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Federal Court of Justice: Claims Normally Cover at Least one Embodiment

Thorsten Bausch (Hoffmann Eitle) · Tuesday, January 27th, 2015

by Niels Hölder and Thomas Koch

In “Zugriffsrechte” (Access Rights) ([docket X ZR 35/11](#)), the Federal Court of Justice decided that a claim can in principle not be construed such that it covers none of the embodiments described in the specification.

To simplify the facts, the claim in question specified two process steps. The Federal Patent Court had interpreted the claim so as to require that the steps are performed in the specific order mentioned in the claim, thereby rendering the subject matter novel over the prior art where this specific order had not been disclosed ([docket 5 Ni 67/09](#)). However, in all of the embodiments described in the specification, those steps were applied in a different order.

In the appeal proceedings, the Federal Court of Justice concluded that the claim was not limited to a certain order of the process steps because otherwise, the claim would not cover any of the embodiments described in the specification. The court ruled that such an interpretation is only possible in exceptional cases, e.g. if no other interpretation reasonably makes sense. In the case at hand, such other interpretation was possible, since the claim could be construed as covering the embodiments. The Federal Court of Justice repealed the first instance decision and declared the patent invalid for lack of novelty on the basis of the found interpretation covering the embodiments.

The decision should be duly considered by applicants that at a certain point of time during prosecution need or want to amend their claims in a way excluding all embodiments described in the specification – a scenario which, while not being unrealistic, will not occur very often, at least not before the EPO with its strict disclosure requirements. If it is possible and desired, however, the applicant should carefully draft the claim and/or amend the specification so as to make sure that no interpretation is possible that would include the described embodiments.

In infringement proceedings, on the other hand, the Federal Court of Justice’s interpretational rule can be useful for patentees lacking sufficient technical arguments as to why a claim language covers an embodiment which is described in the specification. However, this would arguably only work in cases where the claim (i) is sufficiently vague and (ii) covers no other embodiment described in the specification because otherwise, the principle as set forth in the Federal Court of Justice’s decision “Okklusionsvorrichtung” (Occlusion Device) ([docket X ZR 16/09](#)) may apply,

according to which a claim does not cover an embodiment which is described but disclaimed.

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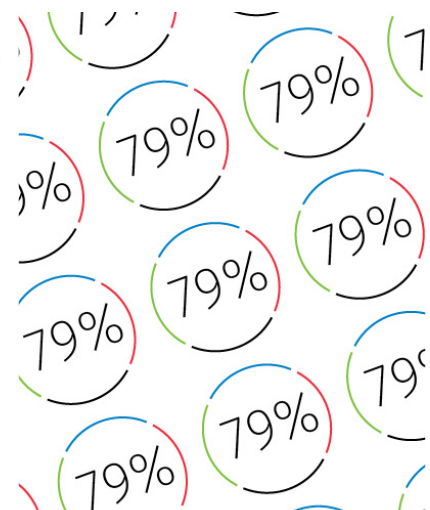
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