

Strong patents as a basis for successful patent litigation

Thoughts and comments from a
practioner's point of view

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I. Infringement Proceedings

- OLG Düsseldorf GRUR-RR 2014, 185 – “*Hinge for toilet seat*”
- EP 1 199 020 B1 (claim 1):

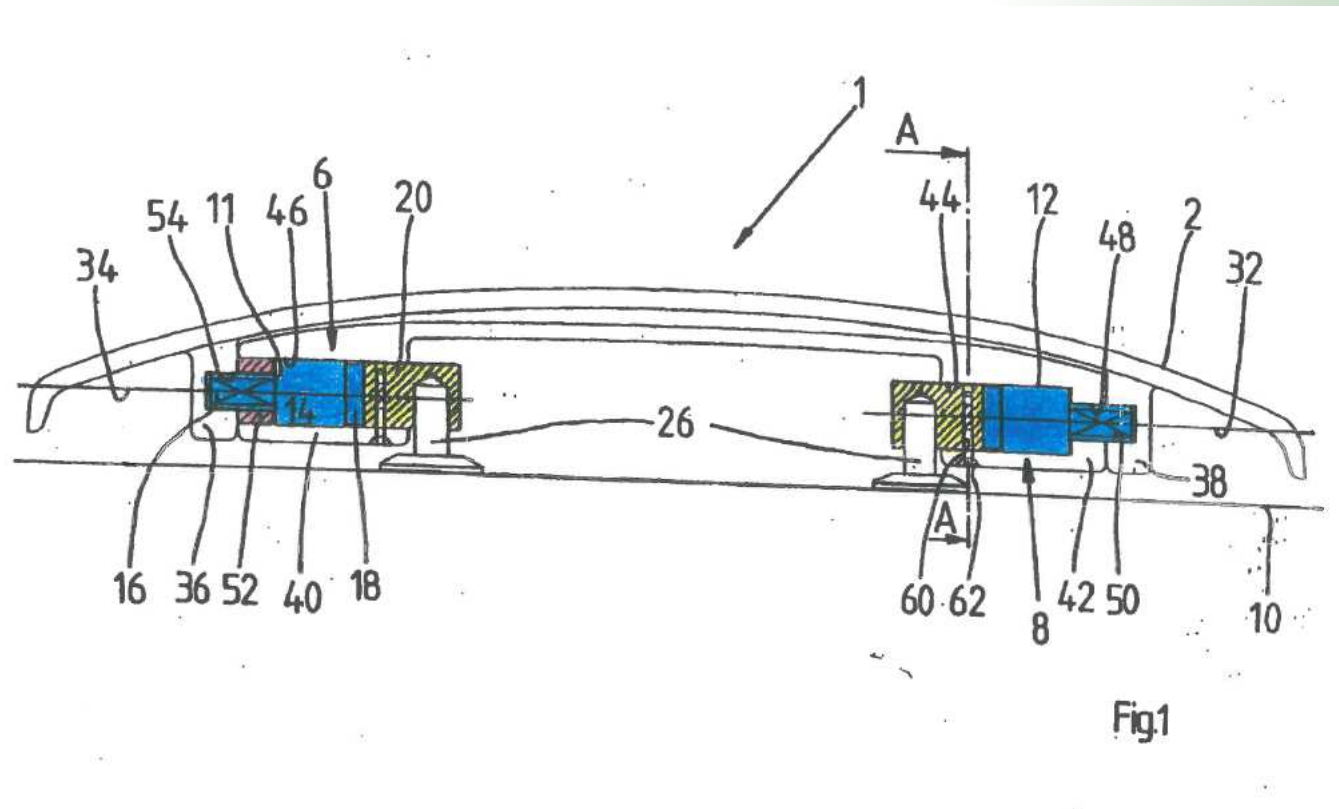
An articulation for a toilet seat for securing a toilet seat assembly (1) to a ceramic body (10), including a rotation axis (32, 34) for a seat (4) and a seat cover (2) of said seat assembly (1) and including a damping means (11, 12) for supporting said seat assembly (1) during the pivoting movement, wherein an adapter member (20) is connected with a fastening means (26) that is secured in said ceramic body (10), and positively connected with the damping means (11, 12) that is received in a reception bore (44, 46) of a mounting link (40, 42) of said seat assembly (1),

characterized in that said adapter member (20) and said damping means (11, 12) form the rotation axis (32, 34) for said seat cover (2) or for said seat (4),

and **in that** said adapter member includes an approximately cylindrical base body in which a **radial blind bore (24)** is formed for insertion on a gudgeon (26).

I. Infringement Proceedings

- Fig. 1:

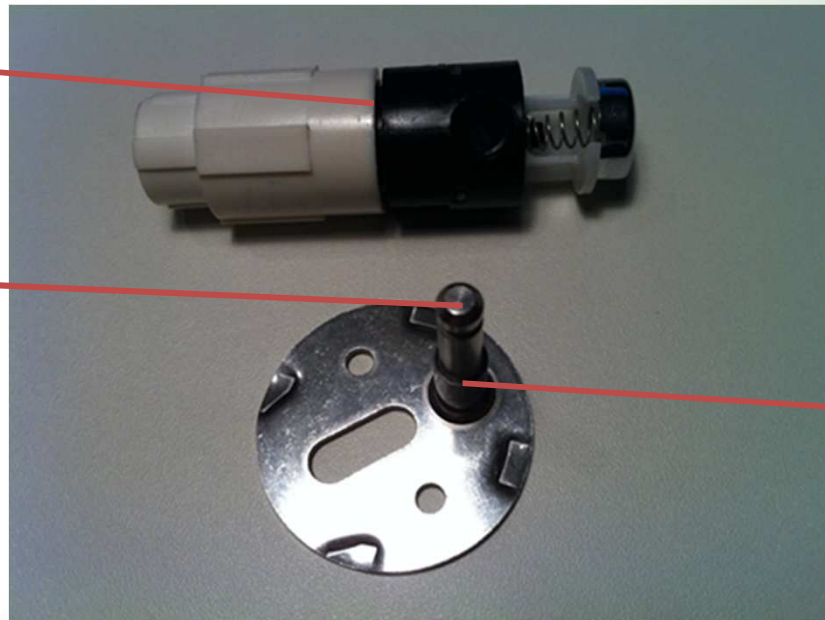


I. Infringement Proceedings

- Attacked embodiment:

Hinge for toilet seat (6, 8)

Gudgeon (26)



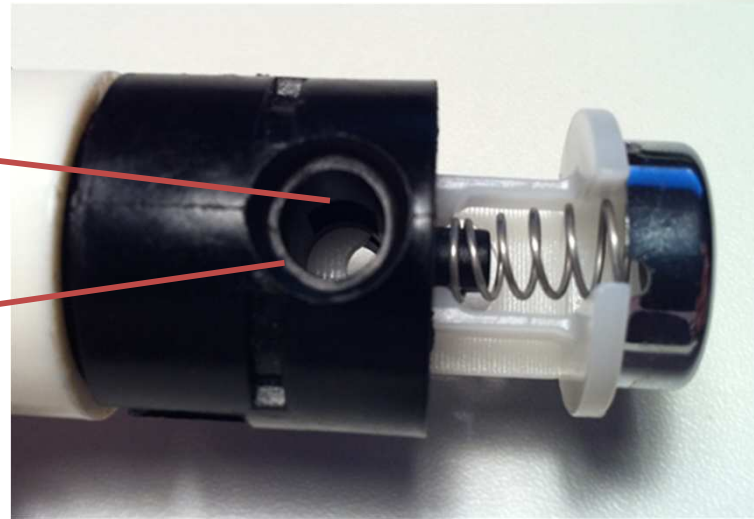
Ring shoulder

I. Infringement Proceedings

- Attacked embodiment:

Continuously stepped bore

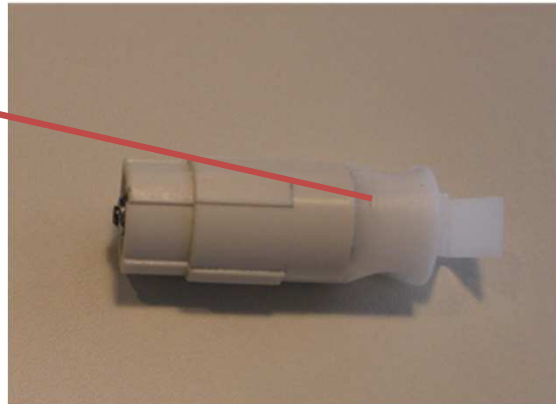
Ring shoulder



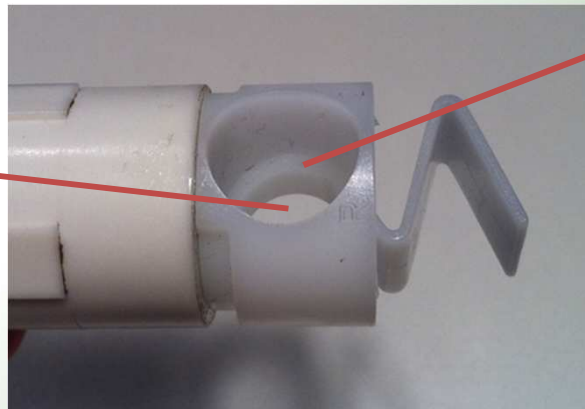
I. Infringement Proceedings

- Attacked embodiment:

Adapter member (20)



Continuously stepped bore



Ring shoulder

I. Infringement Proceedings

References to different kinds of “bores” in the patent in suit:

- [0010] - The damping device is (...) mounted in a **mounting bore** (...)
 - The adapter member is provided with a **radial bore** (...)
- [0015] - (...) the **mounting bore** (...) is realized as a **through bore** (...)
- [0016] - (...) the **mounting bore** (...) is realized as a **stepped bore** (...)
- [0025] - (...) base body having a **radial blind bore** 24 (...)
 - (...) spring washer or o-ring (...) inserted into the **blind bore** 24 (...)
- [0028] - The **mounting bores** 44 or 46 (...) are inserted into the (...) inner mounting straps 40, 42 (...). The **mounting bore** 44 (...) is realized as a **stepped bore** (...)
 - A flattening (...) is formed within the (...) **mounting bore** (...)
 - The rotary piston penetrates a small part of the **mounting bore** and extends into the **bearing bore** 50 (...), whereas the diameter of the **bearing bore** 50 is chosen (...)
- [0029] - The (...) **mounting bore** 46 is realized as a **through bore** (...)
- [0030] - (...) the seat 4 (is) rotatable via the **mounting bore** 46 (...)
- [0031] - The lowering movement of the seat 4 is limited by the engagement with (...) the part 48 of the **mounting bore** 44 (...)
- [0032] - (...) the adapter member 20 (is) (...) secured within the (...) **mounting bores** 44 or 46 (...)
- [0033] - (...) the rotation damping devices are implemented into the (...) **mounting bores** 44 or 46 (...)
 - (...) the rotary piston 16 (...) is rotatable within **the bearing bore** (...)

I. Infringement Proceedings

A.69 EPC Extent of protection

- (1) The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

A.69 Protocol

Article 1

General principles

Article 69 should not be interpreted as meaning 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. Nor should it be taken to mean 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 patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

Article 2

Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

I. Infringement Proceedings

- Admissible reservoir for claim construction:
 - Wording of the claims
 - Description
 - Definitions
 - General description
 - Samples
 - Figures
 - Prior art mentioned in and on the patent document
 - General Knowledge of the person skilled in the art
 - Handbook
 - File history?

I. Infringement Proceedings

- Claim construction:
 - Wording of the claims
 - philological
 - Functional
 - Doctrine of equivalence
 - Same technical effect
 - Obvious for the person skilled in the art
 - Complete state of the art, not limited to cited state of the art
 - Alternative solution on par – in the light of the claim? (~ 3rd Improver/Catnic-question)

I. Infringement Proceedings

Occluding Device (BGH, 10.5.2011, X ZR 16/09)

Infringement in a literal sense or under the doctrine of equivalence?

- The claim:
 - Clamps are provided **at the opposed ends** of the device
- The alleged infringement:
 - A **single** clamp is provided at **one** end of the device

I. Infringement Proceedings

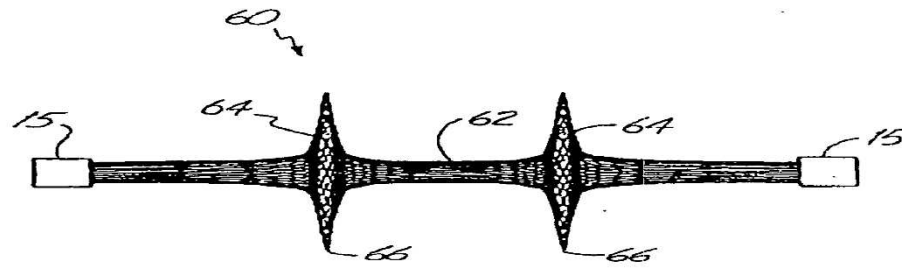
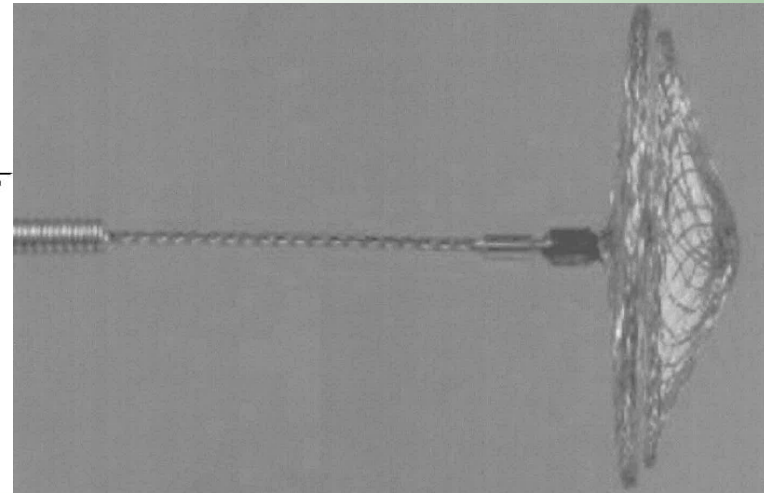


Fig. 504



I. Infringement Proceedings

- The Higher District Court:
 - Patent infringement in a literal sense affirmed
 - Clampss (plural) is a generic name and not to be understood literally
 - The literal **sense** would be “a clamp where required”

I. Infringement Proceedings

- Claim construction:
 - Description
 - Figures
 - Prior art mentioned in and on the patent document
- Description: Embodiment with **one** clamp
- However: This embodiment is not covered by the wording of the claim
- Federal Supreme Court:
 - No literal patent infringement
 - Embodiments which are **not encompassed** by the literal sense of the claim may **not be used** for claim construction

I. Infringement Proceedings

- Patent infringement under the doctrine of equivalence requires equivalent substitute means
 1. which has the same effect,
 2. which can be found by the man skilled in the art without inventive activity on the basis of the patent description and the prior art, and
 3. which is consistent with the general idea of the invention.
- Federal Supreme Court: Precondition 3 not fulfilled.

I. Infringement Proceedings

No patent infringement under the doctrine of equivalence if

- the idea (one single clamp) is disclosed in the patent but
- has not become part of the subject-matter of the claim.

No protection for embodiments which are disclosed in the description but not encompassed by the claims.

Advice: “Less can be more.”

I. Infringement Proceedings

Diglycide Compound (BGH, 13.9.2011, X ZR 69/10)

Infringement under the doctrine of equivalence only

- if equivalent solution is not mentioned in the description as an embodiment which has not been encompassed in the claim (exclusion from protection according to “Occluding Device”), and
- if the **differences** between the subject-matter of the claim in a literal sense and the other embodiments in the description which are not part of the claim are generally the same as the **differences** between the equivalent use and the other embodiments

Easier: Equivalent use must be more like the claimed embodiment and further away from the embodiment which is not encompassed by the claim

II. Nullity Proceedings

- Granted claims covered by priority application(s)?
 - Additional prior art might apply
- Granted claims covered by original disclosure?
 - Especially: Patent inadmissibly amended by deleting parts of the description?
 - Relevant for patent infringement under the doctrine of equivalence?

II. Nullity Proceedings

- “Lean” description might be suggested.
 - However: Object solved by the claimed invention over its full range?
 - Tightrope walk: Multiple examples/fallback positions vs. elusive description
- Object given in the patent?
 - Assessment of inventive step
 - Restrictive claim construction

II. Nullity Proceedings

- No file wrapper estoppel
 - However: Inter partes “squeeze” argument
 - Claims for infringement proceedings might be weakened by statements in nullity proceedings
- Strong “use” claims
 - Broad “method for” claims vs. narrower “use of method for” claims (“Semiconductor Doping” BGH, 18.6.2013, X ZR 35/12)

II. Nullity Proceedings

- Stay of infringement proceedings
 - Patent has to be contested
 - Court has to assume that patent will be revoked
 - Novelty destroying prior art not produced before
 - No prior use claimed
- Stay is the exception

II. Nullity Proceedings

- Restricting the claims in nullity proceedings and only enforcing restricted claims in infringement suit
 - Infringement court decides based on restricted claims (“Machine Set”, BGH, 6.5.2010, Xa ZR 70/08)
- If claims are restricted, even higher chance to avoid stay of infringement proceedings

III. Preliminary Injunctions: Assumption

- A patent's strength is ultimately scrutinized in a motion for Preliminary Injunction, because
 - Speed is the key
 - Patentability must be proven by patentee
 - Extraordinary circumstances need to justify the Preliminary Injunction

III.1. Speed is the key

- Claimant:
 - needs to prove urgent case handling
- Defendant:
 - must initiate nullity or revocation proceedings,
 - should serve a protective letter in advance
- The stronger the patent, the longer it will take to make a nullity / revocation case

III.2. Proving Patentability

- Claimant must defend his patent under time pressure
- Already researched state of the art is rather unlikely to succeed in nullity / patentability proceedings
- Inventive step: the further the safer

III.3. Circumstances

- Extraordinary circumstances justify a Preliminary Injunction
- Preliminary Injunctions are not meant to merely speed up infringement proceedings
- Such extraordinary circumstances may be based on the patent's strength:
 - fundamental invention
 - large technical advantage granted by patent

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