

Kluwer Patent Blog

What happened to/in Summer 2014 in Germany?

Thorsten Bausch (Hoffmann Eitle) · Friday, September 19th, 2014

To the extent that summer 2014 existed at all in central Europe, experts agree that it is now definitely over. There is some controversy whether we ever had summer in Germany this year, but at least it was proven that life without air conditioning is possible.

Meanwhile, the Munich IP Community is busily preparing for Oktoberfest starting tomorrow. So while we are all still sober, time for a little summary on the latest developments in the case law of the German Federal Court of Justice (FCJ) in “Summer” 2014.

In one decision ([X ZR 36/13](#)), the FCJ took the opportunity to explain its current thinking on the **scope of equivalence** a bit further. In the decision under appeal, the Higher Regional Court of Karlsruhe had dismissed Plaintiff’s appeal against the decision of the Regional Court to reject Plaintiff’s infringement action. The Higher Regional Court granted no leave for further appeal, but Plaintiff did not give up and filed a “Nichtzulassungsbeschwerde”, i.e. an appeal against the decision not to grant leave for further appeal. With that, Plaintiff was successful.

The Higher Regional Court had rejected Plaintiff’s claim for literal infringement and found it not necessary to investigate whether the accused infringement embodiment may have infringed claim 1 under the doctrine of equivalents, since it was of the view that Plaintiff no longer asserted equivalent infringement. Plaintiff strongly disagreed with this opinion and claimed that its right to be heard was violated.

After reviewing the files and the parties’ submissions, the FCJ disagreed with the Higher Regional Court and remanded the case back. The FCJ thought that it could at least not be excluded that the Higher Regional Court had found for equivalent infringement, had it properly examined Plaintiff’s submissions. Infringement under the doctrine of equivalents could also not be denied on the basis alone that the considerations necessary to find the variant were not sufficiently oriented at the patent claim.

The FCJ further explained that its earlier decisions [Okklusionsvorrichtung](#) and [Diglycidverbindung](#) are not applicable to the present case. In these decisions, infringement under the doctrine of equivalents was denied since the patent at stake actually disclosed the accused embodiment in the description, but did clearly not cover it by the wording of the claims. The FCJ interpreted such a constellation as a deliberate “Auswahlentscheidung” (selection decision). Patentee is responsible to formulate the claims according to its needs and third parties may rely on that something which is described in the patent but clearly not claimed is free for everyone’s use. Yet in the case of [X ZR 76/13](#), there was no such disclosure of the accused embodiment in the description.

Moreover, the FCJ held that it is not necessary for finding equivalent infringement that the patent specification contains statements that guide the skilled person towards the accused infringing embodiment. If there are such statements in the description, they can be used to support a finding of equivalent infringement, but they do not necessarily need to be present.

It will be interesting to see what the Higher Regional Court will do with these general considerations and how this case will develop further.

A couple of further summer decisions of the FCJ deal, inter alia, with the question of **added matter / unallowable extension**. Three of them related to various embodiments of stents (X ZR 12/11, X ZR 19/11 and X ZR 20/11, all available [here](#)) and in all of them as well as in a further one dealing with elevators (X ZR 74/11) the FCJ followed its earlier patentee-friendly case law on added matter. The following paragraph 19 from X ZR 19/11 may serve as just one example (slightly simplified translation by the author, this is no easy stuff when you read it in the FCJ's High German):

“According to the jurisprudence of the Senate the subject matter of a claim is originally disclosed if and when the person skilled in the art can directly and unambiguously derive the claimed teaching as a possible embodiment of the invention of the original application. In doing this, generalizations of originally disclosed embodiment examples are also allowed to avoid undue restrictions of the applicant. A “widely” formulated claim can at least be considered okay from the point of view of unallowable extension, if an originally disclosed example embodying the invention presents itself to the skilled person as an embodiment of the more general technical teaching circumscribed in the claim and if this teaching in its claimed generality was for him already derivable from the application – whether in the form of a claim, whether by the overall context of the original documents – as belonging to the as filed invention (FCJ, judgment of 17th July 2012 – X ZR 117/11 *Polymerschaum*, judgment of 11 February 2014 – X ZR 146/12 *Kommunikationskanal*).”

To give a seasonal example, suppose that the original application disclosed an example of a certain 1 litre beer mug made out of stoneware, i.e. a so-called “Stein”. Claim 1 of the application related more generally to a drinking vessel comprising a handle that breaks away in a shatterproof way when the vessel collides with another hard object, e.g. a head (indeed a relevant problem in Munich over the next 15 days). Applying the FCJ's thinking, one should probably accept an amendment of claim 1 so as to recite “a drinking vessel made of stoneware comprising a handle...”. The FCJ would not require the applicant to include that the drinking vessel is for beer and/or that it should, when properly filled, at least 1 litre of beer.

Well then... Prost!

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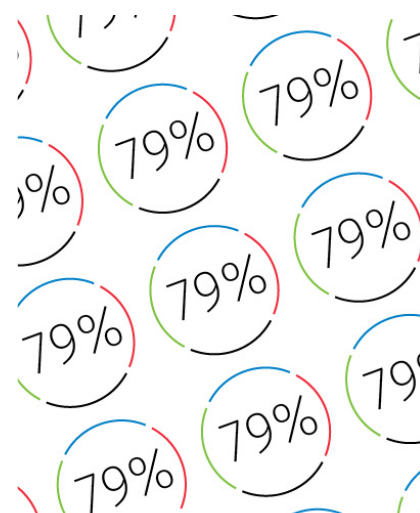
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This entry was posted on Friday, September 19th, 2014 at 7:07 pm and is filed under [Art. 123\(2\) of the European Patent Convention \(EPC\)](#), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. (*G 1/93*, OJ 1994, 541) The ‘gold standard’ of the European Patent Office’s Board of Appeal is that “any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed” (*G 3/89*, OJ 1993,117; *G 11/91*, OJ 1993, 125).“>Added matter, 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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