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Doctrine of equivalence reloaded – Pemetrexed

Markus Lenssen (Rospatt Osten Pross) · Friday, August 19th, 2016

When it comes to infringement of patents, the doctrine of equivalence has gained some more attention in the last few years in German courts and indeed also in some of my earlier posts on this blog (see here). In this context, two decisions of the Federal Court of Justice (Bundesgerichtshof) in 2011 have set up a framework of limitations of the doctrine of equivalence (Judgement of 10 May 2011, X ZR 16/09 – Okklusionsvorrichtung and Judgement of 13 September 2011, X ZR 69/10 – Diglycidverbindung). These decisions address the issue that the specification of a patent deals with several options to reach a certain result whereas the patent claims single out a specific option only. Under such circumstances infringement by equivalent means is generally excluded as the patentee wilfully only incorporated a specific option into the patent claims while presenting other options at the same time. Any option that is disclosed in the specification or that can easily be identified by the skilled person based on the disclosure is generally excluded from patent protection if the reader of the patent has to draw the conclusion that this option – for whichever reasons – should not be protected.

This general rule is confirmed by the most recent decision of the Federal Court of Justice on this issue (Judgement of 14 June 2016, X ZR 29/15 – Pemetrexed). The Federal Court of Justice also refers to the corresponding understanding of the decision in re Improver Corporation v Remington Consumer Products Ltd (Hoffman J), [1990] FSR 181 Rn. 289 of the Court of Appeal of England and Wales and confirms that German and English case law follow the same rules on this issue.

The challenge of the most recent decision Pemetrexed compared to the decisions Okklusionsvorrichtung and Diglycidverbindung was as follows: In both earlier cases Okklusionsvorrichtung and Diglycidverbindung the underlying patent specifications showed two different actual embodiments reaching the intended effect of the invention. However, only one embodiment was included in the patent claims. In contrast, the patent of the new decision only disclosed one embodiment in its specification and this embodiment was included into the patent claims. Only general remarks on the possibility of using a general group of chemical compounds was mentioned in the specification. The attacked embodiment in contrast used a compound of the general group (Permetrexeddikalium) but not the specific compound named in the patent claims (Permetrexeddinatrium).

Unlike the appeal court, the Federal Court of Justice upon revision ruled that excluding infringement by equivalent means just because a specific compound could be found by the skilled person based on the general information in the description cannot exclude infringement by equivalent means per se. Otherwise the result would be that infringement by equivalent means

could never be established as finding the equivalent is one of the preconditions of the doctrine of equivalence as such. There can be constellations in which the fact that a specific embodiment could be found by the skilled person is sufficient to exclude equivalence nevertheless, however, this cannot be established as a general rule but must carefully be analysed on a case by case basis. In the end, the Federal Court of Justice was not in a position to finally decide this question as factual information was missing. It therefore referred the case back to the appeal court for further examination.

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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, Pharma

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