

# Kluwer Patent Blog

## Patent claim construction – reference to a multitude of preceding claims

Markus Lenssen (Rospatt Osten Pross) · Friday, June 6th, 2014

Just recently, the judgement of the German Federal Court of Justice (Bundesgerichtshof, BGH) in re [X ZR 31/11](#) concerning a tyre removal machine has been published. This judgement is of relevance as the Federal Court of Justice had to answer a question of claim construction relevant in infringement and nullity proceedings likewise. The relevant question was whether a claim referring back to a multitude of preceding claims necessarily requires that all features of the multitude of claims referred back to are fulfilled or not.

In this particular case about EP 1 177 920 there have been two independent subclaims (claims 1 and 13) and eleven subclaims dependent on claim 1 (claims 2–12). Whereas claim 1 (and the following subclaims 2–12) defined “an automatic device for mounting and removing a tyre” claim 13 referred to a tyre removal machine comprising the automatic device. Claim 13 was simply drafted as follows:

“A tyre removal machine characterised by comprising a device in accordance with claims 1 to 12.”

The parties argued whether this wording necessarily required that the tyre removal machine has a device implementing all of the claims 1–12 or if any combination of the claims 1 to 12 would be sufficient. Presumably, there would not have been much dispute if the wording of claim 13 would have been:

“A tyre removal machine characterised by comprising a device in accordance with one of the claims 1 to 12.” (addition underlined)

In the context of this particular case this difference became relevant when the patent-ee needed to restrict the patent in order to keep it alive. Is the scope of protection unduly broadened if claim 13 is used to modify claim 1 so that a tyre removal machine comprising all the features of former claim 1 (but not necessarily of the subclaims 2–12) is claimed? In first instance, the Federal Patent Court took this view and nullified the patent in its entirety. But on appeal, the Federal Court of Justice overruled the Federal Patent Court and reasoned that a patent claim wording referencing back to a multitude of preceding subclaims does not necessarily need to be interpreted as such that all features of all mentioned subclaims must be fulfilled.

This ruling of the Federal Court of Justice is based on the following considerations: First of all, the wording of the patent claim would already allow both interpretations. Referring back to claims

1–12 whereas claims 2–12 describe individual and particularly advantageous arrangements could be understood as if the tyre removal machine should comprise a device according to the preceding claims individually or in combination. Subclaims 2–12 have differentiated back-references and allow for a multitude of different combinations of the device. Secondly, the patent specification and the figures showing a tyre removal machine do not indicate which single features are absolutely necessary for such a tyre removal machine.

After the very formalistic view of the Federal Patent Court that nullified the patent the appeal judgement of the Federal Court of Justice allows to take a more hands-on approach. Restricting the wording of claim 13 to a mandatory combination of all preceding claims seems to be a bit over-ambitious. And it is good practice to take the patent specification into account as well when interpreting patent claims.

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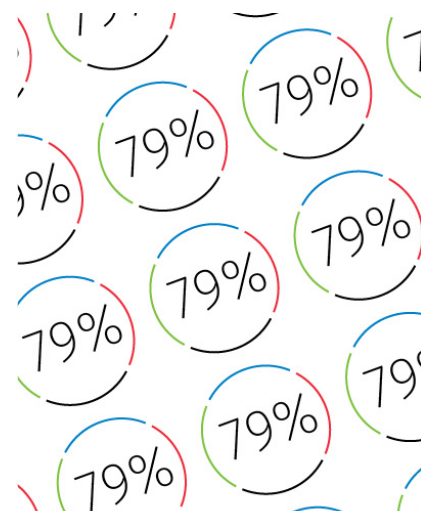
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