

- Informal office translation -

Judgment

22 December 2006

First Division

No. C05/200HR

RM/MK

Supreme Court of the Netherlands

Judgment in the case of:

[Appellant in cassation]

having its registered office in [registered seat],

APPELLANT in cassation,

Lawyer: *Meester* M.A.A. van Wijngaarden,

versus

the legal entity under foreign law SAIER VERPACKUNGSTECHNIK GMBH & CO. KG (formerly known as SAIER GmbH & Co.),

having its registered office in Alpirsbach-Peterzell,

Germany,

RESPONDENT in cassation,

Lawyer: *Meester* C.J.J.C. van Nispen.

1. The proceedings in the fact-finding instances

Appellant in cassation – hereinafter referred to as: [appellant] – has, by means of a writ of summons dated 3 July 2000 summoned the respondent in cassation – hereinafter referred to as: Saier – to appear before the District Court in The Hague. Insofar currently still relevant the [appellant] claimed a declaratory judgment of non-infringement of the Dutch and German parts of European Patent 0.565.967 in the name of Saier, with respect to [appellant]’s buckets of the GAR and Foodline type. Saier disputed the claim and on its part, by means of a counterclaim, claimed – briefly summarised and insofar currently still of interest – to prohibit the [appellant] to infringe its patent in the countries designated by the patent as well as to order the [appellant] to compensate the damages, to be further specified, or to surrender profits. Furthermore, Saier lodged various ancillary claims.

The [appellant] contested the claims in counterclaim.

In its judgment dated 10 July 2002 the District Court dismissed the claims of the [appellant] in the main action. In the counterclaim, the District Court (for the most part) sustained the claims of Saier, insofar they relate to the Netherlands and Germany. As far as France, Austria, Switzerland, Belgium, Luxembourg and Liechtenstein are concerned, the District Court adjourned its decision in connection with pending proceedings in France. The [appellant] lodged an appeal against this judgment at the Court of Appeal in The Hague. Saier lodged a cross appeal and increased its claim.

In its judgment dated 10 February 2005, the Court of Appeal reversed the judgment against which the appeal was lodged and, again giving judgment, in the main action:

- declared (it to be the law) that the [appellant], by manufacturing and trading its “Foodline” buckets, does not infringe the Dutch and German part of European Patent 0.565.967.B2 in the name of Saier;
- dismissed anything more or otherwise claimed by the [appellant].

Insofar relevant in cassation, the Court of Appeal in counterclaim in the principal action ordered the [appellant] to, immediately following serving of this judgment, cease any infringement of European Patent 0.565.967.B2 in all designated countries on pain of a penalty sum. Moreover, the Court of Appeal, in addition to certain ancillary injunctions, ordered the [appellant] to pay damages, to be further specified and to be settled in accordance with the law or to, insofar it concerns the Netherlands and/or Austria and at the discretion of Saier, surrender the profits made by the [appellant] as a result of the infringing actions against Saier.

The judgment of the Court of Appeal is attached to this judgment.

2. The proceedings in cassation

The [appellant] lodged an appeal in cassation against the judgment of the Court of Appeal. The writ of summons in cassation is attached to this judgment and constitutes an integral part thereof.

Saier has moved that the appeal be dismissed. Saier has filed a sample of [appellant]’s bucket of the GAR-II type with the Supreme Court’s registry.

For and on behalf of the parties the case has been clarified by their lawyers.

The opinion of Advocate General D.W.F. Verkade concludes dismissal of the appeal.

By letter dated 19 October 2006 *Meester* W.A. Hoyng, lawyer in Amsterdam, has responded to that opinion for and on behalf of the [appellant].

3. Assessment of the ground for cassation

3.1 In cassation the following can be assumed:

(i) Saier is the holder of European Patent 0 565 967 B2 which relates to a synthetic bucket with a lid. The grant of this patent, which is valid in the Netherlands, Germany, France, Austria, Switzerland, Belgium, Luxembourg and Liechtenstein, was published on 26 July 1995.

(ii) Claim 1 of the patent reads as follows:

“Topfförmiges Gefäß, insbesondere Eimer (1), mit einem Deckel (6), dessen Rand (5) mit einem an dem Gefäßrand (3) angeformten und nach außen hin vorstehenden Befestigungsflansch (4) oder dergleichen rastend verbindbar ist, wobei in der Raststellung des Deckels (6) eine an dessen umlaufenden Rand (5) angeformte, nach innen vorstehende Leiste (13) satt und dichtend um die Außenkante (18) des Befestigungsflansches (4) herumgreift und an dem Gefäßrand (3) mindestens ein Werkzeug (14) zum Lösen des Deckels (6) angeordnet ist, dadurch gekennzeichnet, dass als Werkzeug eine an dem Gefäßrand (3) angelenkte Lasche (14) vorgesehen ist, die durch eine Schwenkbewegung aus einer dem Gefäß nahen Sperrstellung nach außen den Deckelrand (5) in diesem Bereich nach außen über die Außenkante (18) hinweg in eine freigebende Lösestellung anhebt, wobei die mit der Leiste (13) zusammenwirkende Wirkfläche (Außenseite 21) der Lasche (14) in deren Sperrstellung vom Drehpunkt (Filmscharnier 15) der Lasche (14) fort von der Längsachse des Gefäßes beabstandet ist und wobei mindestens die eine der beiden den jeweils benachbarten Stirnkanten (26) der beiden Enden des Befestigungsflansches (4) gegenüberstehenden Kanten (25) der Lasche (14) mit dem zugehörigen Flanschende (26) über dünnwandige, als Originalitäts-Verschluss dienende und damit leicht abreißbare Kunststoffstege (27) oder einen durchgehenden Kunststofffilm verbunden ist.“

(iii) The [appellant] filed opposition and appeal proceedings to the patent at the European Patent Office, as a result of which the patent was partially maintained and claim 1 came to read as aforementioned under (ii).

(iv) In the Netherlands and Germany the [appellant] markets synthetic “GAR” and “Foodline” buckets. These buckets have a lip, connected to the bucket by means of attachments which can be ‘torn’ and moved upwards.

3.2 The [appellant], who takes the position that its buckets do not infringe as the closure thereof is such that it can be removed through finger pressure, as a result of which there is no “satt und dichtend herumgreifen” with respect to these buckets, as intended by claim 1, has requested and claimed before the District Court a declaration of non-infringement of Saier’s patent with respect to its

“GAR” and “Foodline” buckets. The District Court dismissed this claim and, to the contrary, awarded the infringement claim of Saier in the counterclaim as mentioned above under 1.

- 3.3 In appeal, the Court of Appeal ruled that the buckets of the “GAR” type infringe the patent, but that the buckets of the “Foodline” type do not. Consequently the Court of Appeal awarded the declaratory judgment claimed by the [appellant] with respect to the buckets of the latter mentioned type. In counterclaim relating to the infringement of the buckets of the “GAR” type, the Court of Appeal ordered the [appellant] to, in short, cease infringement of the patent of Saier in all designated countries and ordered the [appellant] to pay Saier’s damages incurred since 19 May 2000 as a result of the infringing actions of the [appellant].
- 3.4 With respect to its opinion that the expression “satt und dichtend” in claim 1 would imply a lid/cover which closes/seals so well that it will not or barely be possible to manually, that is: without tools, remove it, the [appellant] invoked, among others, the patent as originally granted (the B1 publication) and the opinion of the Technical Board of Appeal of the European Patent Office. In legal consideration 9 the Court of Appeal has dismissed this position as follows:
“The dictionary (exhibit 28 of the [appellant]) indicates that the definition of “satt”, being “eng (anliegend), knapp, straff”, found by the [appellant] constitutes a Swiss variant. The Court of Appeal considers it little plausible that this variant is actually meant by Saier or its patent attorney mentioned on the front page of the patent (both German), but rather that “satt” is intended to mean “sufficiently”, “completely” and that “satt” consequently states nothing about the strength of the closure/fastening. The [appellant] does not present any passages from the description which would be in direct conflict with this kind of interpretation. The [appellant] does invoke the B1 publication; however, to the opinion of the Court of Appeal, the B1 publication is irrelevant. This opinion is supported, and this also applies to the references made by the [appellant] to the opposition ruling, by the fact that there is no reason to consult the prosecution history file because the claim is sufficiently clear and does not provide cause for this kind of consultation (compare Supreme Court, 13 January 1995, NJ 1995, 391 with note DWFV). Needlessly the Court of Appeal notes that, if nonetheless the ruling of the Board of Appeal is consulted, and the “mit Fingerkraft allein kaum zu lösender Sitz des Deckels auf dem Gefässrand” as quoted by the [appellant] as clarification would be taken into account, this still does not lead to the conclusion that the lid/cover can, in its entirety, not be opened manually but only by means of the lip serving as a tool thereto.”
- 3.5.1 Part I of the ground is directed against the opinion of the Court of Appeal that there is no reason to consult the prosecution history file because the claim is sufficiently clear and does not give cause for this kind of consultation. First of all, the [appellant] complains that this view is incorrect and in connection therewith argues: when a third party accused of infringement defends itself by invoking

the prosecution history file (in this case: the B1 publication and the ruling of the Technical Board of Appeal), by means of the position that the patent holder claims a subject matter which the latter did not claim in the patent as originally granted (B1), there is always reason to consult the prosecution history file in order to verify the correctness of that statement.

3.5.2 With respect to the question if and, if so, when and to what extent, upon interpretation of a patent, meaning can be attributed to the prosecution history file, as also elaborated in the opinion of the Advocate-General under 4.16-4.21, there is no unambiguous position among the Member States of the EPC. By means of its aforementioned judgment dated 13 January 1995, no. 15564, NJ 1995, 391 the Supreme Court considered, following a complaint directed against the position of the Court of Appeal that the (publicly accessible part of the) prosecution history file can – to a certain extent – be invoked against the patent holder but can under no circumstance whatsoever be used in favour of an interpretation of the patent defended by the patent holder and disputed by a third party being sued for patent infringement and as, insofar currently of interest that:

“The complaint is insomuch founded that the opinion of the Court of Appeal is, in general, too far-reaching. The provisions of article 69 paragraph 1 EPC, as interpreted pursuant to the thereto pertaining protocol, do indeed (amongst other things) aim to provide reasonable legal security of third parties, however, this does not mean that consequentially the information from the prosecution history file, insofar accessible to third parties, could never be used in favour of an interpretation of the patent as defended by the patent holder. The requirement of reasonable legal security for third parties does require reticence when it comes to using arguments deriving from the prosecution history file in favour of the patent holder. Therefore, the Court will only be allowed to make use of elucidating information in the public part of the prosecution history file when it is of the opinion that even after studying the description and the drawings it still remains reasonably doubtful to the average skilled person how to understand the content of the claims. In connection therewith it must also be taken into account that obscurities resulting from an inaccurate wording of the patent documentation should, in principle, be at the risk of the patent holder.”

3.5.3 The rule provided by the aforementioned judgment and repeated by Supreme Court, 12 November 2004, no. C03/161, NL 2004, 674, that the Court can only make use of elucidating information deriving from the prosecution history file in the event that the Court is of the opinion that even after studying the description and the drawings it still remains reasonably doubtful to the average skilled person how to understand the content of the claims, relates – as also clearly follows from the word “therefore” – to use of information originating from the prosecution history file in favour of an interpretation of the patent as defended by the patent holder. This restrictive rule serves the requirement of reasonable legal security for third parties which should be taken into consideration

when interpreting a patent. However, in the event that a third party invokes the prosecution history file to substantiate its interpretation of the patent, it cannot reasonably be considered that such requirement would require any restriction with respect to taking into consideration publicly accessible information found in the prosecution history file upon interpretation of the patent. Such a limitation can neither be deducted from Supreme Court, 27 January 1989, no. 13394, NJ 1989, 506, in which (in legal consideration 3.5) it was ruled that third parties may only assume that the applicant of the patent intended, pursuant to wording in the patent documentation, to renounce part of [*i.e. limit*] the protection which the patent provides on the basis of the essence of the patented invention, if reasonable grounds thereto exist, taking in account the content of the patent specification in the context of any other available information, such as the information known by [such third party] deriving from the patent prosecution history file. This view, on the contrary, provides support for the position defended in this Part [I], as no relevant distinction exists between the defence that the patent holder intended to limit the scope of protection provided by the patent on the basis of the essence of the patented invention and the defence as presented by the [appellant] that the patent holder claims a subject matter which it did not claim in the patent as originally granted. The legal complaint of Part I succeeds.

3.6 Part II of the ground, which is directed against legal consideration 12 insofar the Court of Appeal ruled that the interpretation of the words “satt und dichtend” which it provided in legal consideration 9 (“satt” says, contrary to what the [appellant] argues, according to whom these words refer to a lid/cover that closes/seals so well that it will barely be possible to remove it manually (that is: without tools), nothing about the strength of the closure), is not limited by the state of the art presented by the [appellant], requires no further discussion.

4. The judgment

The Supreme Court:

quashes the judgment of the Court of Appeal in The Hague dated 10 February 2005;
refers the proceeding, for further discussion and judgment, to the aforementioned Court of Appeal;
convicts Saier to pay the costs of the proceedings in cassation, up to this judgement on the part of the [appellant] estimated to amount to EUR 444.11 in advances and EUR 2,600.00 in fees.

This judgment is rendered by the Vice-President J.B. Fleers acting as Chairman and the justices O. de Savornin Lohman, A.M.J. van Buchem-Spapens, P.C. Kop and W.D.H. Asser and was pronounced in public by justice E.J. Numann on 22 December 2006.