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German Federal Supreme Court (BGH) on entitlement

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In two recent decisions, the Federal Supreme Court developed its case law on entitlement strengthening the position of the plaintiff in entitlement proceedings.

Judgment of 27 September 2016, docket no. X ZR 163/12 (“coating process”)

This decision develops the case law on benefits of use in cases of joint inventorship. If co-inventors are jointly entitled to an invention a patent application conducted by one co-inventor solely in his own name is not justified. In particular if the applicant incorrectly indicates to be the only entitled person the application in his own name cannot be regarded as a necessary act of sustainment of the invention. Thereby, the right to the invention of the other co-inventor as an absolute right is harmed. The omitted co-inventor may claim damages including a compensation for enjoyed benefits of use.

Judgment of 20 October 2015, docket no. X ZR 149/12 (“vehicle steel component”)

This decision renders more precise the test for establishing an entitlement to a patent. In a first step, in order to determine the subject matter of the invention the patent claim needs to be construed, and in a second step it must be compared with the constructive contribution claimed by the plaintiff. In doing so, it has to be examined in how far the teaching of the patent claim corresponds to the teaching that unrightfully had been usurped.

When construing the patent claim its subject matter is not limited to such items in respect to which the invention is reasonably applicable. Rather, the subject matter extends to all items as generally defined in the claim, even if the positive effects of the invention were undesired for some of the items.

When comparing the subject matter of the patent with the entitlement plaintiff’s contribution, identity can be assumed if the plaintiff had produced the items as described in the general claim, even if the positive effect of the invention is not desired in practice for the specific type of item. Further, it is not necessary that the plaintiff was aware of the specific advantages described in the patent if he had realized that the item described in the patent claim can be in fact be used for the field of application.

The plaintiff’s contribution does not have to be implemented in the patent claim. It can be

sufficient if the plaintiff contributed on the way to the final form of the invention.

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