Interpretation of Article 69 EPC decided at the diplomatic

conference in Munich in November 2000. Developments in court practice under this revised Protocol will need to be followed.

## Summary

Swedish courts apply the doctrine of equivalence. It is provided for by case law and is not expressly included in the Swedish Patents Act.

It is clear from Swedish case law and legal doctrine that the prosecution history can play a role in determining the scope of protection. Under Swedish case law, information from the patent prosecution file can be used not only to resolve questions of equivalence but also to interpret unclear points in the claims or the specification in court proceedings where no equivalence is claimed.

Swedish courts, the patentee and the Swedish Patent Office may under certain circumstances limit the scope of claims outside prosecution in the Patent Office.

## Zusammenfassung

Schwedische Gerichte erkennen eine Patentverletzung unter dem Gesichtspunkt der Äquivalenz an. Sie basiert auf Richterrecht (Rechtsprechung) und ist nicht ausdrücklich im Schwedischen Patentgesetz erwähnt.

Aus Schwedischer Rechtsprechung und Rechtsauslegung ist klar, dass der Inhalt der Erteilungsakte zur Bestimmung des Schutzzumfanges gemäß Schwedischer Rechtsprechung eine Rolle spielen kann. Aus der Erteilungsakte gewonnene Information kann nicht nur dazu benutzt werden, um Fragen der Äquivalenz zu lösen, sondern können auch dazu verwendet werden, Unklarheiten in den Ansprüchen oder der Beschreibung im Gerichtsverfahren zu interpretieren, in denen nicht auf Äquivalenz abgestellt wird.

Schwedische Gerichte, der Patentinhaber und das Schwedische Patentamt können unter bestimmten Umständen den Schutzzumfang von Ansprüchen außerhalb des Verfahrens vor dem Patentamt beschränken.

## Résumé

Les tribunaux suédois appliquent la doctrine d'équivalents. Elle découle de la jurisprudence et elle n'est pas explicitement comprise dans la loi suédoise de brevets.

Il est clair qu'après la jurisprudence suédoise et la doctrine juridique suédoise, le dossier de délivrance peut jouer un rôle en déterminant la portée de la protection. Selon la jurisprudence suédoise d'information tiré du dossier de délivrance du brevet peut être utilisé non seulement pour résoudre des questions d'équivalence, mais aussi pour interpréter des parties obscures des revendications ou de la description aux procédures judiciaires où l'équivalence n'est pas invoqué.

Les tribunaux suédois, le breveté et l'office de brevets suédois peuvent, sous des circonstances particulières, limiter la portée des revendications en dehors de la procédure de délivrance.