

Interpretation of Patent Claims - Influence of Prior Art and the Knowledge of the Skilled Person for the Scope of Protection

Dr. Jochen Pagenberg, Attorney-at Law, Munich

I. Historic development

After the introduction of claims as patent requirement by the Patent Act of 1891, it became the task of the Patent Office to determine the subject matter of the invention and for the courts to determine the scope of the patent¹. The meaning of the claim was to be interpreted by taking into account the understanding of the average person skilled in the art, not the intent of the inventor². Because of the separation between infringement and invalidation procedures under German Law, the infringement courts were not competent to invalidate a patent. When novelty-defeating prior art was detected by the defendant, the infringement court was only able to reduce the scope of the claims to the “concrete subject matter of the patent, namely its wording”.

On the other hand, under the former German practice before the harmonization with the European patent law, the Courts often broadened the claims by granting protection for a *general inventive idea*, if the claims and the description contained a sufficient disclosure for a broader inventive concept. Since this inventive concept had not been examined for patentability by the Patent Office, the courts undertook the patentability examination of the

¹ Supreme Court Bl. PMZ 1910, 147

² Supreme Court MuW 1934, 168; GRUR 1955, 244

general inventive idea and determined novelty and inventive steps over the prior art³.

Other than in such cases of patentability examination of a general inventive idea where the *whole prior art* was examined for the interpretation of the claims and the determination of the subject matter of the patent, the courts derived the interpretation of technical terms and the meaning of the claims only from the specification and the *prior art cited* there, not from the entire prior art⁴. This prior art reported by the inventor in his patent application was contrasted with the entire prior art taken into consideration for the examination of novelty.

II. The changes under the 1981 Patent Act.

The basis for the interpretation of patents is today Sect. 14 of the German Patent Act which contains the identical wording as Art. 69 of the European Patent Convention. According to the Supreme Court also the Interpretation Protocol of Art. 69 EPC must be read into the German Law⁵, according to which the claims must be interpreted in a way which should be a balance between a fair protection for the inventor and a sufficient security for third parties. The Interpretation Protocol reads

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims.

³ Cf. Benkard/Ullman, Patentgesetz, § 14 note 162

⁴ Supreme Court GRUR 1978, 235, 237 - Stromwandler

⁵ Federal Supreme Court GRUR 1992, 594, 596 – Mechanische Betätigungsvorrichtung, Federal Supreme Court 26 IIC 261 (1995)-Segmentation Device, with article by *Pagenberg*, New Trends in Patent Claim Interpretation in Germany - Good-bye to the "General Inventive Idea", 26 IIC 228 (1995)

Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated.

On the contrary, it 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 the third parties.

The courts continue to distinguish between the subject matter of the patent which is the task of the Patent Office and the scope of the patent which is determined by the courts. However, they have stated that the protection of a general inventive idea is no longer possible under the new law⁶. The courts have also confirmed that they will continue to rely on the prior art cited in the description and the general knowledge on the priority date. Facts and documents from the granting procedure are generally excluded, since it is generally not decisive what the inventor wanted to claim, but what for “a skilled person for the interpretation of claims” he did claim⁷. Only where the inventor had expressly limited the scope of his claim or had given a binding declaration about the meaning of a specific term would the courts look into the file of the patent⁸. The meaning of terms in the claim is interpreted like the inventor had understood them, so that the Supreme Court calls the patent specification the “patent’s own dictionary”⁹.

In spite of the general attitude to allow the broadest protection possible for the patentee, the German courts refer in each case to Art. 69 and the legal security for third parties which limits any broadening which is not covered

⁶ Federal Patent Court Mitt 1984, 50, 53 – Schutzzumfang; Federal Supreme Court, 19 IIC 811 (1988)-Radio Broadcasting System with article by *Pagenberg*, New Trends in Patent Claim Interpretation in Germany - Good-bye to the "General Inventive Idea", 19 IIC 788 (1988)

⁷ Federal Supreme Court 24 IIC 259 (1993)- Heatable Breathing Air Hose

⁸ Federal Supreme Court 19 IIC 243 (1988)-Fixing Device I

⁹ Federal Supreme Court 19 IIC 243 (1988)-Fixing Device I, Federal Supreme Court 30 IIC 932 (1999) – Tension Screw

by the text. The interpretation of a claim will therefore always be made on the basis of the terms of the claim. Only the knowledge of the skilled person and the prior art as far as it has been mentioned in the specification can be used for the interpretation.

III. The practice of German Courts in an infringement suit

1. Subject matter of the invention

As explained before also in most recent decisions the Supreme Court starts when interpreting patent claims with the determination of the subject matter of the invention as disclosed in the application, namely the interpretation of technical terms and their meaning (“Sinngesamt”) ¹⁰. The aim of interpretation is to determine which understanding the skilled person would have of the terms and the technical function when reading the claim ¹¹. Relevant references for such interpretation are the general knowledge of the person skilled in the art and the prior art mentioned in the patent specification ¹². Other prior art not mentioned in the patent specification can only be taken into account if it belongs to the general knowledge of the skilled person. As foreseen by Art. 69 EPC also drawings will be taken into account, if the wording leaves room for interpretation. The Federal Supreme Court has stated in numerous decisions that, although the definition of the subject matter of the patent is

¹⁰ Federal Supreme Court GRUR 2002, 511 – Kunststoffrohrteil; Federal Supreme Court GRUR 2002, 515 – Schneidmesser I; Federal Supreme Court GRUR 2002, 523 - Custodiol I

¹¹ Federal Supreme Court 30 IIC 932 (1999) – Tension Screw; Federal Supreme Court 29 IIC 207 (1998) – Brochure Rack

¹² Federal Supreme Court GRUR 1984, 425 – Bierklärmittel; Federal Supreme Court 30 IIC 932 (1999) – Tension Screw; Federal Supreme Court 33 IIC 349 (2002)- Roasting Pots

based on factual determinations, they are subject to legal review by the Supreme Court¹³.

When defining the subject matter of the invention the Supreme Court first defines the technical problem and its solution. Here the factual side is open for expert opinions in both, the first and second instance of an infringement proceeding. The few German courts which primarily deal with patent infringement cases have developed a slightly divergent practice: some, like the Düsseldorf Court of first instance rarely order an expert opinion, and only the second instance will then, if it is a question of a difficult technology, appoint an expert. This has the advantage of speeding up the decision process and often makes an appeal superfluous, if both parties feel that the technical understanding of the court was correct.

Other courts, like Munich, will in most cases already appoint an expert in the first instance which may add to the reliability of the decision under technical aspects but of course influences the speed of the first instance decision. It is obvious that questions concerning the general knowledge of a skilled person on the priority date will be answered differently depending on the experience and knowledge of the appointed expert, so that a professor of a technical university who is normally chosen as an expert may come to a different result than a technical engineer working in industry.

2) Scope of the Patent - Identical vs. Equivalent Use

¹³ Federal Supreme Court 29 IIC 207 (1998) – Brochure Rack

The identical use of the wording of the claim features will not pose a problem for the plaintiff, so that the only defense for the alleged infringer is an attack on the validity of the patent which he can however not raise as part of the infringement procedure under German law as it stands. So he may only request a stay of proceedings once he has filed a nullity suit in the Federal Patent Court in Munich which is the central first instance for revocation actions.

If the defendant does not use the claim features identically or does not use all claim features, the question of a equivalent use arises. The prerequisites of equivalence are that

- the allegedly infringing embodiment reaches the same technical effect
- the defendant's solution could be derived by a skilled person from the disclosure of the patent claims
- the allegedly equivalent solution does not belong to the prior art and would have been patentable over the prior art¹⁴.

The concept of protection against equivalent use therefore presupposes that means are comprised by the scope of protection which have not expressly been mentioned for solving the technical problem, which however were obvious for a skilled person¹⁵. By defining a common principle of solution the equivalence principle allows to include means into the scope of protection which a skilled person could find on the priority

¹⁴ Federal Supreme Court 28 IIC 795 (1987) -Molded Curbstone (Formstein)

¹⁵ Federal Patent Court 29 IIC 243 (1988) – Fixing Device I

date without inventive efforts when reading the claims. The courts have repeatedly held that the skilled person should not be a scientist but a practice orientated engineer in the relevant field.

An embodiment which deviates from the means of solution of the patent claims is therefore only comprised by the scope of protection and thus constitutes a patent infringement, if it could only be found by using the technical teaching of the patent. However, it does not constitute a use according to the patent, if the attacked embodiment could be derived only from the prior art¹⁶, since patent protection does not cover means of solution which are different from the wording and the meaning of the patent features, but were already known in the prior art of the priority date.

Also in case of equivalence a court has to start from defining the subject matter of the patent on the basis of technical problem and its solution. This means that first the meaning of the technical terms of the claim must be determined.

Technical equivalence does not only require that the same technical result is achieved, but also that it is achieved by the same or similar means. If the technical solution of the problem is conceptually different from the solution of the patent, equivalence will be denied. Also here, with respect to the technical equivalence an expert opinion may be ordered by the courts. In the most recent series of decisions, the Federal Supreme Court has found a new formulation with respect to equiva-

¹⁶ Federal Supreme Court GRUR 1972, 579? – Schienenschalter II

lence: in case of an embodiment deviating from the wording of the claims a use falling under the scope of the claim can be given, if the skilled person based on deliberations starting from a meaningful understanding of the protected invention could find the modified features by using his skill and experience when solving the technical problem of the invention.

One can however observe that some lower courts, with few exceptions, looking at the case law of the Federal Supreme Court and applying Art. 69 EPC cite more often the requirement of legal security than the adequate protection of the inventive achievement, probably because of the prior generous approach in Germany. One can however state that most decision are well balanced and reach predictable results, although one must be aware that courts have a positive attitude towards claim interpretation.

3. The *Formstein* Defense vs. Equivalence

In the "Formstein" case, which today is considered a landmark decision the Court confirmed that Section 14 of the Act of 1981 which corresponds to Art. 69 of the Munich Patent Convention also covers equivalents, but the Supreme Court nevertheless limited the application of this theory by the following principle:

The defense that the embodiment alleged to be an equivalent would not be patentable over the prior art is admissible.

In other words:

The defendant can argue that the equivalent element, although it may fall under the scope of protection of the patent, if it does not constitute a patentable invention in itself, cannot be regarded as an infringement. The reasoning behind this concept, which finds its counterpart in the US in the *Wilson* case and in the UK is known as the *Gillette* defense, is derived from competition law which does not allow that prior art is taken away from the public and protected by patent law.

This defense which used to be known in a more restrictive sense as a „defense of the free state of the art“ can be raised in an infringement proceeding only, if the attacked embodiment is not a literal infringement but constitutes an equivalent use¹⁷. The teaching of *Formstein* therefore is that the scope of protection comprises a certain level of development between the prior art and the claimed invention which is excluded as possible equivalence because it would not constitute a patentable invention over what was known already. On the basis of the different tasks of the nullity court on the one hand and the infringement court on the other, the defense that the embodiment is not a patentable invention in view of the prior art and therefore does not constitute a patent infringement, is not admissible in case of an identical use of the invention.

4. Dependent Invention

Special problems may occur in cases where the alleged infringer had obtained a patent for his embodiment. Under the “non-obviousness rule” this seems to speak against the presence of the prerequisite that the equivalent solution

¹⁷ Federal Supreme Court 28 IIC 795 (1987)-Molded Curbstone (Formstein)

could be derived from the patent by a skilled person. In the *Fixing Device II* decision the Supreme Court decided however that

The requirements for patent infringement by equivalent means are also met if one or more elements of the actual embodiment are to be understood as the realization of a more general statement that the average skilled person can deduce to be of equivalent effect to the teaching described in the patent claim and explained in the patent description. Under these circumstances, it is irrelevant whether the actual realization is obvious to the average skilled person, or whether it is inventive.

The scope of protection of a patent can also include such embodiments that make use of the protected teaching whilst also implementing an inventive further realization; it is then a dependent invention.

The Supreme Court affirmed in that decision that if the infringer uses all the features of the patented invention but adds additional features, and the person skilled in the art could have recognized the modified form as equivalent, an infringement must be affirmed¹⁸, even if, as in that case, the Patent Office has granted a patent on that solution. For the Court this was a dependent patent.

Many practitioners interpreted this case as a reintroduction of the general inventive idea, which had been considered abolished by the Supreme Court in the Radio Broadcasting System decision. For many years, practitioners believed that the generalization of a feature of the claim was admissible if it could be regarded as an equivalent of one of the features of the original claim. The Supreme Court however soon made it clear that there might be cases where an equivalent modification which involves an inventive step, would no longer fall

¹⁸ Federal Supreme Court 23 IIC 111 (1992)- Fixing Device II; see also Kraßer, 23 IIC 467, 478 (1992); König, 1991 Mitt. 21, 25 with further references.

into the scope of the respective claim¹⁹. In the case *Segmentation Device* it gave an interpretation of the *Fixing Device* decision which contradicts expectations of broadening of protection by a generalization of claim features. In *Segmentation Device* all but one of the features of the claim were identical in the attacked embodiment. In a multi step tree cutting process the term *sawing* was used for the cutting and smoothening of the edges of a log. The court of appeals came to the conclusion that "sawing" used in the plaintiff's patent claim also covers "molding" which was used by the defendant for the same purpose and with the same result.

Since the defendant had obtained a European patent for his process and device, the Supreme Court also examined whether a dependent invention in the sense of *Fixing Device II* was given, but rejected this on the basis of the facts. It defined a **dependent invention** as a more concrete embodiment of a feature contained in the claim which the alleged infringer was able to derive from a general teaching *already contained* in the original claim. A dependent invention according to the definition of the Supreme Court is therefore always given if the alleged infringer makes (literal or equivalent) use of claim features, but realizes at the same time a further inventive and more concrete embodiment. Such would be the case under the circumstances of the case, where the patent at issue had contained a teaching protecting all "smoothening devices", so that the molding method used by the defendant would constitute a more specific realization of "sawing" contained in the claim. According to the Supreme Court, the patent understands "fine machining" as a smoothening method only as to sawing which was expressly mentioned in the claim²⁰.

¹⁹ Federal Supreme Court 26 IIC 261 (1995) - *Segmentation Device* for Tree Trunks with commenting article by *Pagenberg*, *More Refined Rules of Claim Interpretation*, 26 IIC 228 (1995)

²⁰ See for details *Pagenberg*, 26 IIC 228, 230 (1995).

Summarizing it must be stated that equivalent form of use must be derived by a skilled person on the priority date as obvious equivalence which however where not know in the prior art before. For this examination the hole prior art must be taken into account.