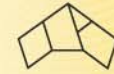


Los Lunes de Patentes

Madrid

November 3, 2008



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# From Patent Drafting to Patent Litigation

by

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# Content:

I Introduction (Session 1)

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II Claim Drafting in View of Litigation (Session 1)

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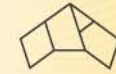
III Break

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IV The “Goal Keeper Glove” (Session 2)

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V Questions/Conclusions (Session 2)

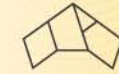
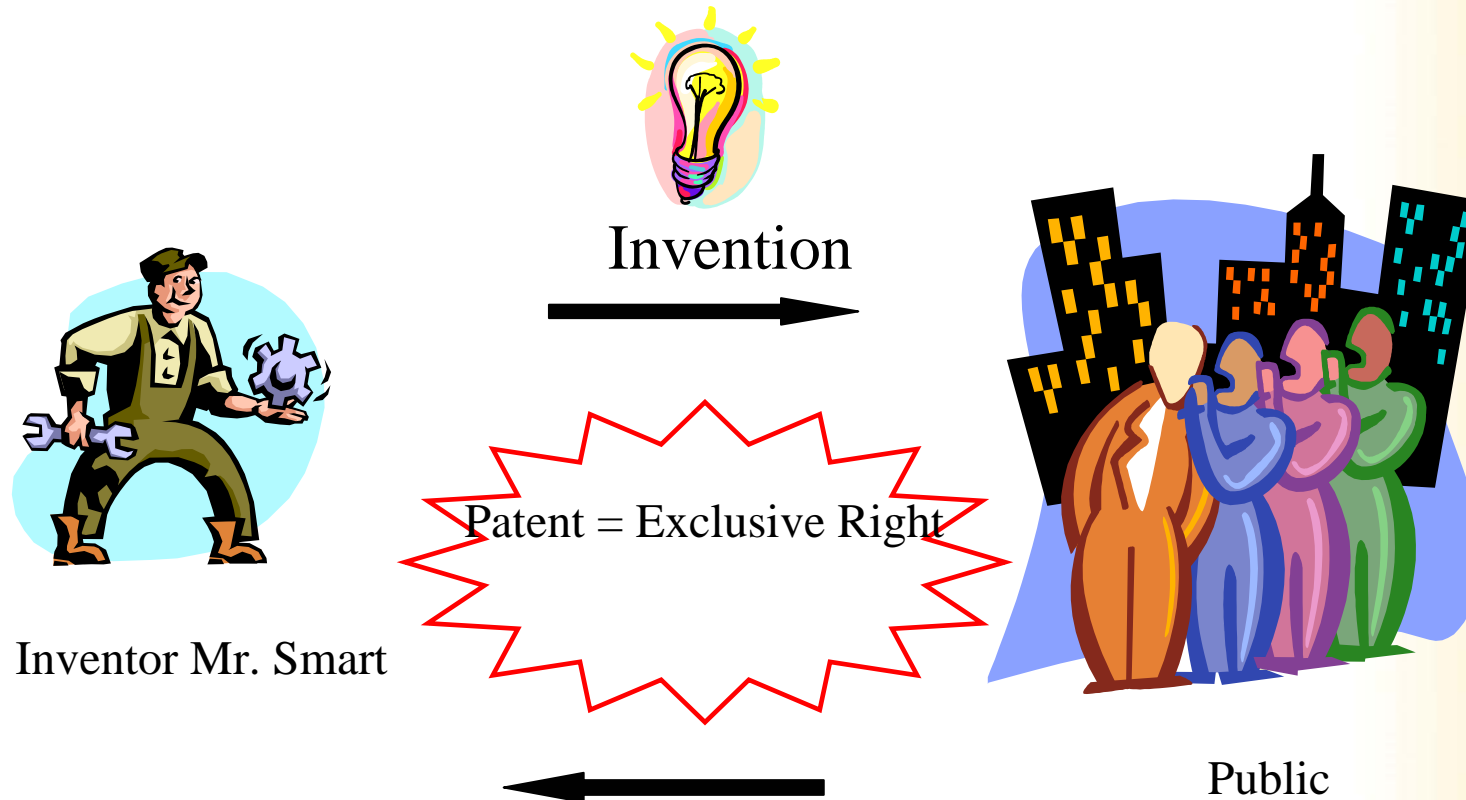


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# I. Introduction

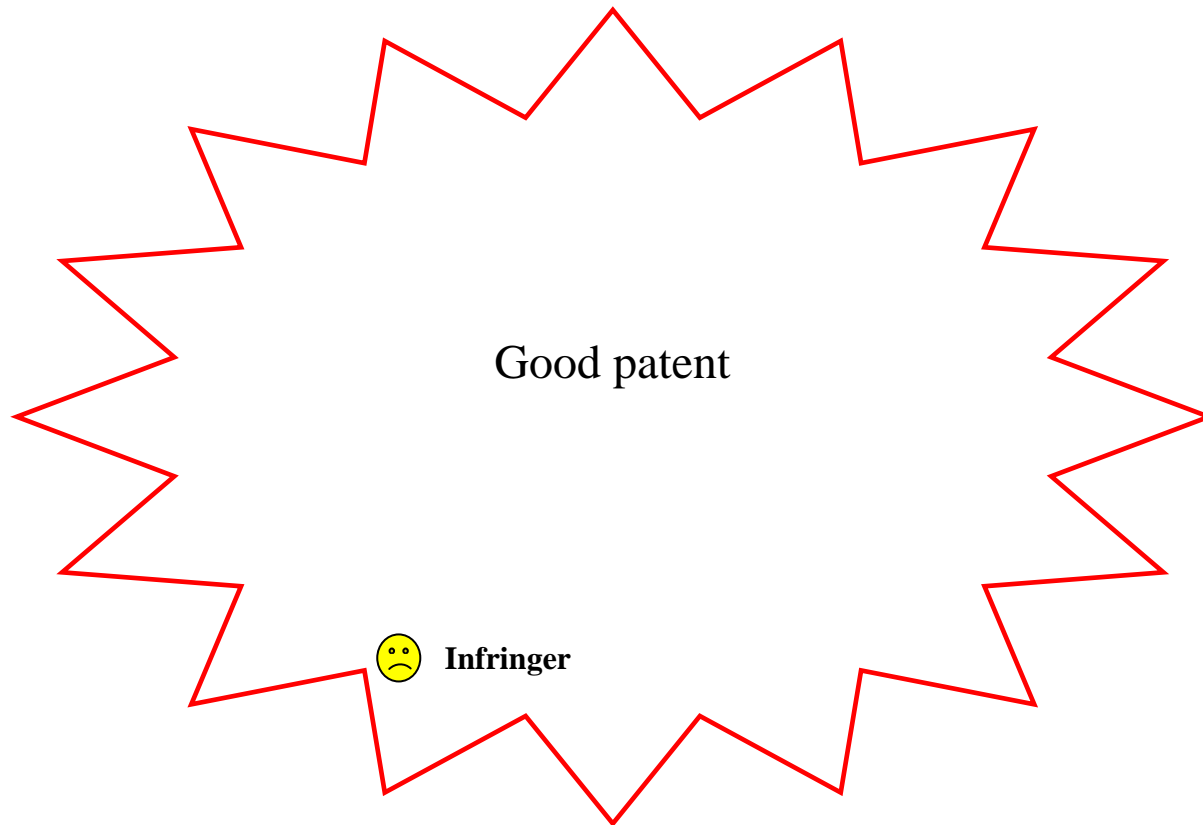


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# What is a good patent?



=> Maximize the **scope of protection!**

## Session 1

# Sources of Law:

- Art. 69 EPC with the Protocol on the Interpretation of Art. 69 EPC
- National Law (e.g. Germany § 14 PatG)

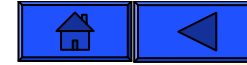


## Session 1

German Supreme Court, decision of March 12, 2002 - X ZR 135/01  
„Cutting knife II - Schneidmesser II“

*„If, in an objective consideration, the **patent** lags behind the technical content of the **invention**, the protection is limited to that which can still be related to the meaning of the patent claims.“*

=> The author of the patent is responsible for the maximal scope of protection: You have to claim it!!!



## II. Claim Drafting in view of Litigation

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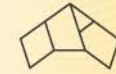
1. Understand the Invention

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2. The Main Methods of Expansion

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3. The Three Claim Tests

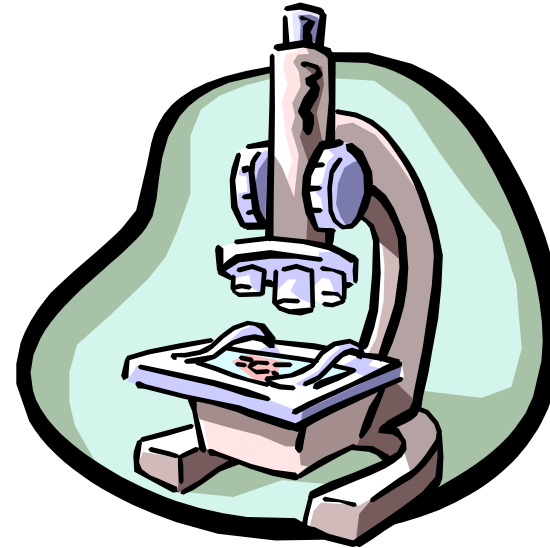
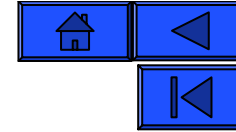


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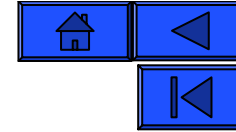
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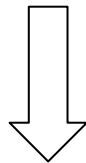
# 1. Understand the invention!

- Understand the prototype concept
- not yet considerations concerning scope of protection
- the better the inventor's explanations and the better the preparatory work of the patent department (if existing), the less time is required



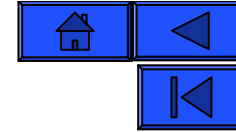


**Don't start yet to draft the claims!!**



instead

- Unstructured „brainstorming“ on the subject matter of the invention;
- „Dig“ like a miner for the jewels in the inventor's brain



## Brainstorming Approaches:

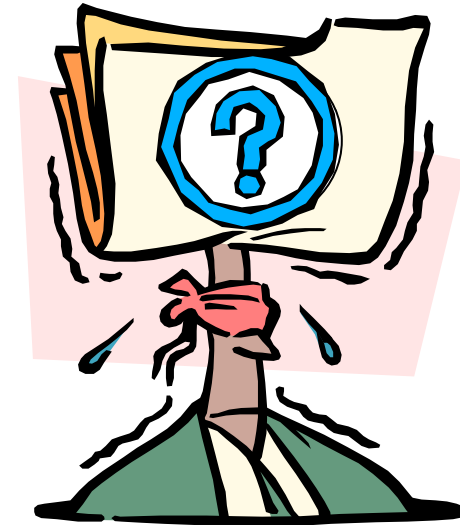
- Look for and note for each term



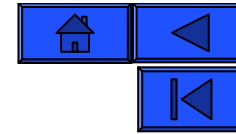
Narrower wording



More general term



Don't cling to inventor's precise embodiment !!!

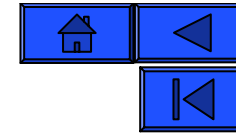
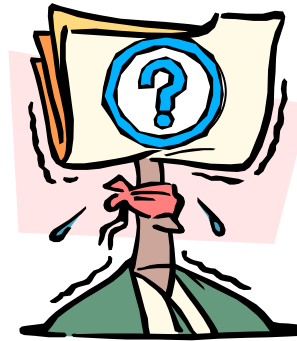


## 2. The Main Methods of Expansion



1. Generalization: Replace species by genus, e.g.

- “Screwed to” => “fixed” => “arranged”
- “Cl<sup>-</sup>” => “halogenide” => “anion”
- “Transistor” => “electrical switch” => “signal routing means”



## 2. Different Independent Claims

- Intermediate product – final product - application product
- New product – new use – new production method – new device
- „Sender“ and „Receiver“ claims → cover the “traded goods”!

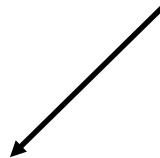
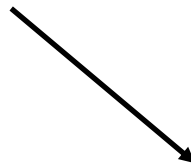
## Intermediate result:



Complete technical  
understanding of invention

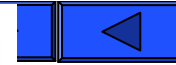
+

Amorphous mass of single words,  
definitions, sketches, ideas, fractions of  
sentences



**Now, the claims can be drafted!**

**→ THEN:**

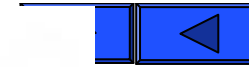


### 3. The Three Claim Tests:

#### A. The Infringer Test



- **Who** is possible infringer? Infringement only by end consumer in private sector?
- **Where** does infringement take place? If claim is partially or completely only realized abroad, value of wording is doubtful.
- **How** does infringement take place? Exactly check product-by-process claims and method claims.

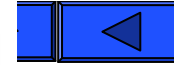


## B. The Scope of Protection Test:



- Are the respective claim features necessary and appropriate for limiting the claim?
- Are the respective claim features sufficiently broad?

**Note:** Check all features, not only „new“ features (“characterized-by clause”)



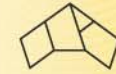
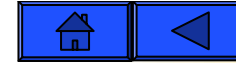
## C. The Provability Test

Check for every claim feature:



- Can the realization of the claim features be proven (easily)?
- Can the feature be replaced by another one with easier provability (e.g. indication of the structure instead of the generating method)?





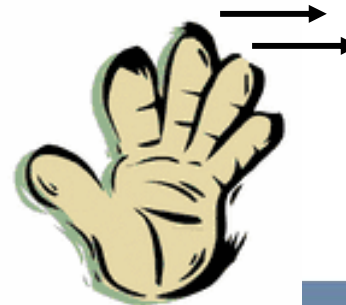
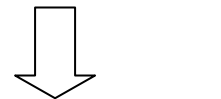
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## III. The “Goal Keeper Glove”



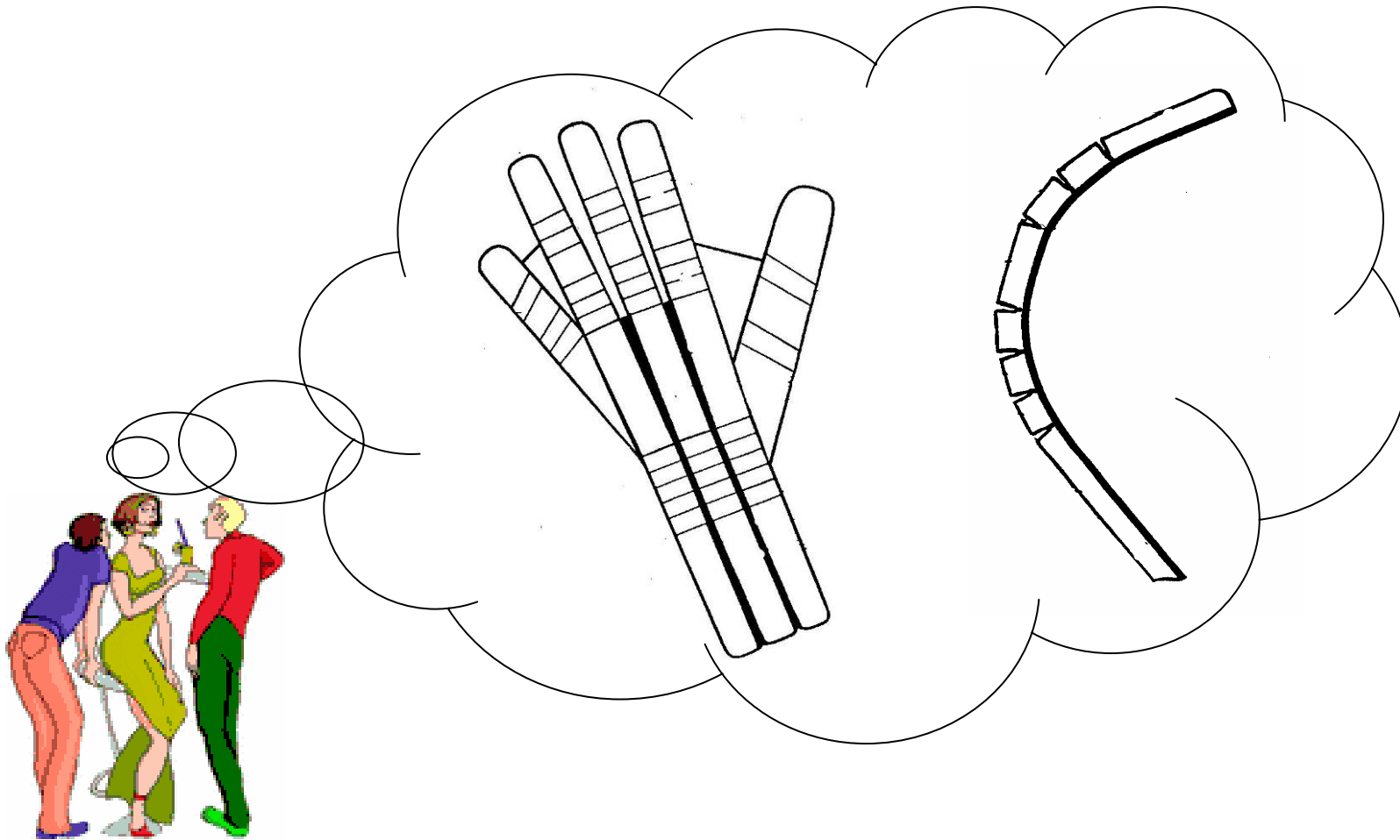
## Inventor Mr. Smart:

- design engineer at plastic-processing company
- ambitious hobby soccer player




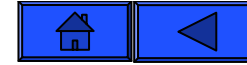
Ow !!

The idea emerges from a Happy Hour discussion  
last night in the pub of Mr. Smart:



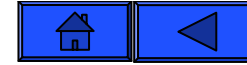
Some times later, a patent has been granted:

<p>19 BUNDESREPUBLIK DEUTSCHLAND</p> <p></p> <p>DEUTSCHES PATENTAMT</p>	<p>12 <b>Patentschrift</b></p> <p>18 <b>DE 35 16 545 C 2</b></p>	<p>51 Int. Cl.<sup>8</sup>: <b>A63 B 71/14</b> A 41 D 19/00</p>
<p>21 Aktenzeichen: P 35 18 545.6-15</p> <p>22 Anmeldetag: 8. 5. 86</p> <p>43 Offenlegungstag: 13. 11. 86</p> <p>45 Veröffentlichungstag der Patenterteilung: 17. 2. 94</p>		
<p>Innerhalb von 3 Monaten nach Veröffentlichung der Erteilung kann Einspruch erhoben werden</p>		
<p>23 Patentinhaber: Fleischmann, Endrik, 85258 Weihs, DE</p>	<p>72 Erfinder: gleich Patentinhaber</p> <p>56 Für die Beurteilung der Patentfähigkeit in Betracht gezogene Druckschriften: DE 82 25 343 U 1</p>	
<p>59 Handschuh, insbesondere Torwarthandschuh</p>		



The goal keeper glove has been really patented → DE 35 16 545 C2. Granted independent claim 1 reads as follows:

*„Glove, particularly goal keeper glove, wherein the glove's back consists of two material layers, characterized in that the inner material layer substantially guarantees tensile strength but is flexible at least in certain surface regions of the glove's back, and in that the outer material layer consists of substantially pressure-resistant elements being strung together in longitudinal direction, being settled on the inner material layer in forming gaps, and in that they blockingly abut short before the glove's stretching position“.*



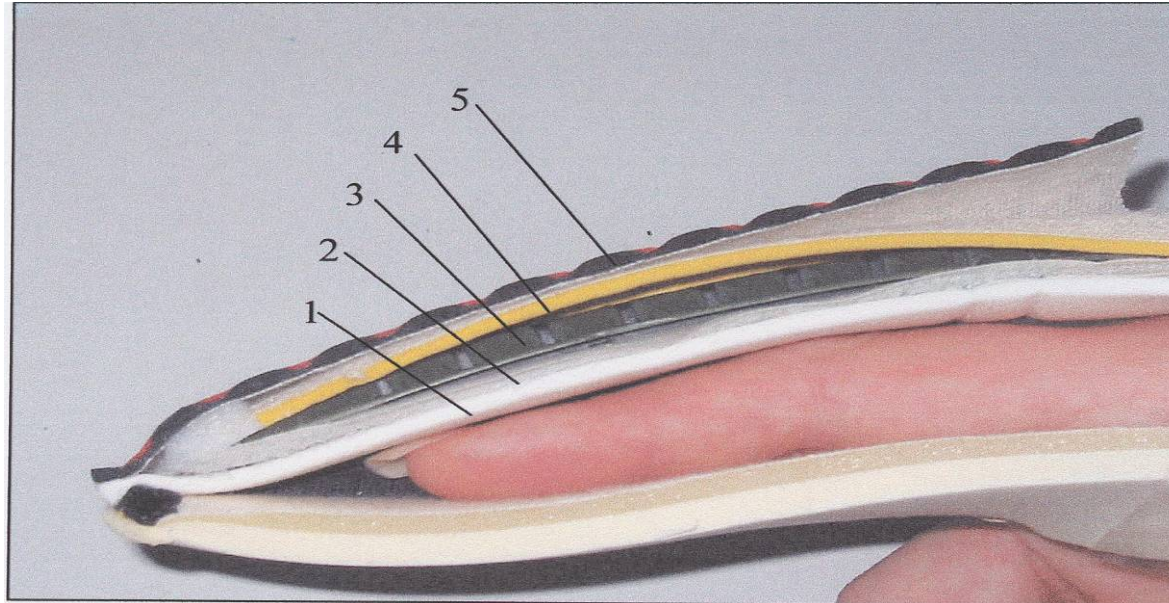
To better understand the claim, here is a feature analysis:

*Glove, particularly goal keeper glove.*

- a. The glove's back consists of two material layers.*
- b. The inner material layer substantially guarantees tensile strength but is flexible at least in certain surface regions of the glove's back.*
- c. The outer material layer consists of substantially pressure-resistant elements being strung together in longitudinal direction.*
- d. The substantially pressure-resistant elements are settled on the inner material layer in forming gaps in that they blockingly abut short before the glove's stretching position.*

Only if a goalkeeper glove realizes all features a. - d., it infringes the patent claim.

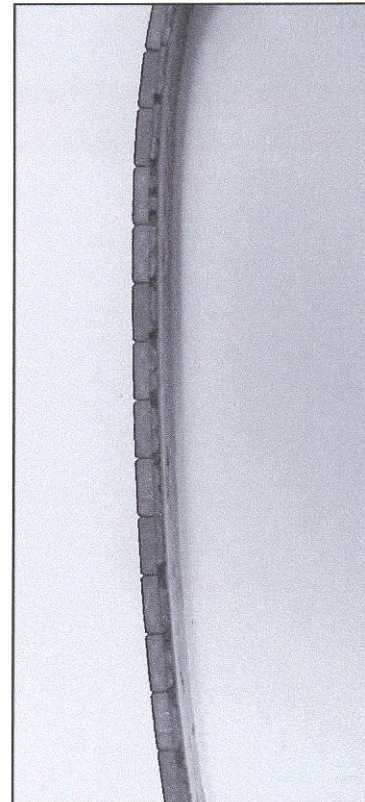
# Infringing Embodiment 1?



**Integration of “Protective Elements” against over-stretching in “Finger Pockets” the glove back. The back consists of various fabric/plastic foam layers with layer 3 being the integrated Protective Element.**

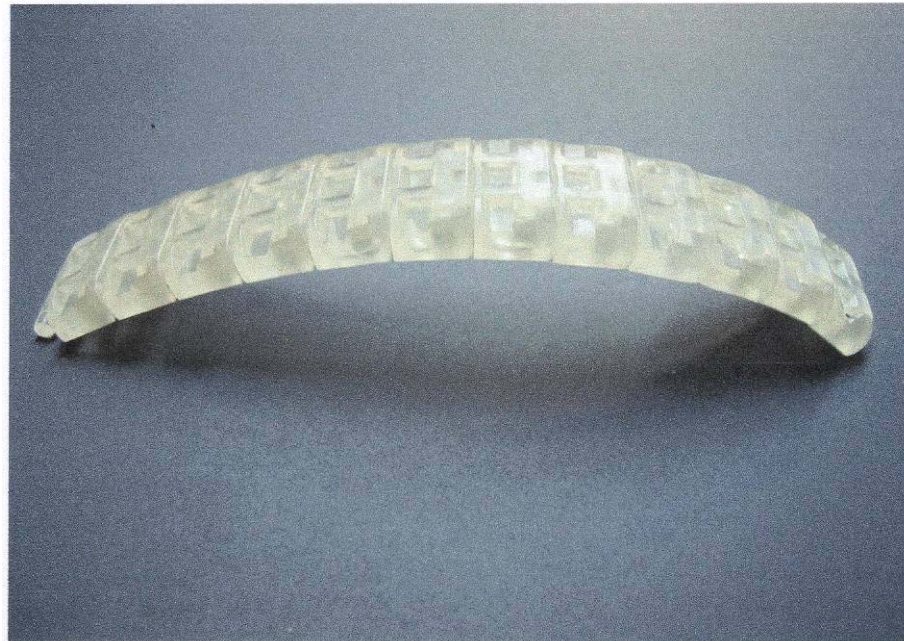


## The “protective element” according to the 1. Embodiment

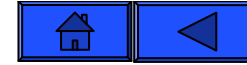




# Infringing Embodiment 2?



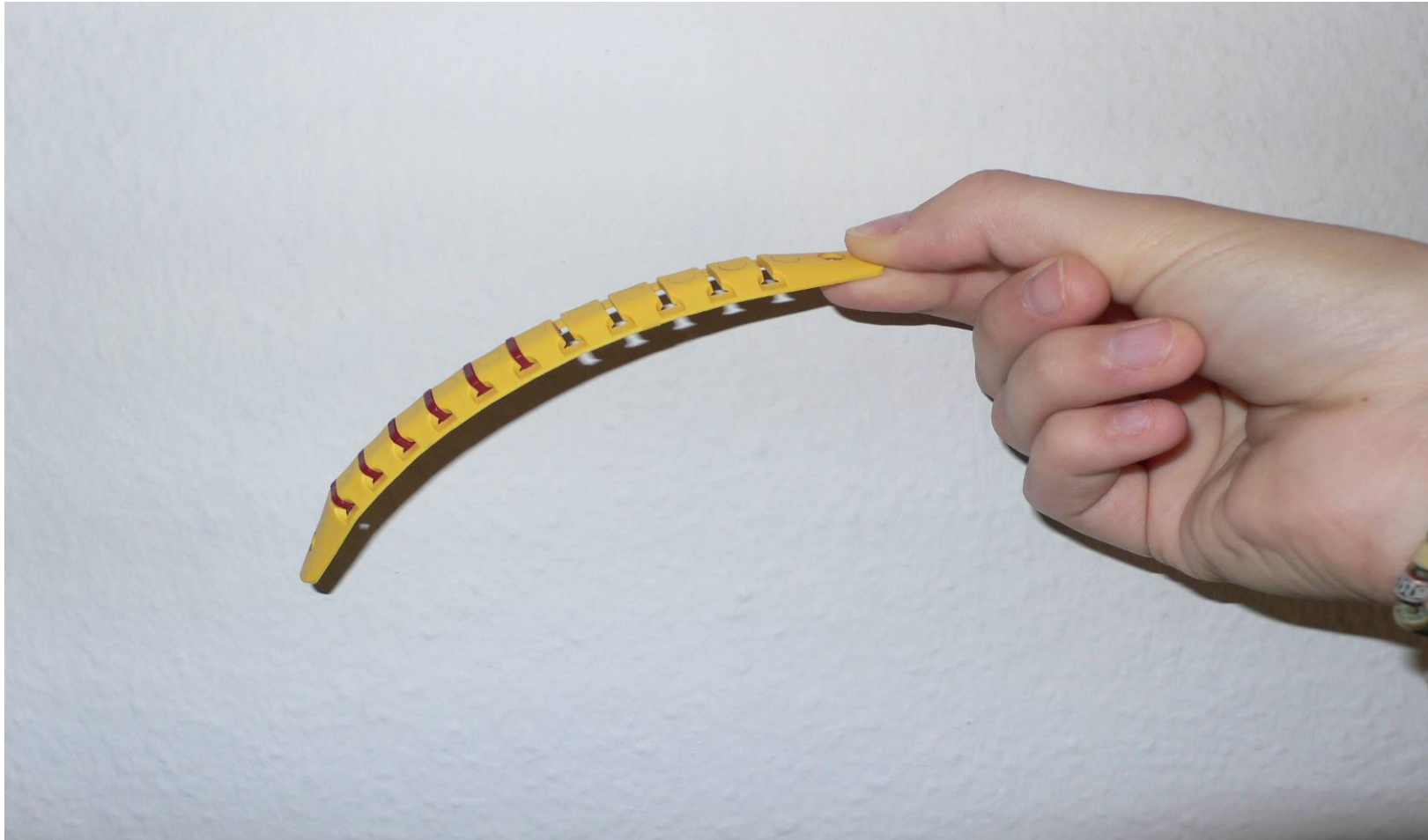
**The “Protecting Element” of the 2. embodiment; again positioned in “Pockets”**



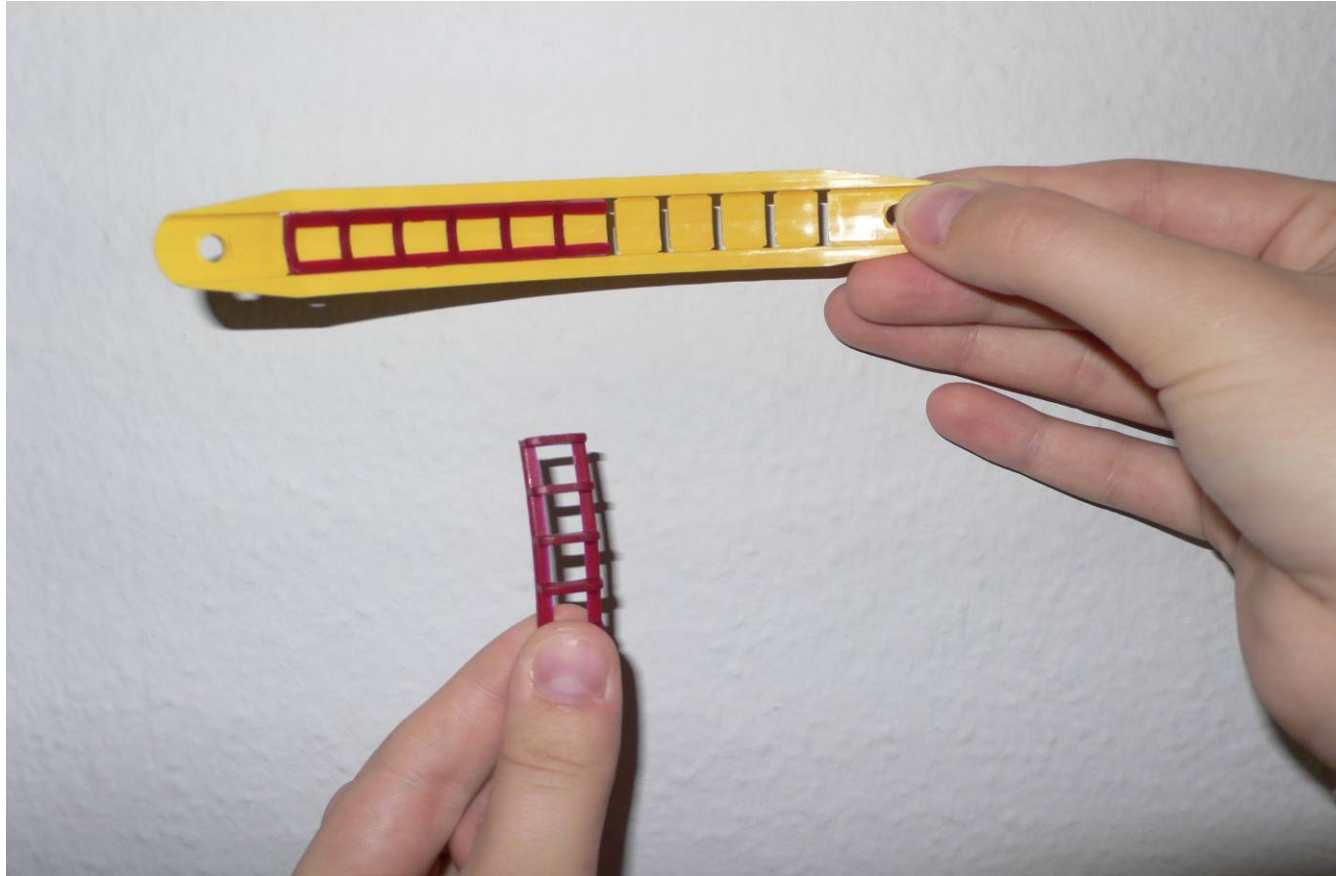
The “Protective Element” according to the 2. embodiment consists of a series of pin-jointed rigid plastic elements. The joints are made such that bending in the gripping direction is possible without resistance, however, short before the stretching position, blocking is also achieved so that the support element cannot be bent into the other direction:



# Infringing Embodiment 3?



# Infringing Embodiment 3?



The „Protective Element“ consists of a flexible main part (yellow), and a rigid grid-like member (red), which is clipped in the main part



# Infringing Embodiment 4?



Here, the „Protective Element“ consists of a flexible main part, and a plurality of rigid L-shaped blocks, which are clipped in the main part



# Infringing Embodiment 5?



# Infringing Embodiment 5?



Finally, in this embodiment, the „Protective Element“ consists of a single piece including reinforcements (ribs) in defined longitudinal sections, which allow a bending at special positions in one direction!



# Have fun!

