



Infringement of Claims:  
The Doctrine of Equivalents  
and Related Issues –  
German Position

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# Topics



- Introduction
- Claim Interpretation
- Scope of Patent Protection
- Summary



# Introduction

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- The hottest topic of the extent of patent protection is the doctrine of equivalence.
- What I cannot present:
  - a worldwide doctrine of equivalence.
  - a European doctrine of equivalence.
- What I can present:
  - a German perspective on European Law.



# Introduction

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- Art. 69 European Patent Convention (EPC)

*"The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims."*



## Introduction

- Article 1 Protocol on the Interpretation of Art. 69 EPC

*"Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. ..."*



## Introduction

### ■ Art. 1 Protocol

*... Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties."*



# Introduction

- Art 2 Protocol (EPC 2000)

*"For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims."*



# Introduction

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- What does equivalence mean?
  - To answer this question, a broader approach is necessary: The concept of claim interpretation forms the basis for the determination of the extent of protection.
  - The extent of protection can only be understood against this background.



# Claim Interpretation

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- How to understand the wording of a patent claim? – Three principles:
  - Viewpoint of a person skilled in the relevant art.
  - Interpretation focused on function ("purposive construction").
  - Contextual Interpretation.
- The result is the determination of the meaning of the claim's wording ("*Wortsinn*").

# Claim Interpretation



In more detail:

- It is not relevant for the understanding of the patent claim what the applicant meant to claim and what the patent office meant to protect. Rather, the understanding of a reasonable third party that reads the patent specification is decisive.
- A claim must be construed from the perspective of a person of ordinary skill in the relevant art.

# Claim Interpretation



- The person skilled in the art, interpreting the technical terms of the claim, will generally rely on his or her "technical dictionary".
- There is a hierarchy of conventions, from the general terminology at the bottom, via the technical terminology to the patent's own lexicon at the top. If a convention is inconsistent with another one, the upper rank prevails over the lower rank.



## Claim Interpretation

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- Description and drawings shall be used to interpret the patent claim.
- But a broader wording of the claim must not be restricted to what is elaborated in the description (*Bundesgerichtshof 160 BGHZ 204 [36 IIC 971] - Bodenseitige Vereinzelungseinrichtung*).

# Claim Interpretation



- The patent claim is to be interpreted as a unit and its technical meaning is to be determined based on this unit (*Bundesgerichtshof 171 BGHZ 120 [38 IIC 726] – Kettenradanordnung I*).
- The meaning and importance of each and any feature is to be determined in context of the claim. The feature's contribution to the technical effect to be achieved by the invention is decisive.

# Claim Interpretation



- Knowledge and experience of the skilled person are questions of fact to be proven by the litigants.
- It is a question of law how to interpret the claim before the background of a skilled person's knowledge and experience (*Bundesgerichtshof* 160 BGHZ 204 [36 IIC 971] - *Bodenseitige Vereinzelungseinrichtung*).



## Scope of Patent Protection

- No statutory provision on the scope of patent protection before EPC came into force and national law was amended accordingly.
- Doctrine of equivalence developed by case law.
- A new perspective and a different understanding of the doctrine was developed in the light of Art. 69 EPC and the Protocol (*Bundesgerichtshof* 98 BGHZ 12 [18 IIC 795] - *Formstein*).



## Scope of Patent Protection

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- Determining the scope of patent protection means balancing conflicting interests: The patentee strives for broad protection, his competitors want free competition.
- Two decisive questions:
  - Where is the borderline to be drawn to ensure fair protection for the patentee's inventive achievement?
  - How can the borderline be made visible to ensure a reasonable degree of legal certainty?



## Scope of Patent Protection

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- Article 69 EPC does not say how the scope of protection is to be determined, but only suggests a reference point for doing so, i.e. by the patent claims.
- The patent claims do not only form the starting point but are the decisive basis for the determination of the extent of protection: This extent must align with the patent claims.



## Scope of Patent Protection

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- Therefore, the scope of patent protection is determined by the knowledge and the conclusions of a person skilled in the art.
- It extends to such variants which are made obvious by the claim to a skilled person.



## Scope of Patent Protection

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- How to determine variants which are made obvious by the claim to a person skilled in the art?
- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):
  1. Does the variant solve the problem underlying the invention by means which have objectively the same technical effect?
  2. ...



## Scope of Patent Protection

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- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):
  1. Does the variant solve the problem underlying the invention by means which have objectively the same technical effect?
    - The claimed invention as a whole is considered rather than a single modified ("equivalent") feature.
    - The total of features realized in accordance with the claim's wording and modified features has to comply with the technical effects of the invention.



## Scope of Patent Protection

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- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):
  1. ...
  2. Was the person skilled in the art enabled by his or her expertise on the priority date to find the modified means as having the same effect?
    - The relevant date (priority) is consistent with the concept of determining the scope by what the disclosure of the patent made obvious to the skilled person.
  3. ...



## Scope of Patent Protection

- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):

2. ...

3. Are the considerations that the person skilled in the art applies drawn from the technical teaching of the patent claim?

This is not the case if

- the skilled person understands from the description that alternative means should not be included,
- ...



## Scope of Patent Protection

- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):

2. ...

3. Are the considerations that the person skilled in the art applies drawn from the technical teaching of the patent claim?

This is not the case, e.g., if ...

- numeric values clearly define the claimed scope,
- the invention strives to avoid the use of alternative means,
- ...



## Scope of Patent Protection

- The "*Schneidmesser*" questions (*Bundesgerichtshof* 150 BGHZ 149 [33 IIC 873]):
  2. ...
  3. Are the considerations that the person skilled in the art applies drawn from the technical teaching of the patent claim?

This is not the case, e.g., if ...

    - ...
    - means are not claimed although mentioned by the description.



## Scope of Patent Protection

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- A fourth question, originating from the *Formstein* decision:
  4. Has the variant been anticipated or made obvious by prior art? (*Formstein* defense)
    - This is to avoid extending protection to non-patentable subject-matter (especially important in German bifurcated system where validity of the patent itself cannot be challenged in infringement proceedings).
    - Consequently, the *Formstein* defense does not apply if the accused embodiment complies with the wording of the claim (*Wortsinn*).



## Scope of Patent Protection

- Do you miss a fifth question?
- There is no file history estoppel in German Law (*Bundesgerichtshof* 150 BGHZ 161 [34 IIC 302] – *Kunststoffrohrteil*).
  - File history estoppel does not fit into the context-focused concept of claim interpretation.
  - Instead Formstein objection is used to prevent objectively unjustified protection.



## Summary

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- The basis of the determination of the scope of protection is the exact understanding of the technical teaching which a person skilled in the art takes from the patent claim's wording as being protected.
- For this purpose the court, considering description and drawings, has to interpret the patent claim.



## Summary

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- A patent is infringed if the accused embodiment is in accordance with the meaning of the wording of the patent claim (*Wortsinn*).
- A patent can also be infringed if the accused embodiment is not in accordance with the wording of the patent claim.

## Summary



- That is the case if the accused embodiment deviates from the wording of the claim but is made obvious by the patent claim to a person skilled in the art.
- The variant is obvious if the "*Schneidmesser*" questions 1 to 3 are to be answered with "yes" and, in addition, question 4 is to be answered with "no".



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