

# Doctrine of Equivalents and Its Equivalence in the Philippines

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## I. INTRODUCTION

Patent infringement is ordinarily understood to mean the unauthorized replication or use of a patented invention or process. In the Philippines, the legal framework for determining patent infringement is that defined in

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Reference is made to jurisprudence from the United States of America (hereinafter U.S.) because the Philippines adheres to the same legal principles as that of the U.S. on patent infringement and patents in general. Thus, the Philippine Supreme Court cites U.S. jurisprudence in its decisions relating to patent issues.

Section 76.1 of Republic Act No. 8293, otherwise known as the Intellectual Property Code<sup>1</sup> (“IP Code”), which states:

[t]he making, using, offering for sale, selling, or importing a patented product or a product obtained directly or indirectly from a patented process, or the use of a patented process without the authorization of the patentee constitutes patent infringement.

Patent infringement determination requires a two-step analysis.<sup>2</sup> First, the patent claims must be properly construed to determine its scope and meaning.<sup>3</sup> This step pertains to the legal question of claim interpretation. Second, the claims as properly construed must be compared to the accused device or process.<sup>4</sup>

Technically, however, patent infringement is committed either literally or by equivalents.<sup>5</sup> Literal infringement exists when every limitation recited in a patent claim is found in the infringing device or process. Infringement by equivalents, on the other hand, happens when a device or process appropriates a prior invention by incorporating its innovative concept and, although with some modification and change, performs substantially the same function in substantially the same way to achieve substantially the same result.<sup>6</sup> This same “function-way-result” equation lies at the heart of the doctrine of equivalents.

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1. An Act Prescribing the Intellectual Property Code and Establishing the Intellectual Property Office, Providing for Its Powers and Functions, and for Other Purposes [INTELLECTUAL PROPERTY CODE] (1998).
  2. *Zelinski v. Brunswick Corp.*, 185 F.3d 1311, 1315 (Fed. Cir. 1999).
  3. INTELLECTUAL PROPERTY CODE, § 75.1.
  4. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984).
  5. INTELLECTUAL PROPERTY CODE, § 75.2 provides:

[f]or the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements that are equivalent to the elements expressed in the claims, so that a claim shall be considered to cover not only all the elements as expressed therein, but also equivalents.
  6. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987); *see also Pascual Godines v. Court of Appeals*, 226 SCRA 338 (1993); *see also Smith Kline Beckman Corp. v. Court of Appeals*, 409 SCRA 33 (2003).

## II. WHAT IS THE “DOCTRINE OF EQUIVALENTS?”

The doctrine of equivalents is a common law concept borne of American jurisprudence.<sup>7</sup> It is an equitable measure to protect patentees against deliberate efforts of infringers to evade liability for infringement by making only insubstantial changes to a patented invention. In other words, it extends protection beyond the specific and literal claims of patents. In one of its recent decisions, the United States of America Supreme Court restated the time-honored rationale behind the application of the doctrine of equivalents:

[t]he language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. For this reason, the clearest rule of patent interpretation, literalism, may conserve judicial resources but is not necessarily the most efficient rule. The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described.<sup>8</sup>

## III. THE DOCTRINE AS ENTRENCHED IN AMERICAN JURISPRUDENCE

One of the earliest manifestations of the doctrine of equivalents in American jurisprudence was in *Winans v. Denmead*.<sup>9</sup> In *Winans*, the doctrine was expressed in this wise: “the exclusive right to the thing patented is not secured, if the public are (sic) at liberty to make substantial copies of it, varying its form or proportions.”<sup>10</sup>

Close to a century later, the debate over whether the doctrine of equivalents should be afforded a second look took center stage in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*<sup>11</sup> Clearing the air of doubts on the matter, the Court ruled in *Graver Tank* that:

[p]atent claims must protect the inventor not only from those who produce devices falling within the literal claims of the patent but also from copyists who make unimportant and insubstantial changes and substitutions in the

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7. *Winans v. Denmead*, 15 How. 330 (1854); *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950); *Warner Jenkinson Co., Inc. v. Hilton Davis*, 520 U.S. 17 (1997).

8. *Festo v. Shoketsu Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 152 L. Ed. 2d 944, 122 S. Ct. 1831 (2002).

9. *Winans v. Denmead*, 15 How. 330 (1854).

10. *Id.* at 347.

11. *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605 (1950).

patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.<sup>12</sup>

Recently, the doctrine's stronghold as an important consideration in patent infringement determination was reaffirmed in *Warner Jenkinson Co. v. Hilton Davis Chemical Co.*<sup>13</sup> *Warner Jenkinson* held that:

[i]f the essential predicate of the doctrine of equivalents is the notion of identity between a patented invention and its equivalent, there is no basis for treating an infringing equivalent any differently than a device that infringes the express terms of the patent.<sup>14</sup>

While the doctrine of equivalents is firmly entrenched in American jurisprudence, its applicability is nonetheless subject to limitations—that is, existence of prior art, technological advances, and prosecution history estoppel. These limitations have been the subjects of numerous cases decided by the United States Court of Appeals Federal Circuit and the United States Supreme Court, of which some of the most significant are the so-called “*Festo*” rulings on the scope and extent of prosecution history estoppel as a limitation to the applicability of the doctrine of equivalents.

#### IV. LIMITATIONS ON THE DOCTRINE OF EQUIVALENTS

##### A. Prosecution History Estoppel

###### 1. Prosecution History Estoppel as a Complete Bar to Claim of Equivalence

Prosecution history (otherwise known as “file wrapper”) generally refers to an official record having to do with a particular patent application.<sup>15</sup> There are stages in the prosecution of patent applications that require patent claims to be amended to conform to patentability requirements. Certain amendments necessarily limit the scope of a patent in such a way that a patentee is prevented from disputing later that its patent still encompasses even the claims surrendered during prosecution as unforeseen equivalents. The doctrine of prosecution history estoppel has been well in place in U.S. jurisprudence as an effective counterbalance to the doctrine of equivalents.

Prior to the year 2000, the controlling jurisprudence was that prosecution history estoppel constitutes a flexible bar to the application of

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12. *Id.* at 607.

13. *Warner Jenkinson Co. v. Hilton Davis Chemical Co.*, No. 95-728, March 3, 1997, available at <http://supct.law.cornell.edu/supct/html/95-728.ZO.html> (last accessed August 30, 2006).

14. *Id.*

15. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2003 WL 2220526 (Fed. Cir. Sep. 26, 2003).

the doctrine of equivalents. This meant that there was sufficient latitude for patentees who foreclosed some claims to sue for infringement by equivalents on unsurrendered claims. The U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) in *Festo v. Shoketsu Kinzoku Kogyo Kabushiki*<sup>16</sup> (“*Festo I*”) made it difficult for patentees to maintain infringement suits as it constricted the application of the doctrine of equivalents to the hilt. Thus, patentees who, at a certain point during the prosecution of their patent applications, amended particular claims to obtain patentability, are automatically and completely enjoined from asserting infringement by equivalents. *Festo I* categorically held that prosecution history estoppel relative to an amended claim is a complete bar against the application of the doctrine of equivalents, regardless of whether the amendment pertains to prior art or not.

In this case, Festo Corporation owned two patents for an improved magnetic rodless cylinder, a piston-driven device that relies on magnets to move objects in a conveying system. During the prosecution of the first patent, the patent examiner rejected the application because of certain defects in the description. To avoid rejection, the application was amended, among others, to include the limitations that the device would contain a pair of “one-way sealing rings” and that its outer sleeve would be made of “magnetizable material.” Similarly, the application for the second patent was also amended to comprise the limitation on sealing rings. Before Festo Corporation could sell its product in the market, Shoketsu Kinzoku Kogyo Kabushiki Co. (“SMC”) sold a similar device that uses one two-way sealing ring and a non-magnetizable sleeve. Festo Corporation sued SMC for patent infringement under the doctrine of equivalents. When the case reached the Federal Circuit, the court ruled that Festo Corporation was barred from claiming equivalents on a subject matter that it has surrendered by amendment. The Federal Circuit further ruled that estoppel arises not only from amendments made to avoid prior art, but also from any amendment that narrows a claim to comply with the Patent Act.

## 2. Rebuttable Presumption of Prosecution History Estoppel

The *Festo I* ruling was brought to the U.S. Supreme Court in *Festo v. Shoketsu Kogyo Kabushiki Co. Ltd.*<sup>17</sup> (“*Festo II*”). The Court affirmed that prosecution history is still an effective bar against the application of the doctrine of equivalents. Nevertheless, the Supreme Court completely disregarded the Federal Court’s ruling that prosecution history estoppel is a

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16. *Festo v. Shoketsu Kinzoku Kogyo Kabushiki*, 234 F.3d 558 (Fed. Cir. 2000).

17. *Festo v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, No. 00-1543, May 28, 2002, available at <http://www.law.cornell.edu/supct/html/00-1543.ZO.html> (last accessed August 30, 2006).

complete bar to a finding of equivalence. Instead, it created a rebuttable presumption that prosecution history estoppel bars a finding of equivalence.

*Festo II* set parameters by which the presumption may be rebutted:

[t]here are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale of the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases, the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.<sup>18</sup>

From a patentee's vantage point, the introduction of the rebuttable presumption will somehow release them from a legal straightjacket. Notwithstanding such, prosecution history estoppel remains an equitable offset against the doctrine of equivalents. As it is, patentees will still have to bear the burden of overcoming the presumption. *Festo II* made this clear:

[w]hen the patentee is unable to explain the reason for amendment, estoppel not only applies but also "bar(s) the application of the doctrine of equivalents as to that element."

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Just as *Warner-Jenkinson* held that the patentee bears the burden of proving that an amendment was not made for a reason that would give rise to estoppel, we hold here that the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question.<sup>19</sup>

Under the circumstances, *Festo* Corporation still has to contend with the tall order of proving that its amendments on the sealing rings and sleeve of its subject device are not narrowing; if they are narrowing, *Festo* Corporation should point out other unsurrendered claims that may have equivalents in the infringing device.

### 3. Prosecution History Estoppel: Manner of Inquiry

The most recent installment of the *Festo* litigation is *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*<sup>20</sup> ("*Festo III*"), which is the same case remanded by the U.S. Supreme Court to the U.S. Court of Appeals for the Federal Circuit. In this case, the application of the flexible bar approach,

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18. *Id.*

19. *Id.*

20. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 95-1066, 2003 WL 2220526 (Fed. Cir. Sep. 26, 2003).

suggested by the U.S. Supreme Court, was at the center stage of the discussion. The main issue was whether a patentee can overcome the presumption that the filing of narrowing amendments surrenders all subject matter between the original claim limitations and the amended claim limitations. The court firmly established that the rebuttal of the presumption is a question of law which it should decide.

The inquiry as to whether prosecution history estoppel bars the application of the doctrine of equivalents yielded some sort of stepladder test which the court employed in deciding the case. At the forefront of the inquiry is the question of *whether the amendment narrowed the literal scope of the subject claim*. If the amendment did not narrow the literal scope of a claim, prosecution history estoppel will not apply. Otherwise, the court will proceed to answer the next step in the inquiry: *whether the reason for the amendment was substantial and related to the patentability*. Where the amendment was neither substantial nor related to patentability, prosecution history estoppel will not apply. Where the answer is in the affirmative, the court will subsequently inquire as to *what scope is surrendered by the narrowing amendment*. This question goes further into addressing the main question: *can the patentee overcome the presumption that all scope between the original claim limitations and amended claim limitations is surrendered?* If the patentee overcomes the presumption, prosecution history estoppel will not apply and the court, as a matter of course, is bound to address the merits of whether the accused element is in fact equivalent to the claim limitation. Conversely, if the presumption is not defeated, prosecution history estoppel applies and the patentee is effectively barred from relying on the doctrine of equivalents.

In *Festo II*, the U.S. Supreme Court laid down in clear terms the parameters upon which the narrowing presumption may be overcome by the patentee, to wit: (a) whether the equivalent would have been unforeseeable at the time of the amendment; (b) whether the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question; and (c) whether there was some other reason suggesting that the patentee could not reasonably be expected to have described the alleged equivalent when it narrowed the claim. These were the same parameters employed by the U.S. Court of Appeals for the Federal Circuit on remand of the case. Negative answers to these queries would pave the way for the application of prosecution history estoppel as an effective bar to the doctrine of equivalents.

Prosecution history estoppel prevailed in *Festo III* because the presumption was not overcome by the patentee. Now, patentees who narrowed their claims during prosecution and who are faced with what they deem as infringing equivalents face the challenge of overcoming the stiff legal presumption.

### *B. Prior Art Bar*

Prior art is knowledge that is available and obvious to a person of ordinary skill in the art.<sup>21</sup> In simple terms, prior art is knowledge that is already available to the public. It is elementary that any matter belonging to the public domain could not be patented. This finds basis on the statutory requirement that a patented invention should be “new.”

The doctrine of equivalents cannot allow a patent to encompass subject matter existing in prior art.<sup>22</sup> This limitation rests on the premise that prior art is subject matter not patentable; hence, if an alleged equivalent belongs to the domain of prior art, it is not susceptible of being captured or recaptured by any patent claim. Further, the doctrine of equivalents is an equitable doctrine and it would not be equitable to allow a patentee to claim or reclaim a scope of equivalents encompassing material that had been previously disclosed by someone else, or that are obvious in light of others’ earlier disclosures.<sup>23</sup> In a case decided by the Federal Circuit, it was pronounced that prior art limits that which an inventor could have claimed; thus, prior art also limits the range of permissible equivalents of a claim.<sup>24</sup>

### *C. All-Elements Rule*

Each element contained in a patent claim is deemed material to defining the scope of the patented invention. The U.S. Supreme Court declared in *Warner Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*<sup>25</sup> that infringement requires that each and every element of a patent claim must be present in the accused device, either literally or through an equivalent element, regardless of the degree of overall similarity or equivalence between the invention and the accused device. Essentially, the “all-elements” rule teaches that the determination of equivalence should be applied as an objective inquiry on an element-by-element basis.

### *D. Disclosure-Dedication Rule and Foreseeability Rule*

Patent applications contain disclosures which are embodied in the specifications and claims. Nevertheless, there are instances when disclosures in the specifications are not actually captured in the patent claims. Subject

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21. *Id.*

22. ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 448 (7d ed. 2005).

23. *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 61 USPQ2d 1647, 1654 (Fed. Cir. 2002).

24. *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677, 14 USPQ2d 1942 (Fed. Cir. 1990).

25. *Warner Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).



matter alternatively disclosed but unclaimed are deemed to have been dedicated to the public.<sup>26</sup> This is the “disclosure-dedication” rule. Hence, the doctrine of equivalents does not operate to cover unclaimed disclosures because this could untowardly encourage patent applicants to present a broad disclosure in the specification and file narrow claims to avoid examination of the broader claims. It is rather inequitable to enable a patentee to expand the narrow scope of his patent claims to cover an equivalent subject matter merely disclosed in the specifications. Patent claims define the scope of protection afforded by the patent; thus, anything beyond the ambit of the claims cannot be deemed as equivalent.

In a recent case, the “disclosure-dedication” rule was substantially extended to exclude not only unclaimed subject matter disclosed in a specification, but also subject matter foreseeable from the subject matter claimed.<sup>27</sup>

#### V. DOCTRINE OF EQUIVALENTS: FINDING ITS NICHE IN PHILIPPINE JURISPRUDENCE.

In the Philippines, the doctrine of equivalents finds statutory basis in Section 75.2 of the IP Code:

[f]or the purpose of determining the extent of protection conferred by the patent, due account shall be taken of elements which are equivalent to the elements expressed in the claims, so that a claim shall be considered to cover not only all the elements as expressed, but also equivalents.

In as far as Philippine jurisprudence is concerned, however, discussion on the doctrine of equivalents is relatively scarce. In fact, only three cases delved on the subject of equivalents *vis-à-vis* patent infringement. Surprisingly, the earliest mention of the doctrine was in *Carlos Gsell v. Valeriano Veloso Yap-Jue*,<sup>28</sup> where there was no substantial discourse on the matter but merely a token reference to an American case.

In *Pascual Godines v. Court of Appeals*,<sup>29</sup> the Supreme Court relied on the doctrine of equivalents when it found patent infringement against an individual for manufacturing and selling “power tillers” in substantially the same mold as that of a patented model. The doctrine as conceived and defined in American jurisprudence, was restated:

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26. *Miller v. Brass Company*, 104 U.S. 350 (1881).

27. *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1425, 44 USPQ2d 1103 (1997).

28. *Carlos Gsell v. Valeriano Veloso Yap-Jue*, 12 Phil. 519 (1909).

29. *Pascual Godines v. Court of Appeals*, 226 SCRA 338 (1993).

[r]ecognizing that the logical fallback position of one in the place of defendant is to aver that his product is different from the patented one, courts have adopted the doctrine of equivalents which recognizes that minor modifications in a patented invention are sufficient to put the item beyond the scope of literal infringement. Thus, according to this doctrine, “(a)n infringement also occurs when a device appropriates a prior invention by incorporating its innovative concept and, albeit with some modification and change, performs substantially the same function in substantially the same way to achieve substantially the same result.” The reason for the doctrine of equivalents is that to permit the imitation of a patented invention which does not copy any literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such imitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of the law.<sup>30</sup>

More recently, in *Smith Kline Beckman Corp. v. Court of Appeals*,<sup>31</sup> the Supreme Court struck down a patent infringement suit because the petitioner fell short of substantiating the function-means-result requirement for infringement by equivalents. It nevertheless reiterated its recognition of the doctrine of equivalents:

[t]he doctrine of equivalents provides that an infringement also takes place when a device appropriates a prior invention by incorporating its innovative concept and, although with some modification and change, performs substantially the same function in substantially the same way to achieve substantially the same result.<sup>32</sup>

While the doctrine of equivalents is recognized in Philippine jurisprudence, the High Court has yet to render an incisive discussion on the matter. Other than reference to the vast sources of American case law on the doctrine, Philippine jurisprudence offers no hint as to the extent of its applicability. As to how the Supreme Court would eventually appreciate the scope of prosecution history estoppel, for instance, remains to be seen. Would the Supreme Court regard prosecution history estoppel as a complete bar to the applicability of the doctrine of equivalents? Alternatively, would the Court provide some leeway for patentees to refute estoppel?

At present, there may be very few cases dealing with prosecution history estoppel that are pending with the Intellectual Property Office. Until these cases actually reach the Supreme Court and are resolved with finality, patent infringement litigants will have to rely exclusively on American authorities for applicable case law on the matter.

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30. *Id.* at 344.

31. *Smith Kline Beckman Corp. v. Court of Appeals*, 409 SCRA 33 (2003).

32. *Id.* at 40.

VI. *FESTO* RULINGS: PHILIPPINE SETTING

In the Philippines, patent examiners are given leverage to make preliminary rejections of patent applications.<sup>33</sup> A preliminary rejection under the rules would necessitate amendments by the applicant in order to conform to requirements on patentability, form, or content.

The IP Code prescribes requirements for patentability—novelty, inventive step and industrial applicability. The want of these requirements are common yet strong grounds for preliminary rejection of patent applications. Other grounds for preliminary rejection that may prompt patent applicants to amend their applications are those pertaining to the application's form and content.

The *Festo* decisions on prosecution history estoppel hold utmost significance on amendments pertaining to novelty and inventive step. This is mainly because amendments in compliance with these requisites essentially involve avoidance of prior art. It is in these areas where a patent applicant necessarily surrenders claims and foreseeable equivalents that may later on bar him from claiming infringement. Overcoming the *Festo* presumption entails a clear showing that the surrendered claims and equivalents do not constrict the patent's reach and that the alleged equivalent in the infringing device could not have been foreseen at the time of the amendment. Otherwise, if amendments to the patent application pertain to matters other than avoidance of prior art, the *Festo* presumption may not at all be a stumbling block against an infringement suit based on equivalents. Amendments in conformity with the law's requirements as to form and content are merely cosmetic—hence, not limiting *vis-à-vis* the scope of the patent. In addition, proving industrial applicability, in response to a preliminary rejection, would not involve avoidance of prior art. Following the *Festo* parameters, amendments of such nature may be characterized as merely bearing “tangential” connection to the equivalent, hence, not effective bars to a finding of equivalence.

There are patent applications in the Philippines that are patterned after approved patents in other jurisdictions, such as the United States and Japan. The common practice of patent examiners at the Intellectual Property Office is to simply require the applicant to make the claims conform to approved patents for equivalent applications abroad. This practice necessarily expedites patent prosecution as patent examiners tend to rely mainly on the claim interpretation undertaken during prosecution in the foreign jurisdiction. In reality, however, it brings to fore a major concern as regards the applicability of the doctrine of equivalents and prosecution history estoppel.

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33. Intellectual Property Office, Rules and Regulations on Inventions, Rule 903-904, Dec. 29, 1998.

In an actual case,<sup>34</sup> a patentee sued a corporation for patent infringement, both literally and by equivalents. During litigation, the alleged infringer submitted the view that the prosecution history of the Philippine patent posed as a bar to the application of the doctrine of equivalents. He relied on the fact, that during the prosecution of the Philippine patent, the applicant agreed to make the application conform to an equivalent U.S. patent. The alleged infringer asserted that such conformity amounted to the amendment of the claims in the application and was tantamount to the adoption of the prosecution history of the U.S. patent, where amendment of claims was made to overcome rejection. A review of the prosecution history in the Philippines revealed nothing that would suggest that the application was rejected due to unpatentability. In cases where a patentee's amendments were neither required as a response to an examiner's rejection nor critical to the allowance of claims, no estoppel could be found.<sup>35</sup> There was no narrowing of the scope of the subject claim, so to speak.

In this scenario, does making the claims of the Philippine patent conform to an equivalent U.S. patent establish the latter's prosecution history relevant in determining patent infringement? The Philippine patent has its own prosecution history and, even adopting the full text of the U.S. patent, could not be construed as also adopting the latter's prosecution history. Patents are territorial and independent from one country to another.

Rather than rely on the prosecution history of patents issued in foreign jurisdictions, patent examiners in the Philippines should make their independent evaluation and examination of claims when confronted with patent applications that have foreign equivalents. Along this line, it will augur well if patent examiners will be made to undergo capacity-building to become truly independent in their evaluation and examination of patent applications.

## VII. CONCLUSION

With the Philippine Supreme Court's recognition of the doctrine of equivalents in *Pascual Godines v. Court of Appeals*<sup>36</sup> and *Smith Kline Beckman Corp. v. Court of Appeals*<sup>37</sup> as a means of committing patent infringement, it is expected that prosecution history estoppel and the *Festo* presumption will eventually find their way in Philippine jurisprudence. That being the case,

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34. This case is awaiting resolution as of this writing. For this reason, the case is not identified.

35. *Mannesmann Demag Corp. v. Engineered Metal Products Co.*, 739 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986).

36. *Pascual Godines v. Court of Appeals*, 226 SCRA 338 (1993).

37. *Smith Kline Beckman Corp. v. Court of Appeals*, 409 SCRA 33 (2003).

*Festo* should be regarded as a welcome development to consistency and predictability in determining patent infringement. For patentees, however, suing for patent infringement via the doctrine of equivalents will be an uphill climb.