

## Rising Litigation Stars TV Ad Lures Patent Plaintiffs

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### HURRY UP...

Patent infringement cases zoom through the International Trade Commission.



### ... AND WAIT

But when Customs takes the reins, things can really slow down.

# THE EUROPEAN DOCTRINES OF EQUIVALENTS

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**G**ermany and the UK are the two European countries which continue developing definitive Supreme Court case law on a Doctrine of Equivalents, to be applied consistently by the lower courts of those and other European countries. Case law changes over time, which makes it difficult for those overseas to stay abreast of changes. This is a brief review of past developments and an explanation of where things now stand.

## HISTORICAL DEVELOPMENT PRIOR TO THE EUROPEAN PATENT CONVENTION (EPC)

### Germany

In German tradition, the "demand for fairness" for the inventor always had priority.

Until the advent of the EPC in 1978, German courts awarded protection for the so-called "concept of the invention". To this end, the courts examined what the inventor could have obtained as protection at the filing date against the prior art, and awarded this potential protection as actual scope of protection. In practice this meant that the claim could be invoked even with one or more features, which are literally expressed in the claim, canceled from the claim, i.e., such feature(s) could be read out of the claim for purposes of enforcement. Moreover, also any imaginable variants were included in the claim protection under various levels of an all-embracing Doctrine of Equivalents.

### United Kingdom

The British approach historically was to put all emphasis on legal certainty for the public. The claim was (and still is) considered to be a "declaration of will" (like a testament or a contract) which has to be construed only in case of ambiguities.

The function of the claims was to define clearly and with precision the monopoly claimed, so that others might know the exact boundaries of the area, within which they will be trespassers. Their primary object was to limit, and not to extend the monopoly. What was not claimed was disclaimed.

## DEVELOPMENT SINCE THE ADVENT OF THE EPC

The problem of fair protection and certainty for the

public played an important role in the preparatory work for the EPC.

The result is the famous Protocol on Interpretation of Art. 69 EPC. This refers to the German and British approaches and declares each undesirable. It closes: "On the contrary, it [Art. 69 EPC] 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."

It is undisputed that now the Protocol is the guideline for any claim construction in all European countries, whether the patent was granted by the EPO or a national patent office.

### Germany

The first decision which applied Article 69 EPC and the Interpretation Protocol was the so called "Formstein" (Molded Curb Stone) decision.

This decision stated that the scope of protection as a rule extends to equivalents of the invention as claimed, but no longer to a general concept of the invention beyond the claimed matter.

As regards equivalents, the protection of a German patent could be extended to elements which

(1) have, in principle, the same effect as the claimed element, but only if

(2) the skilled person is, based on his/her professional knowledge, readily able to recognize such same effect.

### United Kingdom

The British tradition was first softened up by the famous "Catnic" decision of the House of Lords which ruled that the claimed features must be given a "purposive" interpretation. If something (here: a wall of a lintel) was claimed to be vertical (i.e., 90°), a wall having say 85° was included if this equally served the purpose.

Three questions had to be asked:

(1) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no -

(2) Would this (i.e., that the variant has no material



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The Kuhnen & Wacker Intellectual Property Law Firm is a boutique firm in the small town of Freising next to the Munich International Airport and specializes in all aspects of intellectual property. The patent section has expertise in the fields of mechanics, electronics and chemistry/biotechnology/pharmacology. It is completed by a powerful trade mark section and a general law section. Sixteen partners and associates presently work in the firm, assisted by well-trained and dedicated staff of some 35 paralegals and other supporters such as translators and secretaries. For more information please visit the website: [www.kuhnen-wacker.com](http://www.kuhnen-wacker.com).



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effect) have been obvious at the date of the publication of the patent to a reader skilled in the art? If no, the variant is outside the claim. If yes -

(3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning denoting a class of things which included the literal meaning and the variant, the former being perhaps the most perfect, best-known or striking example of the class.

The *Catnic* decision issued in fact before the EPC came into force, but it was made with a view to its advent. It was affirmed by later decisions like the "Epilady" decision.

## PRESENT STATUS

### Germany

There was a "quintet" of Supreme Court decisions issued in 2002 which modified the principles of the "Formstein" decision to include a third question to be answered:

Are the considerations of the skilled person so closely guided by the meaning of the claimed teaching that the skilled person considers the variant as equivalent to the claimed solution? - If no, the variant is outside the claim; if yes, we have an equivalent use of the patent.

The third question may be simplified for non-numerical limitations to ask: Is the variant based on the same technical principle as the claimed feature?

For numerical limitations the third question has as a consequence that, as a rule, numerical limitations must not be exceeded. However, deviations in the amount of tolerances usual in this field are included in the protection.

Otherwise, what is not claimed is disclaimed with respect to numerical limitations. The scope cannot be extended beyond what is claimed just because the

skilled person will realize that the problem of the invention may also be solved with broader numerical limitations.

### United Kingdom

Here the landmark "Epogen" decision of 2005, the first House of Lords decision since *Catnic* on patent infringement, set a new standard.

While the *Catnic* questions may still be helpful, there is only one decisive question to be answered:

What would a person skilled in the art have understood the patentee to mean with his language?

This is a question a German court will ask, too. However, the German court will ask this question to determine the correct understanding of the wording of the claim ("Wortsinn"), within which there will be literal infringement.

## CONCLUSION

So comparing the present German and British practice, what the British courts determine to be the most extensive claim construction by their Doctrine of Equivalents still is within what the German courts consider as literal infringement. The German Doctrine of Equivalents starts where the British ended. Thus there is an urgent need to harmonize on a common Doctrine of Equivalents all over Europe. ■

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