Kluwer Patent Blog

New news about the doctrine of equivalence in German case law

Markus Lenssen (Rospatt Osten Pross) · Wednesday, March 18th, 2015

About half a year ago I reported on new developments in German case law concerning the doctrine of equivalence (see http://kluwerpatentblog.com/2014/10/10/news-about-the-doctrine-of-equivalence-in-german-case-law/). Just at the beginning of this month my colleague Bernward posted about further developments (see http://kluwerpatentblog.com/2015/03/02/8966/). Now again, there is a recent decision of the German Bundesgerichtshof (Federal Court of Justice) dealing with the doctrine of equivalence to report on.

The decision "Kochgefäß" ("cooking pan", X ZR 81/13) dealt most prominently with the first question to be asked under the German doctrine of equivalence if there is no literal infringement: Do the different means used by the attacked embodiment to solve the problem underlying the invention objectively have the same effect as the means according to the claim?

The patent concerned cooking pans with a capsular base whereas the lateral wall of the capsular base is shaped in a certain manner to avoid deformation when heated. In principle, such a capsular base is formed of a plate of a good-thermal-conductivity metal (such as aluminium) that is completely surrounded by a metal layer of low thermal conductivity having a greater resistance to oxidation, scratching and corrosion (such as stainless steel). The result is a cooking pan with a heat-radiant base in which the metal layer of good thermal conductivity is completely enclosed or "encapsulated" within the metal of low thermal conductivity of greater resistance to the aforesaid action.

The attacked embodiment implemented all features of the claim except for the feature "capsular base" as the layer of aluminium was not completely covered by stainless steel at the lateral rim.

The first instance and appeal courts both found for equivalent infringement. They ruled that the attacked embodiment showed the same effect to a sufficient extent although there was no all-embracing protection against oxidation etc. The courts decided that such protection would only be a side-effect and not the crucial effect of the invention (being to avoid deformation). Therefore, this side-effect would not have too much influence on the question of equivalent infringement.

However, the Bundesgerichtshof rejected this ruling. Under the doctrine of equivalence it would not be relevant whether an effect is crucial for the invention or only a side-effect. The "same effect" required by the doctrine of equivalence is only obtained if all effects according to the

invention are achieved. The court added that it might be sufficient to achieve an effect necessary according to the claim by modified means even if it is only reached to a limited extent. As these aspects have not been subject of the proceedings so far, the Bundesgerichtshof referred the case back to the appeal court for further analysis.

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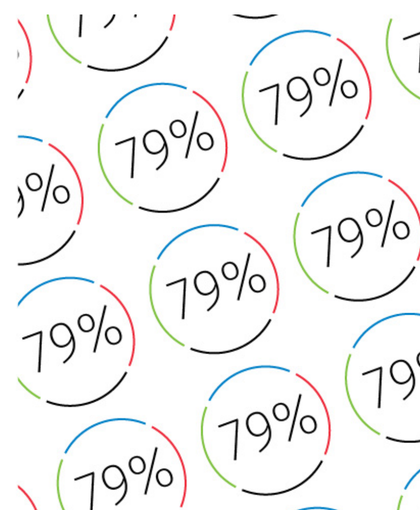

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This entry was posted on Wednesday, March 18th, 2015 at 6:36 pm and is filed under literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial 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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