

Patent Equivalence - German Approach in a Nutshell

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by

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I. Art. 69 European Patent Convention (EPC)

- (1) The extent of the protection conferred by a European Patent ... shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.
- (2) ...

II. Protocol on the Interpretation of Art. 69 EPC

- (1) Art. 69 should not be interpreted ...
- (2) **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.**

III. Requirements for Patent Equivalence under German case law

Settled case law, e.g.: Bundesgerichtshof, 12 March 2002 – X ZR 168/00, 2002 IIC 873 – Cutting blade I; 13 January 2015 – X ZR 81/13, 2015 IIC 721 - Cooking pan.

1. Same effects

Does the variant solve the problem underlying the invention with means that have objectively the same technical effects?

2. Obviousness

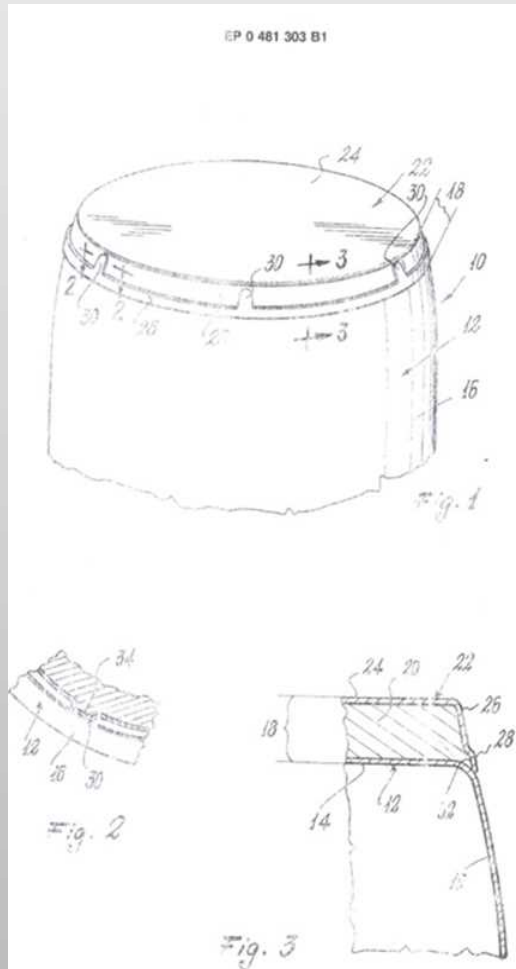
Could the person with ordinary skill in the art easily come up with the variant having objectively the same effects?

3. Claim orientation

Was the person skilled in the art able to find the variant by considerations oriented to the technical teaching of the claim as a variant having the same technical effects?

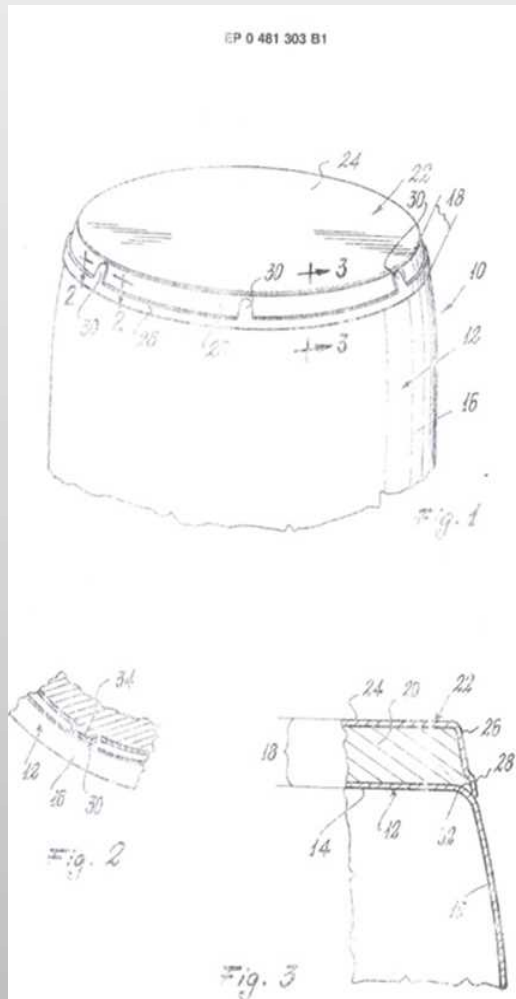
IV. Same effects – The cooking pan case

Bundesgerichtshof, 13 January 2015 – X ZR 81/13, 2015 IIC 721 - Cooking pan



A cooking pan with

- **a capsular base**
 - of thermally conductive metal (like aluminum)
- **a protection that covers the capsular base**
 - to resist against corrosion and scratching (like stainless steel)
- **the lateral wall of the protection is shaped with stiffening ribs**
 - to counteract peripheral deformations of the capsular base due to uneven heating.



The allegedly infringing cooking pan

- a capsular base of aluminum
- a stainless steel protection that covers the capsular base with
- a lateral wall with stiffening ribs.

However, **the lateral wall does not extend up to the upper edge of the pan base.**

- **No literal infringement.**
- **Equivalent infringement? Same effects?**
 - Stiffening ribs counteract peripheral deformations but
 - **Resistance against corrosion and scratches is not only a negligible “additional effect”.**
 - **Is this effect fully realized?**

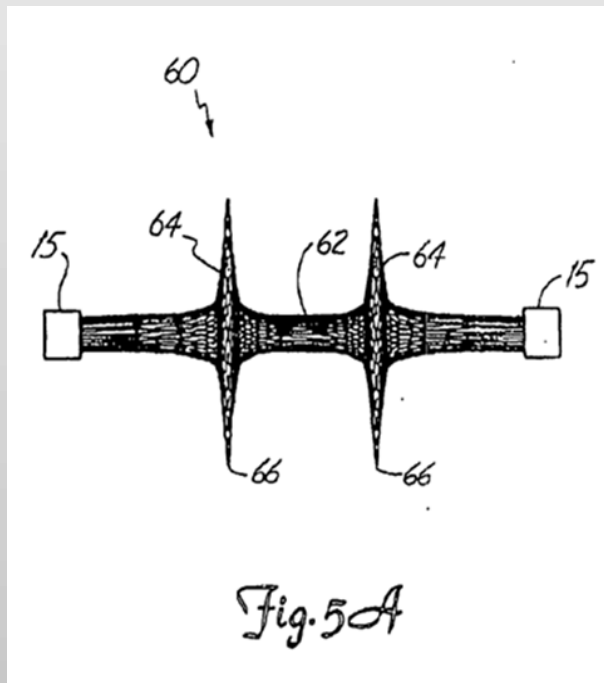
Abstract:

All effects that are achieved by the features of the patent claim represent the solution of the invention and have also to be achieved in the variant.

It would be a mistake to subdivide these effects into “essential effects” and “additional effects” when examining equivalent effects.

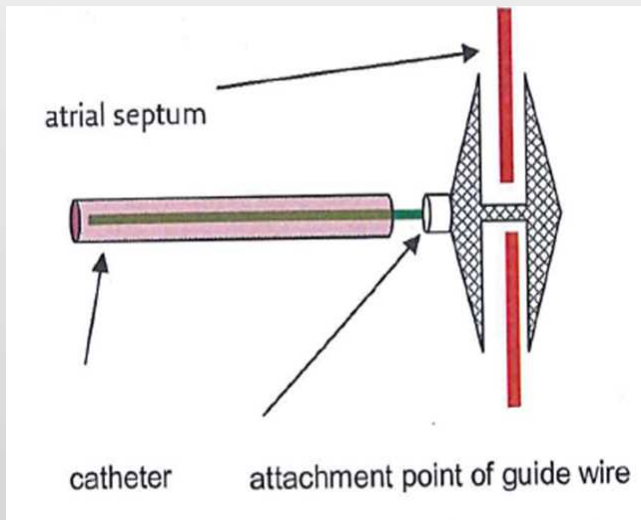
V. Claim orientation – The occlusion device case

Bundesgerichtshof, 10 May 2011 – X ZR 16/09, 2011 IIC 881 – Occlusion device



A collapsible medical device

- comprising a metal fabric,
- having a dumbbell-shaped expanded configuration and
- having clamps that are adapted to clamp the strands at the opposed ends of the device
 - in order to avoid unravelling of the end of the strands.



The allegedly infringing embodiment

- is a collapsible occlusion implant,
- comprises a metal fabric and
- has a dumbbell-shaped expanded configuration.

No literal infringement.

- The strands of the metal fabric are inverted upon themselves so that both ends of the strands are **clamped at only one end**.

Infringement by equivalent means?

- Other “alternative ways of affixing the ends together like soldering, brazing welding “ are disclosed in the description but not included in the claim that only mentions “clamping”.

Abstract:

If the description discloses a number of ways in which a technical effect can be achieved but only one of these ways is included in the patent claim, the use of the other ways cannot be found by orientation to the technical meaning of the patent claim.

It, therefore, does not constitute an infringement of the patent with equivalent means.

The “occlusion device”-case has to be distinguished from cases in which **one way to achieve a technical effect is mentioned in the patent claim but other ways – including the way realized in the allegedly infringing embodiment - are not disclosed in the description.**

Example (Bundesgerichtshof, 10 May 2011 – X ZR 16/09 – V-shaped guiding formation)

- The **patent claim** mentions **V-shaped guiding formations** of a replaceable wear part.
- The allegedly infringing embodiment has a **U-shaped guiding formation instead.**
- The **description** does **not** mention a **U-shaped guiding formation.**

Under these circumstances an infringement by equivalent means (claim orientation) cannot be denied by holding that the patent owner has limited himself to the one way mentioned in the claim.

However, the court has also to find that the other requirements of an infringement by equivalent means (same effects and obviousness of the variant, in the example case of the U-shaped guiding formations) are fulfilled.

VI. End



Thank you very much for your attention!