
Claim interpretation in case of incorrect cited prior art in the patent – Higher Regional Court of Duesseldorf in "proximity switch", Judgment of October 26, 2017 – court docket: 15 U 95/16

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The decision of the Higher Regional Court of Duesseldorf (“Higher Regional Court”) deals with the interpretation of a patent claim in case of objectively incorrect, claim limiting, cited prior art in the patent description. In its judgment, the Higher Regional Court particularly decided whether the objectively incorrect description of the prior art in the patent-in-suit has to be taken into consideration, or, whether an objectively accurate analysis of the prior art should be relevant.

1. Facts of the case

The Plaintiff is owner of a German Patent („patent-in-suit“) relating to proximity switches, more specifically inductive proximity switches. Proximity switches are sensors which respond to approximation, i. e. they react without a direct contact. Proximity switches are inter alia used as position detectors as well as triggers of security measures. The Defendant offered and distributed in the Federal Republic of Germany, inductive proximity switches (“attacked embodiment“) via, among other means, its online shop.

The Plaintiff filed a lawsuit for patent infringement before the Regional Court of Duesseldorf („Regional Court“) requesting the Defendant to cease the offering, marke-

ting, usage and importation, as well as to provide information, to render accounts, to recall and to destroy the patent infringing products due to a literal infringement of the patent-in-suit. The Regional Court fully dismissed the case.

The Plaintiff lodged an appeal before the Higher Regional Court against this decision reiterating the same claims which were unsuccessful in first instance. The Defendant requested a dismissal of the appeal. With its decision of October 26, 2017, the Higher Regional Court dismissed the admissible appeal as being unfounded.

2. The decision of the Higher Regional Court of Duesseldorf

The Higher Regional Court dismissed the appeal with a finding of non-infringement of the patent-in-suit by the attacked embodiments. The parties particularly argued about the claim construction. The Higher Regional Court decided for a narrow claim interpretation, founding its arguments on the prior art cited in the patent description.

The Plaintiff argued - for the first time after the oral hearing in the appeal proceedings - that the description of the prior art was objectively incorrect and, thus, could not be used as a basis for a narrow interpretation of the protected subject-matter of the patent-in-suit. However, according to the

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Higher Regional Court, the Plaintiff failed to prove an error. For this purpose, in fact, it would have been necessary not only that the assessed prior art had not disclosed the version contained in the patent-in-suit, but – above all – that the technical teaching of the aforementioned prior art did not lead to the solution revealed by the patent-in-suit.

In its decision, the Higher Regional Court points out that another interpretation would not have even been appropriate, in the assumption of inaccurate prior art described in the patent by mistake. This is because the Plaintiff as patent proprietor should know his own patent and its content in detail. Pursuant to the principle of legal certainty, even inaccurate information concerning „strong“ prior art, i.e. incorrectly assuming a new subject matter as known, would need to be claim limiting. In particular, the patent claims cannot be given the same scope that would have been indeed given if the application would have not been found having such deficiencies.

The Higher Regional Court further points out that an inaccurate evaluation of the prior art in the patent-in-suit is only to be disregarded if the person skilled in the art, reading the patent specification, would detect and correct the error without difficulties.

In this specific case, the Higher Regional Court assumes that, for the interpretation of the claims, the inaccurately cited prior art, is to be considered. The person skilled in the art reading the patent-in-suit would probably not have corrected the inaccurately cited prior art as he would have not detected the inaccuracy without difficulties. The Higher Regional Court reasons that the Plaintiff, as a specialized company in this technical field, itself assumed the cited prior art to be correctly described in the patent-in-suit until the end of the oral hearing of the second instance. Furthermore, the allegedly detected error of the Plaintiff is not clearly identifiable and evident, wherefore the principle of legal certainty for third parties excludes a correction within the interpretation of the patent.

Remarks

The interpretation of a claimed feature can derive from the cited prior art in a patent specification. With regard to the object of a patent, it is recognized that it does not decisively depend on what is mentioned (subjectively) as being the object of the invention in the patent specification but it depends on the objective problem (c.f. Kuehnen, Handbook of patent infringement, 10th edition 2018, p. 29, mn. 48).

The Higher Regional Court does not automatically apply these generally known principles when interpreting a patent claim in case of inaccurately described prior art in the patent description. Objectively accurate information regarding the cited prior art compared to inaccurate information are only relevant if it can be assumed that the person skilled in the art would detect and correct the error when assessing the patent.



In conclusion, the analyzed judgment is one of a series of decisions relating to the interpretation of patents. Specifically, this judgment follows a Federal Court of Justice decision (FCJ GRUR 1974, page 148, 149 „Stromversorgungseinrichtung“) concerning the question whether an evident error in the drawings of a prior art publication for the interpretation of a patent is relevant.

The judgment underlines the importance of the evaluation of the cited prior art in the patent-in-suit for the claim interpretation, however, taking into account the legal certainty interests of third-parties. The decision emphasizes that errors during prosecution can subsequently, by means of claim interpretation, only be corrected restrictively, so that special attention should be paid on a thorough and accurate draft of the description of the cited prior art during prosecution.