

„Occlusion Device“ in German Federal Court of Justice – A Change of Tide for Doctrine of Equivalents and File Wrapper Applicability in Germany?

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German Federal Court of Justice (GFCJ) Decision „Tension Screw“ („Spannschraube“) (GRUR 1999, 909, 914)

- Patent specification (PS) creates own dictionary
- If meaning according to PS differs from general (technical) language, PS meaning decisive
- „literal meaning“ of patent claim (PC) can deviate from „literal wording“

Suggestions/Recommendations for Patent Prosecution in Europe based on Recent Decision Practice of German Federal Court of Justice (GFCJ)

- In Decision „Occlusion Device“ (X ZR 16/09) of May 10, 2011, GFCJ has decided that Embodiments of Invention only contained in specification, but not covered literally by claims, cannot be covered by Doctrine of Equivalents (DOE) any more, rather are surrendered to the public
- Before filing with effect for DE (i.e. PCT, or EPC, or DE), care should be taken to cover all embodiments by broadest claim
- Whenever during prosecution at EPO or GPTO claims are narrowed, re-checking of coverage of all embodiments by broadest claim, otherwise divisionals necessary
 - ◆ otherwise, „surplus“ of specification/description surrendered to the public
- Additional care/control of drafting/prosecuting agents/attorneys necessary because of DE presently being most used patent litigation country in Europe (70%-80% of all cases annually filed)

GFCJ Decision „Plastic Tube Part“ („Kunststoffrohrteil“) (GRUR 2002, 511, 513)

- Art. 69 EPC „considers exclusively patent claim, specification, and drawing“
 - ◆ Really?? No word relating to a „prohibition“ of considering the file wrapper in Art. 69 EPC and/or in the Interpretation Protocol
- That means: „Events“ in prosecution, which have found a „reflection“ in PS, may limit patent scope
 - ◆ Therefore: file wrapper may (must?) be considered if prosecution history has found its way into patent specification

GFCJ Decision „Occlusion Device“ („Okklusionsvorrichtung“) (GRUR 2011, 701) - I -

- Events in prosecution, which have not found their way into PS, must not be used for claim construction
 - ◆ On the other hand: file wrapper may be considered, if condition of „reflection in PS“ is fulfilled
- Possibly consideration of published version of publication (OS) permitted, if meaning of PS can be found only by comparison of OS and PS
 - ◆ What is meant by this? Does comparison of OS and PS only lead to necessity of file wrapper consideration if patent claims are different? What about differences in specification (description) only?

GFCJ Decision „Occlusion Device“ („Okklusionsvorrichtung“) (GRUR 2011, 701) - II -

- Question: Is not prosecution history always then reflected in PS if – as regularly in DE and under EPC – OS differs from PS at least in specification?
- Is a „relevant“ deviation of OS and PS already given if only specification of OS and PS differ from each other?
- Does claim construction therefore in case of deviation/difference of OS and PS justify consideration also of file wrapper?

Practical Consequences for Prosecution and Opposition

- As a tendency, case law of GFCJ seems to encourage consideration of file wrapper
- Legal certainty concerns no more relevant because of easier electronic file inspection?
- File wrapper therefore to be considered always if OS and PS differ from each other, even if only in specification
- Claim construction therefore should be based on combination of OS, PS and file wrapper
- Consequence: Fight for change of specification in prosecution and opposition may be decisive, at least sometimes, for finding the meaning of the wording of patent claims and thereby for claim construction

Practical Consequences for Infringement Procedure

- Whenever PS is different from OS or otherwise events of prosecution/opposition have found their way into PS, consideration of file wrapper advisable. Claim construction needs using a combination of PS, OS and file wrapper in the sense of an „overall dictionary“.
- Only after claim construction based on „overall dictionary“ test is possible as to whether embodiments in PS which are outside of the meaning of the words according to the „overall dictionary“ have to be excluded from range of equivalency
 - ◆ According to „Occlusion Device“: Equivalency is not possible for embodiments only contained in specification, but being outside of a the properly construed claim
- Personal opinion: According to the consequences of „Occlusion Device“, all „equivalents“ that could be foreseen on the priority date of a patent, but are outside of the sense of the properly construed claim, should not be protected by doctrine of equivalence
- Equivalent infringement therefore only possible by non-foreseeable developments
- If disclaimer or the like used in patent claim for ordre public reasons, to be stated in specification in order to avoid loss of equivalency