

# Kluwer Patent Blog

## Is there still such thing like infringement under the doctrine of equivalence in Germany? – Recent trends

Thorsten Bausch (Hoffmann Eitle) · Saturday, November 26th, 2011

On 13th September 2011, the German Federal Court of Justice (FCJ) rendered a decision under the keyword “Diglycidverbindung”, i.e. diglycidyl compound (case number X ZR 69/10).

The case revolved around a license agreement. Defendant alleged that he was using a variant of the patented process which no longer fell within the scope of the license. The lower instance courts held otherwise, i.e. confirmed that Defendant’s variant is covered by the patent in suit. The FCJ reversed this judgement and remanded for further consideration.

Claim 1 of the patent in suit (DE 36 17 672) is concerned inter alia with a method for the manufacture of a reagent wherein a solid phase is reacted in a first step with a diglycidyl compound, i.e. a compound having two glycidyl groups (which by definition each comprise an epoxy group), to provide free epoxy groups. That means one of the two epoxy groups of the glycidyl moieties is reacted with the solid phase so that the second one remains free and is as such available for further reaction with linking groups and ligands in subsequent method steps. Specifically, the ligands attached in the final step can be polycarboxylic acids.

Moreover, in Example 9 of the description of the patent in suit, an alternative is disclosed, namely the binding of the polycarboxylic acid to an amino- or mercapto-derivatised organic solid phase.

In the accused infringing manufacturing method, the free epoxy groups were obtained in a different way. Namely, rather than by reacting with a diglycidyl compound, they were obtained by copolymerizing compounds having only a single glycidyl group. So, the feature of the reaction of the solid phase with a diglycidyl compound was found not to be literally realized.

However, the first and second instance courts held that equivalent usage is made of the claimed invention. Their main argument was that the alternative method of providing free epoxy groups in the potentially infringing manufacturing method is equivalent in terms of effect and readily available to the skilled person.

The FCJ did not accept this and emphasized that this amounts to relying on a general inventive idea. The court emphasized that the impugned decision has not sufficiently considered that the claim does not fully exploit the technical contents of the invention as laid down in the description.

Referring to its earlier decision “Okklusionsvorrichtung” of 10th May 2011, the court initially stressed the following: Where the description discloses several ways of achieving a specific

technical effect, as a rule, patent infringement by equivalent means is to be denied if only one of these ways is incorporated in the claim. So it seems that the usage of the invention under the doctrine of equivalence would have to be denied in line with “Okklusionsvorrichtung” when the accused infringing solution exactly corresponds to the (unclaimed) method mentioned as an alternative in Example 9. However, the FCJ considered it possible that the Defendant’s solution represents a third way to obtain the same effect, i.e. the binding of the polycarboxylic acid to the organic solid phase, which may be distinct both from the literal scope of the claim and from the alternative disclosed in Example 9. In such a case, the FCJ did not wish to categorically rule out infringement under the doctrine of equivalence and therefore remitted the case back to the Higher Regional Court for further exploration of the facts.

Assuming that there is such a “third way situation” as addressed above, it would in the FCJ’s view not be sufficient that the variant is equally good for solving the technical problem underlying the invention as the protected solution. Rather, the considerations that were necessary to arrive at the variant must be guided by the terms of the claim (after proper claim construction). Moreover (this is stated in the Headnote of the decision), at least two requirements would have to be met for infringement under the doctrine of equivalence: (1) the specific effects of the variant are in accord with the claimed solution, and (2) the variant differs from the alternative merely outlined in the description but not in the claims in a similar fashion as the claimed solution differs from it. Requirement (2) seemingly refers to the alternative mentioned in connection with Example 9.

It will be interesting to see how the “third way situation” will be dealt with by the Higher Regional Court.

In summary, according to the FCJ decision “Okklusionsvorrichtung” an example disclosed in the description that clearly does not fall under the claim cannot be covered thereby using the doctrine of equivalence. However, according to the decision “Diglycidverbindung”, if the variant does neither fall under the literal scope of the claim nor corresponds to a (non-claimed) example in the description, infringement by equivalent means still seems to be possible under certain circumstances.

Stephan Disser

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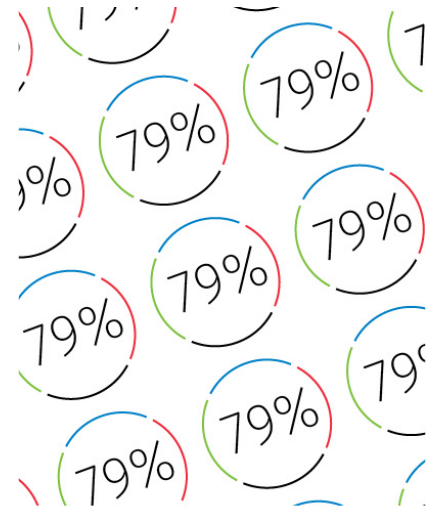
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This entry was posted on Saturday, November 26th, 2011 at 12:16 am and is filed under [Enforcement](#), [literally fulfil all features of the claim](#). The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser's questions. In the UK, the equivalence doctrine was most recently discussed in *Eli Lilly v Actavis UK* in July 2017. In the US, the function-way-result test is used.">Equivalents, Germany, Scope of protection  
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