



PATENT LAW UPDATE GERMANY

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RECENT GERMAN CASE LAW ON THE DOCTRINE OF EQUIVALENTS

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A selection decision by the patentee excludes patent infringement under the doctrine of equivalents

– Making use of an embodiment disclosed but unclaimed by the patent does not constitute infringement under the doctrine of equivalents (c.f. German Federal Court of Justice (FCJ) – Okklusionsvorrichtung [occlusion device] and Diglycidverbindung [diglycidyl compounds]). The embodiment not claimed must be explicitly disclosed. It is not sufficient that the embodiment is obvious to the skilled person based on the disclosure in the patent description (FCJ – Pemetrexed and V-förmige Führungsanordnung [V-shaped guide formation]). The FCJ has not yet decided whether disclosure only in the current version or also in earlier versions of the patent description are relevant.

In two recent decisions, Pemetrexed and V-förmige Führungsanordnung, the FCJ affirmed and clarified its established case-law under which embodiments disclosed but not claimed by the patent are excluded from the scope of protection under the doctrine of equivalents. The FCJ clarified in particular in which cases such a selection decision can be assumed to restrict the scope of protection under the doctrine of equivalents.

PRINCIPLE: LITERAL AND EQUIVALENT PATENT INFRINGEMENT

The scope of protection of a patent is determined decisively by the claim wording, whereas patent description and drawings must also be taken into account for the interpretation of the claim wording. A patent claim can be infringed both literally and equivalently. Embodiments not fulfilling all features of a patent claim literally but deviating from the claim wording can fall within the patent's scope of protection if the embodiment meets the following three conditions (called the three "Schneidmesserfragen" [cutting knife questions], settled case law of FCJ, for example GRUR 2011, 313 margin no. 35 – Crimpwerkzeug IV [crimping tool IV]; GRUR 2007, 959, margin nos. 22 and 24 – Pumpeneinrichtung [pumping equipment]; GRUR 2002, 515, 517 – Schneidmesser I [cutting knife I]):

The embodiment must, first of all, solve the problem underlying the invention with different means which do, however, have the same objective effect. Secondly, the expertise of a person skilled in the art must enable said person to consider the modified embodiment with its modified means as having the same effect. And finally, the considerations that the person skilled in the art must make to achieve this effect must be based on the meaning of the teaching protected by the claim in such a way that the person skilled in the art considers the modified embodiment with its modified means as an equal solution to the literal solution.

EXCEPTION: NO EQUIVALENT PATENT INFRINGEMENT IN CASE OF A SELECTION DECISION AGAINST THE ALLEGEDLY INFRINGING EMBODIMENT

According to settled case law of the FCJ, embodiments explicitly disclosed in the patent description but not claimed in the patent claims are not considered equal to the literal solution by the skilled person (cf. third condition for equivalent infringement). The FCJ stated in the decisions *Okklusionsvorrichtung* and *Diglycidverbindung* that an equivalent patent infringement must be denied with regard to a specific embodiment if the patent description discloses said embodiment but only another embodiment is claimed in the patent claims (FCJ GRUR 2011, 701 principle 2 – *Okklusionsvorrichtung*; GRUR 2012, 45 margin no. 44 – *Diglycidverbindung*). This is the case where the patentee made his choice between different possibilities known to him about how to achieve a technical effect and therefore refrained from claiming certain embodiments. Thus, the scope of protection of a patent shall not be extended later on in infringement proceedings to retrospectively include embodiments in the scope of protection which the patentee had refrained from in the prosecution proceedings.

The FCJ further elaborated in the decision *Diglycidverbindung* on the scope of the selection made by the patentee. According to this decision, the selection is not only restricted to unclaimed embodiments specifically mentioned in the patent description, but also to further embodiments that differ in the same manner as the mentioned unclaimed embodiment from the claimed embodiment (FCJ GRUR 2012, 45 margin no. 46 – *Diglycidverbindung*).

AFFIRMATION AND CLARIFICATION OF THE PRINCIPLES REGARDING THE SELECTION DECISION

The FCJ affirmed those principles regarding the selection decision in its decisions "*Pemetrexed*" and "*V-förmige Führungsanordnung*" (FCJ GRUR 2016, 921 margin no. 52 – *Pemetrexed*; GRUR 2016, 1254 margin no. 27 – *V-förmige Führungsanordnung*) and defined those principles in more detail as follows:

FCJ – *Pemetrexed* (decision of 14 June 2016 – X ZR 29/15)

In its decision "*Pemetrexed*", the FCJ clarifies that the selection decision made by claiming only one embodiment must be based on a selection between at least two embodiments mentioned in the patent description (FCJ GRUR 2016, 921 margin no. 52–55 – *Pemetrexed*). There is no selection decision if an embodiment is not disclosed in the patent description but is only discoverable for the skilled person based on information in the description. For applying the principles established in the decisions "*Okklusionsvorrichtung*" and "*Diglycidverbindung*", it is not sufficient that an embodiment claimed by the patent is a specific application of a general solution principle revealed by information in the patent description or for other reasons and that, based on this knowledge, the skilled person was able to find further embodiments corresponding to this solution principle (FCJ GRUR 2016, 921 second principle – *Pemetrexed*).

The disputed patent disclosed and claimed "*pemetrexed disodium*", a specific chemical compound. Other chemical compounds with pemetrexed, such as "*pemetrexed dipotassium*", were obvious to the skilled person but not disclosed as specific embodiment in the patent description. Unlike in *Okklusionsvorrichtung* and *Diglycidverbindung*, claiming the specific embodiment ("*pemetrexed disodium*") was not based on a selection decision of the patentee against specific other embodiments disclosed in the patent description. The requirements for an exclusion of the contested embodiment from the range of equivalence were not fulfilled due to the lack of a corresponding selection decision.

A broadening of the exclusion on such embodiments that were not discoverable for the skilled person based on the information in the patent specification shall not be appropriate since discoverability (cf. second cutting knife question) is a basic prerequisite for the applicability of the principles of equivalence and that the use of modified

means would never be able to constitute a patent infringement (FCJ GRUR 2016, 921 margin no. 61 – *Pemetrexed*). By mentioning a general solution principle and only claiming a specific embodiment, the patentee did not make a corresponding selection decision so that, based on this, an equivalent patent infringement cannot be denied.

FCJ – V-förmige Führungsanordnung (decision of 23 August 2016 – X ZR 76/14)

In the decision "*V-förmige Führungsanordnung*", the FCJ further clarifies that the established principle regarding the selection decision is not applicable similar to the "foreseeable equivalents" of the US-American patent law according to which embodiments having the same effect are excluded from the scope of protection whenever the patentee foresaw or could have foreseen that a replacement of the claimed solution exists and failed to also claim this replacement (FCJ GRUR 2016, 1254 margin no. 22 – *V-förmige Führungsanordnung*). What is rather important for a selection decision is only whether the embodiment having the same technical effect is in fact disclosed in the patent description (FCJ GRUR 2016, 1254 margin no. 27 et seq. – *V-förmige Führungsanordnung*).

In casu, only the claimed V-shape of a guide formation but not the contested U-shaped embodiment was disclosed in the patent description. Thus, the FCJ did not see a selection decision and therefore did not exclude the U-shaped guide formation from the range of equivalence.

The FCJ did not decide whether only the description in the currently valid patent specification is decisive for proving a selection decision (FCJ GRUR 2016, 1254 margin no. 30 et seq. – *V-förmige Führungsanordnung*). There, the initial granted version of the patent (B1 document) had been limited in the opposition proceedings (B2 document). Unlike the current valid B2 document, the B1 document comprised a reference to other cross-sectional shapes. However, the FCJ did not decide upon this question since a general information to other potential cross-sectional shapes would not constitute a disclosure of a U-shaped embodiment and, thus, could not serve as proof for a selection decision of the patentee.

CONCLUSION

The FCJ's case law establishes that a selection decision of the patentee in favor of a specific claimed embodiment and therefore a waiver of claiming other embodiments can only be considered if the other embodiments are explicitly disclosed in the patent description. This principle shall not be applied to embodiments that are not disclosed but easily discoverable based on the information in the patent description.

Thus, when filing a patent application, one should ensure that the description does not give reason to suppose that a selection decision was taken. To prevent such an assumption, a corresponding note could be included into the description. Further, attention should, in particular, be paid to ensuring that only embodiments actually claimed are mentioned in the patent description. However, under current German patent law, the use of generic terms and the disclosure of general solution principles does not create such risk.

In case you have any questions, please do not hesitate to contact us.



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