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Recent Decisions of the Federal Court of Justice on the Doctrine of Equivalence: Consequences for Patent Practitioners

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In its decision "Okklusionsvorrichtung" (Aga v. Occlutech), the Federal Court of Justice (FCJ) denied patent infringement by equivalent means since the contested infringing embodiment was disclosed in the description as an alternative to the claimed one. This decision was followed in the decision "Diglycidverbindung".
In a nutshell, the FCJ, in continuation of its decisions "Schneidmesser I, II" in 2002, reaffirmed in these recent decisions the paramount importance of the claims in determining the scope of protection of a patent.

Specifically, the FCJ emphasized in "Okklusionsvorrichtung" that where a number of alternatives which are equally effective at solving the problem are disclosed in the description, but only one of the alternatives is claimed, patent protection is limited to the claimed alternative. Therefore, making use of a disclosed but unclaimed alternative does not normally constitute infringement by equivalent means.
In the case to be decided upon in "Diglycidverbindung" the contested infringing manufacturing method was found to represent a third way differing from both the claimed way and a second way that was disclosed in the description but was not claimed. In this case, infringement by equivalent means may, in the FCJ's view, still be possible if the contested infringing method turns out to be closer to the claimed process than the process disclosed in the description. The FCJ remanded the case for further exploration of the facts.

What can patent practitioners learn from the above recent case law of the FCJ?

First of all, in view of the primacy of the patent claims, one should make sure that all potentially patentable variants of the invention are claimed. Hoping to regain unclaimed variants through the doctrine of equivalence is now less likely than ever to be successful. This is in particular the case if the unclaimed variants are disclosed in the description, in which case "Okklusionsvorrichtung" virtually rules out any protection under the doctrine of equivalence. Therefore, when drafting patent applications, one should, if possible, refrain from disclosing equally effective variants of the invention which are not to be covered by the claims.

Moreover, if the claims are amended during prosecution, the description should be adapted to the amended claims with the utmost care. Namely, inadvertently leaving unclaimed variants of the invention in the description may allow a potential infringer to realize precisely one of these

variants and to rely on “Okklusionsvorrichtung” in defense of an infringement claim.

For instance, in the case of chemical patent applications, bringing the description into accordance with claims amended to include a narrower generic formula than initially claimed can be a risky task in the aftermath of “Okklusionsvorrichtung”. Chemical patent applications sometimes contain hundreds or even more than a thousand exemplary individual compounds which may no longer be covered by the amended generic formula. For the above reasons, failing to delete a single individual compound that is no longer covered by the literal scope of the claims may have serious consequences in that the rationale of “Okklusionsvorrichtung” would be directly applicable so that this very compound would be excluded from the scope of equivalence.
Even a perfect adaptation of the description to the amended claims may in the future no longer save patentee from such consequences.

This is because it is possible that a “simple” form of file-wrapper estoppel will be admitted in Germany in the future. The following citation from Section 25 of “Okklusionsvorrichtung” (our translation) can be interpreted as a cautious hint in this direction:
Therefore, it does not need to be discussed here either whether the principle that measures in the grant proceedings which are not reflected in the patent may not be drawn upon (…) also prohibits the use of patent publications such as the patent application published by the office or earlier versions of the patent specification amended at a later stage, e.g. during opposition proceedings or limitation proceedings, if the content of the relevant version of the patent specification only becomes apparent from a comparison with these other versions, and, as a result, is also reflected in the relevant version (…).
Taking account of the above citation, it is by no means certain whether a properly adapted description will provide a patentee with better chances of extending the equivalent protection scope also to previous embodiments of the invention that are no longer claimed. Hence, the key to success is more than ever to do a good job before the decision to grant. All patentable embodiments of the invention known at the time of drafting must be properly reflected by the claims to be granted.
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This entry was posted on Monday, March 5th, 2012 at 7:28 pm 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
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