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## Tell me what you want! – Determining the subject matter of the litigation in patent infringement cases

Henrik Timmann · Friday, March 30th, 2012 · Landmark European Patent Cases

On the defendant's side, knowing what the patent dispute is all about is essential for your strategy. Not only do you need to adjust your non-infringement arguments to the plaintiff's assertions concerning how the features of the claim are fulfilled in the attacked embodiment. Even more importantly, the scope of an infringement verdict is determined by the "subject matter of the litigation". An injunction covers not only products that are explicitly mentioned in any of the parties' briefs, but all products that have the same technical features as the ones discussed in the course of the proceedings. Deciding which technical features these are is decisive for work around solutions, and decisive for whether a ruling has the effect of *res iudicata* for a particular new embodiment.

According to long-term standard practise in Germany, the "subject matter in dispute" is determined by two combined factors: The motions as filed by plaintiff ("Klageanträge"), as well as the factual basis for these motions ("Lebenssachverhalt").

As now confirmed again by the Federal Supreme Court in a decision of 21 February 2012 (X ZR 111/09) under the name of "Rohrverteilerdüse II", the second factor is of utmost importance specifically in patent matters. The plaintiff's motions usually only repeat the wording of the asserted patent claims. This, however, does not mean that an injunction issued on the basis of these motions would cover each and every embodiment that eventually infringes the patent literally, or that a non-infringement verdict would have the effect of *res iudicata* for other embodiments that the patent holder could have attacked at the same time, as the Federal Supreme Court now clarified. Instead, you have to take into consideration the plaintiff's assertions in the course of the proceedings, in particular in the complaint brief, as to which physical properties of an attacked embodiment allegedly fulfil which features of the patent claims. It is the plaintiff who decides by his pleadings what the "subject matter of the litigation" is. This brings you to a much narrower understanding of the scope of a verdict.

Embodiments which use different technical features than those that have been pleaded are consequently not covered by the findings of the infringement court, even if under the rules of substantive law the decision would have to be the same or essentially the same as for the pleaded embodiments. If the plaintiff wants to get an injunction against a different embodiment, he must, and he can, file a new complaint on the merits.

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