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Enabling Disclosure – A New Rule of Reason for Patentability?

Thomas Musmann (Rospatt Osten Pross) · Friday, July 8th, 2011

This is to report on a new tendency in the jurisdiction of the Federal Patent Court to use the prerequisite of enabling disclosure (Art. 83 EPC) as an unpredictable rule of reason for patentability.

Based on a Federal Supreme Court decision of 2001 (“Taxol”), it had been established case law in Germany that a patentee may claim a broad scope of protection even if the patent specification only disclosed one way to accomplish the object of the invention. Namely, in the “Taxol” case, the claimed substance could not be obtained by known esterification methods, and the patent specification mentioned only one specific esterification method which would produce the claimed substance. Still, the Federal Supreme court allowed a claim which encompassed an arbitrary esterification method.

Then, in 2010, the Federal Supreme Court had to decide an extreme case (“thermoplastische Zusammensetzung”). Although the patent specification disclosed a manufacturing method leading to substances within only a limited range of physical characteristics, patentee claimed all substances that possessed a certain minimum impact strength and a certain maximum resistivity. The physical properties of the substance were therefore delimited only in one direction with respect to two antagonizing parameters. In this particular case, the Federal Supreme Court held that the claim in its full scope was not sufficiently disclosed by the specification. In the grounds of the decision, the court noted, inter alia, that it would be unjustified to grant the patentee protection for all substances that fulfilled the abstract features of the claim although the contribution to the state of the art that was actually disclosed in the patent specification did not encompass all of these substances.

The Federal Patent Court recently referred to this decision in many instances, as, e.g. in the case “Buprenorphinplaster”. In latter case, the patent specification mentioned the effect of a better skin penetration of a specific analgesic when a combination of a softener and a solvent was used in a matrix. In the examples of the specification the solvent always was acidic. However, the claim did not contain the delimitation that the solvent needs to be acidic. The Federal Patent Court held that there was an enabling disclosure only for acidic solvents. The group of solvents as such, not delimited to acidic solvents, was so large that it would be unjustified to grant the patentee protection also for matrices that contained a non-acidic solvent. The grounds of the decisions seem to implicate that the Federal Patent Court tries to establish a rule of reason for patentability. The court wishes to evaluate to which degree it seems to be justified to reward the patentee and where the boundary of a justified reward lies.

In my opinion this leads to a dilution of predictable rules for patentability. You can eventually justify the nullification of almost any patent claim that contains abstract terms with the argument that the patent specification demonstrates the effect of the invention only with respect one or more specific subsets within these abstract terms. For example, in the decided case, the Federal Patent Court could as well have delimited the “justified” scope of protection to the specific acidic solvents mentioned in the examples of the patent, arguing that only for these specific solvents the effect was actually demonstrated, whereas the term acidic solvent as such encompassed so many different substances that it would be unjustified to grant the patentee a reward also for matrices with acidic solvents not explicitly mentioned in the specification. For me it is impossible to justify the nullification of a claim just with the argument that patentee is rewarded beyond his actual contribution to the state of the art.

I am therefore glad to see that the Federal Supreme Court has just last month confirmed the general rule of the “Taxol” decision that one reproducible way to realize the teaching of the claim is usually sufficient in terms of enabling disclosure (“Substanz aus Kernen und Nuessen”) and that according to another recent decision of the Federal Supreme Court (“Klammernahtgeraet”) a sufficient disclosure is even fulfilled if the patent itself does not directly disclose a useful example for practicing the invention, so long as the general knowledge of the one skilled in the art enables him to realize the invention.

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