Can there be equivalents in invalidity?

This year's AIPPI patent law study question – Excerpts from the German contribution for discussion at the AIPPI World Congress 2023

By Dr. Michael Schneider

© Alexander Limbach – stock.adobe.com

Under German current practice, in validity proceedings before the Federal Patent Court and the Federal Supreme Court, the doctrine of equivalence is not considered when assessing the validity and/or patentability.

Dr. Michael Schneider
Eisenführ Speiser, München
Rechtsanwalt, Partner

mschneider@eisenfuhr.com
www.eisenfuhr.com

Introduction

The German national group of AIPPI (Association Internationale pour la Protection de la Propriété Intellectuelle) is a grateful contributor to the IntellctualPropertyMagazine and its larger platform. On the occasion of the upcoming AIPPI World Congress, to be held in Istanbul (Turkey) on October 22-25, 2023, the group is happy to share its main findings here on the topic of the "Doctrine of Equivalents" – the subject of this year's patent law study question (see **here**). In keeping with the AIPPI's approach for a comparative law-based resolution process, the full report encompasses a comprehensive de lege lata overview of the German statutory and case-law-based practice in this field, as well as discussions and de lege ferenda proposals for further harmonization. With a particular

view to the latter, and building on earlier AIPPI Resolutions in this field, this year's study question, among others, focuses on two further-reaching aspects of the "law of equivalents" as developed in the various jurisdictions, namely:

- whether equivalents should also be considered as part of the scope of protection when determining the validity and/or patentability of a patent,

- and whether the patent owner is prevented or estopped from claiming equivalent infringement with regard to those embodiments which (based on the contents of the specification) were known to the applicant but which the applicant failed to claim literally.

The first question had recently also come up in prominent cases before the UK High Court (in Apple v Optis, 2021) and before the Dutch Court of Appeals and Supreme Court (in Fresenius Kabi Nederland B.V. v Eli Lilly & Company, 2018 and 2020). The rationale behind the suggested approach being that a patent which is held to be infringed must be also valid, i.e. there must be symmetry between infringement and validity/patentability. The second question has occupied German (and international) courts and practitioners since (at least) the decision of the German Federal Court of Justice (FCJ) in the Okklusionsvorrichtung case of 2011, with the court at that point denying equivalent protection for alternative embodiments of the claimed invention disclosed in the patent application (but not covered by the literal scope of protection). This line of case law has since been further developed in the decisions Pemetrexed and V-förmige Führungsanordnung (both of 2016), holding that the doctrine of Okklusionsvorrichtung only applies if at least one of several embodiments explicitly mentioned in the specification is actually the subject matter of a granted claim. The fact that other embodiments are merely generally mentioned in the specification, e.g. by using generic terms, has been held not to result in a categorical denial of equivalent patent infringement.

„The rationale behind the suggested approach is that a patent which is held to be infringed must be also valid, i.e. there must be symmetry between infringement and validity/patentability."

The following reproduces the findings of the German working group on these core aspects of the study question:

Should (unclaimed) alternative embodiments disclosed in the specification be excluded from infringement by equivalence?

Under the current law and practice in our jurisdiction, YES, in principle, but not categorically. An equivalent patent infringement under German law is regularly denied if the alternative means were disclosed as one of several possibilities in the description, without having been included in the patent claim. This is based on the principle that equivalence is to be denied if the patent, when viewed objectively, is limited to a more narrowly worded claim than warranted by the technical content of the invention. Thus, it is regularly assumed that in relation to embodiments that are disclosed but not claimed, the patentee had made a conscious "selection decision" and "waived" part of the obtainable patent protection.

The starting point of this doctrine are the FCJ's Okklusionsvorrichtung and Diglycidverbindung decisions. The general rule derived from Okklusionsvorrichtung is that:

"If the description discloses several ways of achieving a certain technical effect, but only one of these ways has been included in the claim, the use of one of the remaining ways regularly [but not categorically] does not constitute infringement of the patent by equivalent means."

This rule was further specified in Diglycidverbindung. There, the FCJ ruled that "if the description of a patent discloses several possibilities of how a certain technical effect can be achieved, but only one of these possibilities has been included in the patent claim, infringement of the patent by equivalent means can only be assumed if the modified solution:

- coincides in its specific effects with the solution under protection, and

- differs in a similar way to the protected solution from the variant solution shown only in the description but not in the patent claim".

The FCJ further specified the idea of these lead sentences with the Pemetrexed and V-förmige Führungsanordnung decisions. If the specification describes a general principle, although only one specific embodiment of this principle may be disclosed and claimed, an infringement under the Doctrine of Equivalents by other variants which follow this principle is not excluded (Pemetrexed). This even applies when the claim was limited for formal reasons from the principle to the specific embodiment during prosecution.

A concrete formulation of a technical feature in a patent claim does not necessarily limit the scope of protection in a literal sense (FCJ – V-förmige Führungsanordnung). Provided that an analogous feature with the same technical working principle can be found and/or recognized by the skilled person within the context of the patent's teachings this may still lead to the assumption of patent infringement by equivalent means.

With a view to possible further harmonization, the German group is of the opinion that, short of an unwarranted categorical answer in either direction, the general guiding principle here should be that equivalence is to be denied if the patent, when viewed objectively, is limited to a more narrowly worded claim than warranted by the technical content of the invention.

If a specific alternative is mentioned in the patent specification, but not claimed, this per se can be seen as a strong indication that the applicant made a deliberate selection decision and waived protection for the non-claimed alternative. We are of the opinion that, as a general rule (and in line with current German case law), the alternative should be excluded from the scope of protection under the doctrine of equivalence in these cases. Legal certainty for the public prohibits the scope of protection from being extended beyond that which has been previously objectively waived from protection.

However, there may be circumstances where the mentioned alternative in the patent specification was clearly not meant to be left unclaimed, e.g. where it is apparent from the patent itself that mentioning but not claiming the alternative was clearly unintentional. In these exceptional cases which have to be evaluated on a purely objective basis from the perspective of the skilled person, and solely based on the patent, legal certainty does not require the alternative (which is mentioned in the specification but not claimed) to be excluded from the scope of protection, when all other requirements of protection under the doctrine of equivalence are met. Thus, the exclusion of disclosed-but-not-claimed alternatives from the Doctrine of Equivalents should be seen as a general rule rather than a categorical exception.

Should one consider the equivalent scope of protection conferred by a patent when assessing the validity and/or patentability of that patent?

Under current German practice, in validity proceedings before the Federal Patent Court and the Federal Supreme Court, the doctrine of equivalence is not considered when assessing validity and/or patentability. In patent prosecution proceedings, a literal approach is generally followed both by the EPO and the German Patent and Trademark Office (GPTO) when determining patentability, with a recent EPO decision explicitly considering claim construction in accordance with Art. 69 EPC when determining added matter.

With a view to possible further harmonization in this regard, the German group remains of the opinion that the equivalent scope of protection conferred by a patent should not be taken into consideration when assessing the validity and/or patentability of that patent.

Validity and/or patentability concerns do play a crucial role in limiting the extent of the equivalent scope of protection of a patent (FCJ – Formstein), based on the notion that no protection should be conferred for subject matter for which the applicant could not have obtained patent protection. In particular, if an equivalent solution was prior art or obvious over the prior art at the priority date, any third party should be free to make, sell, use or market this equivalent solution. If that equivalent solution is already excluded from the scope of protection, there is no justification for depriving a patent owner of the protection for an invention by considering equivalents when assessing validity and/or patentability.

Considering the equivalent scope of protection would also introduce significant uncertainties into the validity/patentability assessment. For example, any hypothetical equivalent could then be used to attack a patent (application), increasing the burden on applicants, patent offices and patent courts deciding validity issues, even if the claimed

subject matter within its literal scope and without the consideration of equivalents already fulfills all requirements of patentability. Similarly, such hypothetical equivalents could most likely only be excluded from the scope of protection by adding disclaimers to the claim language, which could potentially not find any basis in the disclosure of the patent, thus increasing uncertainty for third parties in subsequent infringement proceedings.

For the group's full report, and for the ultimate resolution which will to be adopted at the World Congress in October, please refer to the AIPPI website (as indicated above). AIPPI would once again like to thank all members of this year's patent law working group for their time and contributions. ←