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# German Federal Court of Justice reaffirms commonsense approach to patent translations

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A recent measured decision of the German Federal Court of Justice has reaffirmed common sense with regard to patent translations.

In patent litigation the defendant has two basic lines of defence. First, the defendant can claim non-infringement on material grounds. This includes showing that it has made no use of the invention as put down in the claims or that the patent in question is not patentable in material terms (ie, because it is anticipated by the prior art).

Alternatively, the defendant can try to use formal grounds in order either to show that the patent is not enforceable, or to demonstrate that the patent should be revoked.

It appears only just and fair that a defendant which is not materially infringing a patent is not found liable in the proceedings. Likewise, all parties agree that a patent for an invention that is not novel or inventive must be revoked.

On the other hand, some of the formal defences – while basically justified for a particular set of cases – are often at risk of being abused in situations in which they were never meant to apply. These legal loopholes are usually there for a legitimate reason. However, legal practice must ensure that what is legitimate as an exception does not become illegitimate as the rule.

Fortunately, the German Federal Court of Justice continues to ensure that infringers cannot use formalistic arguments to escape liability when material grounds for defence are exhausted or simply do not exist.

In the *Orange Book* decision the German Federal Court of Justice clearly specified the narrow circumstances under which a defendant in patent infringement is entitled to the "fair, reasonable and non-discriminatory" (FRAND) defence (for further details please see "Supreme Court confirms FRAND jurisdiction").

The German Federal Court of Justice has now found that a European patent is not invalidated in Germany just because of omissions in translation. Infringers had argued that minor omissions in translation comprising only a few, materially irrelevant words among pages and pages of specification consituted an incomplete translation and were thus tantamount to a missing translation.

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The legal point of entry for this bold argument is the fact that for the majority of European patents in effect for Germany, which were granted before 1st May 2008, the translation requirements in existence before the London Agreement apply. According to these, submission of an erroneous translation of the specification results in republication of a corrected version and a protection of confidence for those infringing parties believing themselves outside the patent scope in good faith, due to their reliance on the faulty translation.

However, according to the same article, the consequences of submitting a translation late or failing to submit a translation at all are worse. They entail the complete revocation of the patent for Germany. Clearly, this rule was meant to enforce the timely submission of a translation. It was not meant to invalidate the patent because of omissions in that translation that may as well be slips of the pen. The severe and final penalty associated with a missing translation, compared to the possibility of corrections in the case of mere errors in the translation, naturally suggests that if a translation of the patent was submitted in time, revocation of the patent should occur only under exceptional circumstances.

Yet for a certain period of time, theGerman first instance patent infringement courts did not rigorously adhere to a consistent standard in this regard. One court went so far as to decree a translation to be missing because section headings in the patent specification were forgotten. It explicitly equated any degree of incompleteness with an entirely missing translation. Results-wise, overlooking section headings became equivalent to not submitting a translation of the patent specification at all.

The fact that this position was subsequently adopted by some other first instance courts raised even more eyebrows in the patent community. After all, with some patent specifications running to hundreds of pages, was it not likely that the majority of German translations of European patents had some, however tiny, elements that were overlooked in the translation?

Even though there was vocal opposition from some important courts, which blasted this view as disproportionate, patent infringers saw an opening. Increasingly, they tried to pinpoint minuscule omissions, including footnote-like text in illustrations, as evidence of an incomplete translation and therefore of an invalid patent.

Fortunately, recent decisions of the German Federal Court of Justice have now unequivocally settled the matter on the side of common sense. The German Federal Court of Justice has ruled that an incomplete translation is equivalent to an erroneous translation and is therefore remediable at any point during the patent's period of validity. Citing the patent claims as providing the most definite basis for the protected subject matter, this decision finds defects on the part of the translation of the specification to be insufficiently severe to warrant revocation of the patent in its entirety. The existing provisions regarding good-faith adherence to erroneous translations adequately serve the justified interest in protection of confidence.

Given the long tradition of pragmatic and fair jurisdiction by the Patent Senate at the German Federal Court of Justice, this decision comes as no surprise to IP law observers. Nonetheless, an explicit reaffirmation of common sense should always be welcomed for the good news that it is. Once again, a formalistic loophole for patent infringers has been consigned to the dustbin, where it rightly belongs.

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