

GERMANY



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important aspects mentioned in the description should also be reflected in the claims, otherwise they will fall out of the scope of protection.

Approach to patent claims and description confirmed

In a recently published decision of May 10 2011 (*Okklusionsvorrichtung*), the German Federal Court of Justice (FCJ, *Bundesgerichtshof*) confirmed existing case law concerning the precedence of the claim over the description in a patent.

The case related to intravascular occlusion devices. Whereas the District Court as well as the Appeal Court had found the attacked occlusion device to literally infringe the patent in question, the FCJ dismissed the action denying literal infringement and infringement under the doctrine of equivalence.

In the headnote of the decision, the FCJ states that when a contradiction arises between the patent claims and the description, those parts of the description, which do not manifest themselves in the claim do not fall under the protection of the patent. The description may only be considered as far as it can be used to explain the subject matter of the claim. These principles are fully in line with a series of previous decisions. Applying these rules to the present case, the FCJ declined literal infringement.

Moreover, infringement under the doctrine of equivalence was also denied, in particular because the FCJ did not find the “third requirement” to be fulfilled. Under German law, equivalent infringement is acknowledged if (1) the modified solution has an equal effect, (2) the skilled person may find the modified solution without inventive considerations and (3) when making deliberations oriented by the patent claim, the skilled person will assess the modified solution as being an equivalent solution. With respect to the third requirement, the FCJ stated that if the description reveals several options of how a particular technical result may be achieved and if (further) only one option is contained in the claim, the realisation of one of the other options does not constitute an infringement under the doctrine of equivalence.

This decision is of great relevance when drafting a patent application: all