

Doctrine of Equivalents: Recent Developments in Germany

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Ole Dirks

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decisively different

Introduction

Legal framework:

- Art. 69 para. 1 EPC / Sec. 14 German Patents Act:

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

- Art. 2 of the Protocol on the Interpretation of Art. 69 EPC:

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.

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Introduction

Three questions formulated in decision *Cutting Blade I* of the German Federal Court of Justice (decision of March 12, 2002 – X ZR 168/00 – *Schneidmesser I*):

- Q1: Does the modified means realized by the infringing embodiment have objectively the same effect as the means specified in the claim? (**same effect**)
- Q2: Was it possible for the person skilled in the art to come up with the adapted means on the priority date of the property right without any particular considerations on the basis of his expert knowledge? (**obviousness**)
- Q3: Are the considerations that the skilled person has to take into account in order to arrive at the modification based on the meaning of the teaching protected in the claim such that the skilled person considers the differing embodiment with its adapted means as a solution that is equivalent to the teaching in question? (**parity**)

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Introduction

Important defence only available if equivalent infringement is in question:

Objection according to the “*Molded Curbstone*” decision of the FCJ (April 29, 1986 - X ZR 28/85 – *Formstein*) (“*Formsteineinwand*”):

- A contested embodiment does not fall within the scope of protection of a patent, if, with its (partly literally realized and partly equivalently realized) features, it is anticipated in the state of the art or is obvious from the state of the art
- The contested embodiment as a whole has to be derived from the state of the art at the priority date
- Several citations may be combined
- However, distribution of competence between grant authorities and infringement court must be respected. Infringement court may not deny patent infringement solely based on an argumentation that, if applied to the patent in suit accordingly, would have led to a finding that the patent in suit contained no patentable teaching

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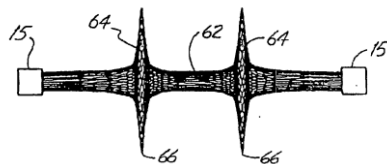
II. Important recent case law

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Occlusion Device

(FCJ decision of May 10, 2011 - XZR 16/09 - *Okklusionsvorrichtung*)

- The patent in suit protects an intravascular device for treating certain medical conditions as shown in its Fig. 5a:



- Feature 5 of claim 1 reads:

„Clamps (15) are adapted to clamp the strands at the opposite ends of the device“

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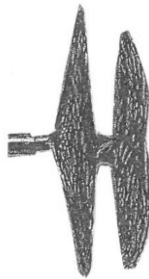
Occlusion Device

(FCJ decision of May 10, 2011 – X ZR 16/09 - *Okklusionsvorrichtung*)

- Paragraph [0027] of the description:

„...the fabric can be inverted upon itself to form a recess or depression and the fabric can be clamped about this recess to form an empty pocket [...] before the fabric is cut“

- Contested embodiment:



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Occlusion Device

(FCJ decision of May 10, 2011 - X ZR 16/09 - *Okklusionsvorrichtung*)

- FCJ specified Q3 more precisely:

„If the description discloses several ways in which a particular technical effect can be achieved, but only one was included in the claim, the use of one of the other ways does not, as a general rule, constitute an infringement of the patent with equivalent means“

→ An embodiment that was disclosed but not claimed falls not within the scope of protection if the skilled person had to have the impression that this embodiment was – for whatever reason – not intended to be protected (with the formulation of the claim thus being result of a **selection decision**).

- Accordingly, FCJ denied patent infringement by equivalent means, since description showed embodiment with one clamp, while feature 5 of claim 1 required two clamps on opposite ends of the device.

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Diglycid Compound

(FCJ decision of September 13, 2011 – XZR 69/10 – *Diglycidverbindung*)

- The patent in suit disclosed two different manufacturing methods for a reagent
- Only one of those methods was claimed
- The contested embodiment applied a third method

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Diglycid Compound

(FCJ decision of September 13, 2011 – XZR 69/10 – *Diglycidverbindung*)

- FCJ specified Q3 more precisely:
 1. The protection conferred by the patent has to be limited to what can be correlated to the meaning of the patent claim
 2. The modified technical solution has to correspond in its specific technical effects with the protected solution and has to differ the same or in a similar way from a solution disclosed in the description but not included in the claims

→ Equivalence requires that the third solution neither described in the specification nor covered by the wording comes „closer“ to the solution included in the claims
- Accordingly, the FCJ set the contested judgment aside and remanded the case back to the Instance Court since further material findings seemed necessary

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Pemetrexed

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

- Claim 1 of the patent in suit reads:

„Use of pemetrexed disodium in the manufacture of a medicament for use in combination therapy for inhibiting tumor growth in mammals wherein said medicament is to be administered in combination with vitamin B12 or a pharmaceutical derivative thereof [...]“
- The technical problem to be solved by the patent: to reduce the toxic effects on the patient that are caused by administering pemetrexed as an antifolate
- In the description it is explained that the invention has to do generally with the use of antifolate medicaments by administration of a substance such as vitamin B12. As a concrete embodiment, however, only pemetrexed disodium is cited.
- The contested embodiment used pemetrexed dipotassium

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Pemetrexed

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

FCJ specified Q3 more precisely:

„For excluding an embodiment from the scope of the patent, it is not sufficient for an embodiment claimed by the patent to be represented, due to information in the description or other reasons, as a special application of a more general approach and for the person skilled in the art, due to this insight, to be capable of discovering other relevant embodiments of this approach“

→ Unlike in the decisions *Occlusion device* and *Diglycide Compound*, no alternative embodiment is disclosed in the patent. This constitutes not a selection decision against other embodiments, because disclosure of the general approach is not comparable to a listing of all compounds belonging to this species. The reason for this is that the mere possibility of finding the solution is a fundamental prerequisite for finding equivalence.

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Pemetrexed

(FCJ decision of June 14, 2016 – XZR 29/15 – *Pemetrexed*)

- The FCJ stated, however, that from this general rule it does not necessarily follow that the finding of a selection decision in comparable cases is utterly ruled out.
- In this context, even though the FCJ refused a general statement as to whether a *prosecution history estoppel* is admissible in Germany, the FCJ noted that it may for example be justified if a comparison of different claim versions makes it sufficiently clear that the concretisation has been made as to overcome prior art and thus to avoid doubts as to patentability to exclude a concrete embodiment from the scope of protection.
- Since the FCJ did not find the matter ready for decision, it set aside the appellate decision and remanded the case to the court of appeal.

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III. The Drospirenone Case

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Drospirenone

(Higher Regional Court of Duesseldorf, decision of September 13, 2013 – I-2 U 23/13 - Drospirenon)

- The patent in suit covered a method of manufacturing Drospirenone by dehydration and use of P-Toluenesulfonic acid (p-TSA) to do so
- Initially, the claim was broader and covered use of an acid or Lewis Acid as catalyst but was restricted to p-TSA in the course of an opposition procedure
- The description of the patent mentions in the context of the state of the art that in general acids as well as bases can be used for dehydration. In this context, also Pyridinedichromate (PDC) is mentioned.
- The contested embodiment used Pyridine (= a base) as a catalyst

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Drospirenone

(Higher Regional Court of Duesseldorf, decision of September 13, 2013 – I-2 U 23/13 - Drospirenon)

- The Duesseldorf Court specified Q3 more precisely:
 - „Parity of the alternative means must be denied when the person skilled in the art, by use of the alternative means, carries out the opposite to that taught to him by the claim“
 - Base and Acid are opposite chemical categories. By including an acid in the claim, the patentee made a selection decision against base.
- Furthermore, the Court stated that the restriction during the opposition procedure from acid or Lewis Acid to a specific acid was a further selection decision that also has to be respected by the Court.

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Drospirenone II

(Higher Regional Court of Duesseldorf, decision of September 13, 2013 – I-2 U 26/13 - Drospirenon)

- The patent in suit covered a method of manufacturing Drospirenone with one step being oxydation in presence of (non-organic) ruthenium salt as catalyst
- In the description only ruthenium salts were discussed as possible catalysts
- The contested embodiment used an organic chemical compound as catalyst

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Drospirenone II

(Higher Regional Court of Duesseldorf, decision of September 13, 2013 – I-2 U 26/13 - Drospirenon)

- The Duesseldorf Court specified Q3 more precisely:

„In order to come to the alternative technical solution, the person skilled in the art had to ignore the teaching of claim 1 and instead had to make own considerations regarding suitability and expediency of organic catalysts for the oxydation reaction in question “

→ If the claim teaches the person skilled in the art to make a selection from the group of ruthenium salts, he would not consider an organic catalyst as being an equivalent means due to the different chemical properties of such catalysts

The Court furthermore added it would already be highly debatable whether or not mentioning of ruthenium salts in the claim would allow use of other metallic catalysts

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Thank you!

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