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Monopoly on Test Results? Protection of Immaterial Products as “Fruits” of a Patented Method under Sec. 9 (3) German Patent Act

Henrik Timmann · Wednesday, April 1st, 2015 · Landmark European Patent Cases

Based on method claims, German Patent Law does not only grant the patentee an exclusive right to exercise the method on the German territory, but also a monopoly to offer, bring into circulation or to use in Germany a “fruit” that is the immediate result of the patented method (Sec. 9 (3) German Patent Act). This is true even if the method has been carried out, and the “fruit” has therefore been “picked”, in another – not designated – country and has then been imported into Germany.

Following a 2012 decision of the Federal Supreme Court (“MPEG-2 Videosignalcodierung”), which specifies how this rule applies to immaterial products like data, the District Court Munich now had to decide whether test results that had been gained by a patented method were also covered by this protection.

Background

According to the jurisdiction of the Federal Supreme Court, an immediate result of a patented method in the sense of Sec. 9 (3) German Patent Act cannot only be a material product, like a substance, a drug or the like, but also an **immaterial product**, like a data sequence (BGH GRUR 2012, 1230, 1233 [Rn. 20 et seq.] – MPEG-2-Videosignalcodierung). In the case at hand, the patented method resulted in a specific order of data bits. The court decided that the immediate result of the patented method was actually not the DVD that carried the data, but **the data sequence itself**. The data sequence had the same standing as a material product because it was **tradable** and **repeatedly usable** without immediately exhausting its value, just like a material product. Furthermore, the specific data sequence had a **sufficient relation to the patented method** since it was dependent on the use of this method.

Decision of the District Court Munich

The District Court Munich was concerned with a patent that claimed a specific method for the detection of a mutation within a nucleic acid fragment. The test result either confirmed or negated the presence of this mutation.

The patent owner claimed that the sale of the test result to a customer in Germany infringed its patent rights under Sec. 9 (3) German Patent Act, even if the blood sample was tested in another country where the patent was not valid. The test result as such was an immediate result of the

patented method and therefore fell under the scope of protection.

The District Court Munich dismissed the case. It found that the **test result** was **not tradable like a material product**. Once disclosed, the test result immediately lost its market value. The human brain could easily memorize the result, and it could be orally communicated and thereby continuously used without maintaining a monetary value. Consequently, it was not justified to treat the test result just like a material product.

Landgericht München I, decision of 20 November 2014, docket No. 7 O 13161/14, GRUR-RR 2015, 93 – FLT3-Gentest
The decision is under appeal at the Oberlandesgericht (Court of Appeal) München, docket No. 6 U 4891/14

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