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How courts and appointed experts should cooperate

The German Federal Court of Justice (FCJ) has repeatedly emphasised in a series of decisions (*Seitenspiegel*, 2005; *Kettenradanordnung*, 2007) that the interpretation of a patent claim is a question of law and thus may not be committed to the court expert, but is the original duty of the court.

Although claim construction is regarded as a question of law, it is based on factual circumstances subject to fact-finding by the court. For this reason the infringement court must clarify the factual basis to be able to perform the claim construction as stipulated by the FCJ in the decision *Mehrgangnabe* issued in 2008. It is the task of the court expert – if appointed by the court which is not mandatory but happens quite often – to provide the technical facts and background knowledge required by the judges to be able to interpret the claim.

In a recently published decision of December 22 2009 (*Kettenradanordnung II*), the FCJ stipulated further requirements which the infringement court must meet when determining the factual basis of the claim construction with the help of a court expert. This decision, as well as the earlier decision *Kettenradanordnung*, dealt with the question of infringement of a patent directed at a sprocket assembly (in German: *Kettenradanordnung*) of a bicycle.

The FCJ held that the court in a patent infringement lawsuit is obliged to request from the parties that they submit comprehensive presentation on the factual basis of the claim interpretation such as the technical background of the invention, the appropriate skilled person and their educational background. The decision further states that the appointment of a court expert may nevertheless be required, if the presentation on these factual aspects is not sufficient to allow the court to deduce the skilled person's understanding from these facts.

Since the (second instance) court had

neither urged the parties to comprehensively present the facts that the court required for the claim construction nor had appointed an expert to further clarify the issues involved, but had quite simply rejected the complaint, the FCJ remanded the case to the second instance court.

The decision, apart from focusing on the court's deficiencies when dealing with fact-finding, also highlights the importance of the parties' presentation of the relevant facts for claim construction.