News about the doctrine of equivalence in German case law

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The doctrine of equivalence has seen some kind of renaissance in German case law recently. In short words, there are three questions to be asked to decide for equivalent infringement if there is no literal infringement. The first one being the question about the effect of the different solution. Do the means used to solve the problem underlying the invention objectively have the same effect? If so, would this different solution have been discovered by the man skilled in the art at the time of the priority date? The objective of this second question to be asked is whether it was kind of obvious to use the different approach instead even though it does not fall under the literal meaning of the patent claims. Finally and most crucially, it has to be asked whether the different solution to the problem is of the same value as (is equivalent to) the solution presented by the patent claim. It is decisive whether the thoughts that need to be thought to reach the different solution are somehow orientated along the patent claim so that the man skilled in the art would realise that the different solution is on par with the claimed solution.

Typically, the answer to the last question is guided by considering whether the patent specification gives some hints into the (equivalent) direction. The counter-example usually being that a solution the patent specification explicitly mentions as unfavourable or disadvantageous would not be equivalent to the claimed solution.

The Federal Court of Justice (Bundesgerichtshof, BGH) has now ruled that the test for equivalence is not limited to the hints from the patent specification as explained before (BGH, Court Order of 6 May 2014 – X ZR 36/13, GRUR 2014, 852). This case dealt with a patent (EP 0 927 292) directed to an "end stop on c-shaped guide profile for motor-driven objects" used for motor driven door openers. Although the court could not finally decide the case but had to refer it back to the appeal court it gave some advice on how to deal with the question of equivalence. First of all, in this case it could not be argued that the attacked embodiment would represent a solution that is described as not covered by the patent claim as this would require that the patent claims somehow demonstrate that a selection of covered and not covered embodiments should be protected despite any potential equivalence. This was not the case here.

Contrary to the first instance court that did neglect equivalent infringement explicitly and contrary to the appeal court that did not deal with the issue at all the Federal Court of Justice saw room for equivalent infringement. The first instance court did not find for equivalent infringement as it could not find any reference why a person skilled in the art would think of the variant as being equivalent in the patent specification. However, the Federal Court of Justice did not follow this reasoning but stated the following: Even though the patent specification was silent about the variant and did not lead the person skilled in the art to this different solution this does not necessarily mean that such a solution could not be regarded as an equivalent infringement. Any reference in the patent specification might serve as an indication for equivalence but this does not constitute an inevitable condition. Equivalence could also be found if the patent specification is silent about the different solution.

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