# Q284


| | |
|---|---|
| **National Group:** | Hungary |
| **Title:** | **Doctrine of equivalents** |
| **Contributors:** | Marcell KERESZTY (chair), Mónika BIACS, Zsuzsanna BUZÁS-NAGY, Daisy MACHYTKA-FRANK, Pálma GRÓF, Ádám GYÖRGY, Gábor HARANGOZÓ, Bertalan HORVÁTH, Nóra LAZÁNYI, Imre MOLNÁR, Árpád PETHÖ, Zsolt SZENTPÉTERI |
| **E-mail:** | kereszty@godollepat.hu |
| **Date:** | 5 May 2023 |


## Questions

### I. Current law and practice

Please answer all questions in Part I on the basis of your Group's current law.

In the questions below:

> **"4a function test"** means that the element under consideration in the allegedly infringing product performs substantially the same function to produce substantially the same result as the corresponding claim element,
>
> **"4b difference test"** means that the difference between the claimed element and the element under consideration is not substantial according to the understanding of the claim by a person skilled in the art at the time of the infringement,
>
> **"5a exclusion"** means that a person skilled in the art would at the filing date have understood an element to be excluded from the equivalent scope of protection,
>
> **"5b exclusion"** means that as a result of adopting the equivalent scope of protection, the scope of protection covers the prior art or that which is obvious over the prior art,
>
> **"5c exclusion"** means the patentee expressly and unambiguously excluded an element from the claim during prosecution of that patent to overcome a prior art objection, and
>
> The **"Q175 Approach"** means that the scope of protection shall include those elements that meet the 4a function test and 4b difference test, provided that they are not excluded under the 5a, 5b or 5c exclusions.

1) Is the current law and practice in your jurisdiction generally in line with the Q175 Approach?

a) Is there a distinction between the scope of protection and the scope of claims? Please answer YES or NO and you may add a brief explanation.

Yes

There is a distinction in Hungary between the scope of protection and the literal scope of claims, as stipulated by Art. 24 of the Hungarian Patent Act (Act No. XXXIII of 1995 on the protection of inventions by patents):

> "(1) The scope of protection conferred by a patent shall be determined by the claims. The claims shall be interpreted on the basis of the description and the drawings.
>
> (2) Patent protection shall cover any product or process in which all the characteristics of the claim are embodied.
>
> (3) The terms of the claims shall not be confined to their strict literal wording; neither shall the claims be considered mere guidelines for a person skilled in the art to determine the claimed invention.
>
> (4) For the purpose of determining whether the patent protection extends to a product or process, due account shall be taken of any characteristics of the product or process which is equivalent to those specified in the claims."

The above provisions are in line with the European Patent Convention, and regarding equivalency considerations no distinction can be found in the case law between Hungarian national patents and European patents validated in Hungary, so all the answers in the present report are valid for both types of patents.

b) Is the current law and practice in your jurisdiction following the 4a function test? Please answer YES or NO and you may add a brief explanation.

Yes

The Hungarian Group notes that in Q175 the 4a function test and the 4b difference test were intended to define equivalency in combination (are in a logical 'and' connection), so Q175 proposes to use the two tests in combination. Accordingly, the Hungarian Group addresses the 4a function test and the 4b difference test as subconditions of equivalency.

The 4a function test is not stipulated by law in Hungary, but the case law follows this subcondition in assessing equivalency. More specifically, the Hungarian case law consequently requires for finding equivalency that the two conditions "substantially the same function" and "substantially the same result" are fulfilled together with a third one: "in substantially the same way". Thus, equivalents are taken into account in Hungary under the "function-way-result" test referred to in point 2) of the Introduction of the Study Guidelines.

As to the Hungarian case law and practice, reference is made e.g. to

- the following court decisions (in Hungarian), each citing the "function-way-result" test and being confirmed by higher court instances: 3.P.26.728/2010/13., 3.P.21.444/2013/62. and 3.P.25.037/2014/24. (https://birosag.hu/birosagi-hatarozatok-gyujtemenye); and to

- the Guidelines for Patent Examination published by the Hungarian Intellectual Property Office (in Hungarian), also citing the "function-way-result" test in section III, point 4.3.2.7 (https://www.sztnh.gov.hu/sites/default/files/files/professional/szabadalmimuiiifejezetvegleges.pdf), and in section VI, point 3.8 (https://www.sztnh.gov.hu/sites/default/files/files/professional/viegyebeljarasok201707vegleges.pdf)

c) Is the current law and practice in your jurisdiction following the 4b difference test? Please answer YES or NO and you may add a brief explanation.

No

As mentioned in our answer to question b) above, the "function-way-result" test is consequently applied in the case law in Hungary, and the 4b difference test is not followed as a subcondition of equivalency.

d) Is the current law and practice in your jurisdiction following the 5a exclusion? Please answer YES or NO and you may add a brief explanation.

Yes

On the basis of Art. 24 (1) of the Hungarian Patent Act, the scope of protection is determined by the claims, which are to be interpreted on the basis of the description and the drawings. It follows from this provision that an element cannot be regarded as an equivalent if a person skilled in the art would at the filing date have understood an element to be excluded from the equivalent scope of protection.

e) Is the current law and practice in your jurisdiction following the 5b exclusion? Please answer YES or NO and you may add a brief explanation.

Yes

The decisions identified in this respect in the Hungarian case law deny the applicability of equivalency to embodiments that belong to the prior art or to the public domain, or to those got outside of the literal scope of the claims due to a delimitation of the scope of protection from the prior art in patent nullification proceedings.

The following court decisions (in Hungarian) are referred to, which were also confirmed by higher court instances: 3.P.24.994/2013/4. and 8.Pf.20.451/2015/14. (https://birosag.hu/birosagi-hatarozatok-gyujtemenye).

f) Is the current law and practice in your jurisdiction following the 5c exclusion? Please answer YES or NO and you may add a brief explanation.

Yes

The related decisions identified in the Hungarian case law deny the applicability of equivalency to embodiments that got outside of the literal scope of the claims due to a delimitation of the

scope of protection from the prior art in patent nullification proceedings. Accordingly, the Hungarian Group is of the opinion that the same considerations would apply to situations where an exclusion of an element from the literal scope of the claim is made during prosecution to overcome a prior art objection.

The following court decisions (in Hungarian) are referred to, which were also confirmed by higher court instances: 3.P.24.994/2013/4. and 8.Pf.20.451/2015/14. (https://birosag.hu/birosagi-hatarozatok-gyujtemenye).

2) Whether (unclaimed) alternative embodiments disclosed in the specification should be excluded from infringement by equivalence

a) Under the current law and practice in your jurisdiction, does equivalent infringement categorically exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims, i.e. are such alternative embodiments implicitly disclaimed from the equivalent scope of protection?

Please answer YES or NO and you may add a brief explanation.

No

There are no specific legal provisions to this situation and no relevant Hungarian case law has been found either. The Hungarian Group is of the opinion that such alternative embodiments are not categorically excluded from infringement by equivalence, but each of such embodiments are to be assessed on a case-by-case basis and by taking into account all relevant circumstances, such as whether the whole context of the description, claims and drawings conveys an understanding that the particular embodiment is disclaimed, or, to the contrary, that the embodiment is disclosed as a potential equivalent embodiment.

b) Under the current law and practice in your jurisdiction, does equivalent infringement exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims if the patentee excluded them from the claim during prosecution of that patent to overcome a prior art objection?

Please answer YES or NO and you may add a brief explanation.

Yes

See our answer to question 1f).

3) Under the current law and practice in your jurisdiction, does one consider the equivalent scope of protection conferred by a patent when assessing validity and/or patentability of that patent? In other words, is it possible that, considering the equivalent scope of protection of a particular patent, this patent is deemed to

a) lack novelty, and/or

Please answer YES or NO and you may add a brief explanation.

No

The equivalent scope of protection conferred by a patent is only considered when assessing enforcement aspects and not for assessing validity and/or patentability aspects.

The following court decision (in Hungarian) is referred to, confirming the above standpoint: 8.Pkf.25.032/2009/3. (https://birosag.hu/birosagi-hatarozatok-gyujtemenye).

b) lack inventive step (non-obviousness), and/or

Please answer YES or NO and you may add a brief explanation.

No

c) lack sufficiency of disclosure, and/or

Please answer YES or NO and you may add a brief explanation.

No

d) lack plausibility, and/or

Please answer YES or NO and you may add a brief explanation.

No

e) claim added matter?

Please answer YES or NO and you may add a brief explanation.

No

*If your answer to any of the questions 3 a) to e) is YES, please address the following questions:*

4) When assessing validity and/or patentability against the equivalent scope of protection, are the relevant embodiments limited to those embodiments which are attacked as "equivalent infringement" in a specific case by the patent owner (or an otherwise entitled person)?

Please answer YES or NO and you may add a brief explanation.

5) If the answer to question 4 is YES, is anyone be entitled to attack the validity and/or patentability of the patent based on such argument, or only the alleged infringer? Please answer YES or NO and you may add a brief explanation.

6) If the answer to question 4 is NO, what is the appropriate approach to identify the relevant equivalent embodiments when assessing validity and/or patentability? Is there, for example, a requirement that relevant equivalent embodiments must be likely being used in practice?

Please answer YES or NO and you may add a brief explanation.

7) If the answer to question 4 is NO, does the patent office consider the equivalent scope of protection when assessing validity and/or patentability, or is such discussion limited to post-grant proceedings?

Please answer YES or NO and you may add a brief explanation.

**II. Policy considerations and proposals for improvements of your Group's current law**

8) According to the opinion of your Group, is your current law regarding the doctrine of equivalents adequate and/or sufficient? Please answer YES or NO and you may add a brief explanation.

Yes

The Hungarian Group is of the opinion that the Hungarian Patent Act addresses the doctrine of equivalents in an adequate and sufficient way, and in line with the European Patent Convention. Art. 24 of the Hungarian Patent Act constitutes an appropriate balance between providing legal certainty and leaving room for case law development.

9) According to the opinion of your group, is there (still) a need for a doctrine of equivalents under your law, i.e. in that there needs to be a distinction between the scope of protection and the scope of claims? Please answer YES or NO and you may add a brief explanation.

Yes

See our answer to question 10) below.

10) According to the opinion of your group, what is the principal justification of the doctrine of equivalents? What factor does legal certainty for third parties play in this regard?

Literal claims are the only possible but still an imperfect means of defining inventive ideas to be protected. Since the claims contain the applicants' expression of their intention, general rules governing the interpretation of declarations of rights may also play a role in determining the intended meaning. Thus, while ensuring legal certainty and a fair balance between the rights of the applicant and those of third parties, there should be some extent of flexibility in extending patent protection to cases of application of the idea of the invention outside the literal meaning of the claims because, despite the best efforts and the best skills, the claims often cannot be formulated in such a precise delimited manner that they cover all possible applications of the invented technical idea. On the other hand, said requirement of fair balance

includes not to extend patent protection by equivalency to embodiments for which no literal protection would have been granted due to any patentability objections.

11) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

The Hungarian Group notes that the "function-way-result" test may not be readily applicable to some technical fields. For example, in chemistry, biochemistry and in the pharmaceutical field the condition “in substantially the same way” often may not be readily interpreted. The Hungarian Group proposes for such cases to reduce the "function-way-result" test to a "function-result" test, i.e. to the “4a function test” and not to consider the way of achieving the result.

**III. Proposals for harmonisation**

12) Do you consider harmonisation regarding the doctrine of equivalents as desirable in general? Please answer YES or NO and you may add a brief explanation.

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.*

Yes

13) Do you see any need to amend and/or change the Q175 Approach?

a) Is there (still) a need for doctrine of equivalents, i.e should there be a distinction between the scope of protection and the scope of claims? Please answer YES or NO and you may add a brief explanation.

Yes

See our answer to question 10).

b) Alternatively, instead of a doctrine of equivalents, would it better to require more comprehensive claim drafting, or would you prefer any other alternative approaches to address the material issues underlying the doctrine of equivalence, such as e.g. an exhaustive list of equivalents set forth in the specification? Please answer YES or NO; in particular if answering YES, please add a brief explanation.

No

One of the main benefits of equivalency is that infeasible drafting burdens of alternative approaches can be avoided.

c) Do you see any need to amend and/or change the 4a function test in Q175? Please answer YES or NO and you may add a brief explanation.

No

Noting again that in Q175 the 4a function test and the 4b difference test were intended to define equivalency in combination, the 4a function test and the 4b difference test are addressed below as subconditions of equivalency.

The Hungarian Group is of the view that the 4a function test is not to be amended as it provides a practical, fair and balanced guidance in assessing equivalency.

d) Do you see any need to amend and/or change the 4b difference test in Q175? Please answer YES or NO and you may add a brief explanation.

Yes

The 4b difference test in itself is not sufficiently specific and therefore should not be applicable. Even in case of combining the 4a function test and the 4b difference test as proposed in Q175, the resulting overall test is considered diluted by the vague 4b difference test.

The Hungarian Group is in favor of the "function-way-result" test for technical fields where the condition “in substantially the same way” can be readily interpreted, and favors a reduced "function-result" test for technical fields, such as chemistry, biochemistry and the pharmaceutical field where the condition “in substantially the same way” often may not be readily interpreted.

e) Do you see any need to amend and/or change the 5a exclusion in Q175? Please answer YES or NO and you may add a brief explanation.

No

f) Do you see any need to amend and/or change the 5b exclusion in Q175? Please answer YES or NO and you may add a brief explanation.

No

g) Do you see any need to amend and/or change the 5c exclusion in Q175? Please answer YES or NO and you may add a brief explanation.

Yes

The express and unambiguous exclusion of an element from the claim to overcome a prior art objection can occur in post-grant proceedings as well. Therefore, the coverage of the 5c exclusion should be extended to post-grant proceedings. Furthermore, not just prior art but any patentability objection may necessitate an express and unambiguous exclusion of an element from the claim, so the coverage of the 5c exclusion should also be extended to any patentability objection.

14) Whether (unclaimed) alternative embodiments disclosed in the specification should be excluded from infringement by equivalence

a) Should equivalent infringement categorically exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims, i.e. are such alternative embodiments implicitly disclaimed from the equivalent scope of protection? Please answer YES or NO and you may add a brief explanation.

No

The Hungarian Group is of the opinion that such alternative embodiments should not be categorically excluded from infringement by equivalence, but each of such embodiments should be assessed on a case-by-case basis and by taking into account all relevant circumstances, such as the whole context of the description, claims and drawings.

b) Should equivalent infringement exclude those embodiments which are disclosed in the patent specification as possible alternatives of the means literally mentioned in the granted claims if the patentee excluded them from the claim during prosecution of that patent to overcome a prior art objection? Please answer YES or NO and you may add a brief explanation.

Yes

The Hungarian Group is of the opinion that both legal certainty and fair balance considerations definitely lead to the exclusion of those embodiments from equivalent infringement.

15) Should one consider the equivalent scope of protection conferred by a patent when assessing validity and/or patentability of that patent? In other words, should it be possible that, considering the equivalent scope of protection of a particular patent, this patent is deemed to

a) lack novelty, and/or

Please answer YES or NO and you may add a brief explanation.

No

The starting point should be a patent with a valid and patentable literal scope. The valid and patentable literal scope literally delimits the invention from the prior art by means of the literal claim wordings. Patent prosecution and post-grant proceedings can only deal with the literal scope as (i) it is theoretically impossible to exclude, by means of literal wordings, literally not covered embodiments and (ii) handling each and every possible equivalent of each and every claim feature/element would be an unmanageable burden both for the applicant and for the patent granting authorities. Thus, it is both theoretically and practically impossible to consider the equivalent scope of protection when assessing validity and/or patentability.

A patent with a valid and patentable literal scope shall be considered a valid patent. If beyond the literal scope an additional scope is included on the basis of equivalency, taking into account the above equivalency considerations, then such equivalent scope will form part of the valid scope of the patent, and on the contrary, a scope that is not included will not form part of the valid scope of the patent. However, this analysis is to be carried out in the light of a given embodiment. Thus, as the real question is always whether a given embodiment is covered by the valid scope of the patent, in the opinion of the Hungarian Group, the lack of symmetry problem between infringement and validity/patentability as mentioned in e.g. point 13) of the Study Guidelines is a theoretical one and should not arise in assessing infringement.

As a conclusion, the equivalent scope of protection conferred by a patent should only be considered when assessing enforcement aspects and not for assessing validity and/or patentability.

b) lack inventive step (non-obviousness), and/or

Please answer YES or NO and you may add a brief explanation.

No

c) lack sufficiency of disclosure, and/or

Please answer YES or NO and you may add a brief explanation.

No

d) lack plausibility, and/or

Please answer YES or NO and you may add a brief explanation.

No

e) claim added matter?

Please answer YES or NO and you may add a brief explanation.

No

*Even if your answer to question 15 is NO, please address the following questions:*

16) When assessing validity and/or patentability against the equivalent scope of protection, should the relevant embodiments be limited to those embodiments which are attacked as “equivalent infringement” in a specific case by the patent owner (or an otherwise entitled person)?

Please answer YES or NO and you may add a brief explanation.

–

See our answer to question 15a). The applicability of equivalency should be considered only with respect to those embodiments which are attacked as “equivalent infringement” in a specific case.

17) If the answer to question 16 is YES, should anyone be entitled to attack the validity and/or patentability of the patent based on such argument, or only the alleged infringer?

Please answer YES or NO and you may add a brief explanation.

–

See our answer to question 15a).

18) If the answer to question 16 is NO, what should be the appropriate approach to identify the relevant equivalent embodiments when assessing validity and/or patentability? Should there be, for example, a requirement that relevant equivalent embodiments must be likely being used in practice?

Please answer YES or NO and you may add a brief explanation.

–

See our answer to question 15a).

19) If the answer to question 16 is NO, should the patent office consider the equivalent scope of protection when assessing validity and/or patentability, or should such discussion be limited to post-grant proceedings?

Please answer YES or NO and you may add a brief explanation.

–

See our answer to question 15a).

20) Please comment on any additional issues concerning any aspect of equivalents that you consider relevant to this Study Question.

In many jurisdictions patent provisions stipulate that the claims shall be supported by the description (see e.g. Art. 84 EPC and Art. 60(3) of the Hungarian Patent Act). This practically means that the description has to be in line with the claims, and in case of any claim amendments, the description has to be brought into line with the amended claims. The harmony between the claims and the description also involves that disclosed but not claimed embodiments are deleted from the description or are explicitly denoted as not-claimed embodiments. Experiences, however, may show that this requirement is not consequently enforced by patent granting authorities. The Hungarian Group would welcome a harmonization towards such a requirement and towards a patent practice consequently enforcing this requirement. This could contribute to avoid legal uncertainty resulting from ‘disclosed but not claimed and not disclaimed' situations.

The Hungarian Group finds the following further aspects of equivalency as particularly relevant:

- According to the experiences of the Hungarian Group the Hungarian courts are reluctant to grant preliminary injunctions if the request is based on equivalent infringement. The rationale of this practice is that the complexity of assessing equivalency is beyond the framework of such summary proceedings. There might be different approaches in different jurisdictions in this respect.
- Recently a particular emphasis can be experienced in the doctrine of equivalents with respect to the ability of patentees to gain exclusivity over equivalent “after-arising technologies”, i.e. technologies that did not exist on but are developed after the filing date. After-arising technologies are often called

"unforeseeable technologies / embodiments". Patent literature shows that there may be considerable differences in jurisdictions in this respect.

The Hungarian Group would welcome future AIPPI studies of the above issues of equivalency.

21) Please indicate which industry sector views provided by in-house counsels are included in your Group's answers to Part III.

Pharmaceutical industry