

GERMANY



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New life for equivalent infringement

If an allegedly patent infringing product does not literally use a certain feature of a patent claim, but uses a surrogate means, according to German Patent Law, the product can still be sued for infringement under the doctrine of equivalence.

A potential equivalent infringement is evaluated on the basis of three prerequisites: (1) the effect of the surrogate means must be equal to that of the feature of the patent claim (“equal effect”); (2) the surrogate means must be “obvious” to a skilled person as of the priority date; and (3) the surrogate means must be considered by the skilled person to be “equivalent” to or “of the same value” as the teaching of the patent.

However, existing German case law dismisses the prerequisite “same value” if the surrogate means is mentioned in the patent specification, which apparently kills every possibility of successfully establishing an infringement under the doctrine of equivalence.

Now, the Dusseldorf Appeal Court (Case I-2 U 29/12 – *WC-Sitzgelenk*, November 7 2013) further stipulates that special circumstances are required to exclude surrogate means mentioned in the patent specification. According to the Court, such special circumstances may only be assumed if the patent specification shows that the patent applicant was aware of the surrogate means and consciously decided not to claim them. Such special circumstances are a rare occurrence.

As a consequence, the equivalent infringement appears to be alive again and available for plaintiffs in German infringement proceedings!

As a further consequence, when drafting and prosecuting German patent applications, any surrogate means should be included in the literal wording of the claim, or else it should not be mentioned in the application documents at all. At the least there should be no hint that the surrogate means is consciously not claimed.