

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-02-17
Docket Number / Aktenzeichen:	X ZR 161/12
Name of Decision / Name der Entscheidung:	Wound treatment apparatus



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.

Our ref.: R3006

**English Translation of the Judgment by the Federal Court of Justice
Pronounced on 17 February 2015**

**FEDERAL SUPREME COURT
IN THE NAME OF THE PEOPLE
JUDGMENT**

X ZR 161/12

Pronounced on:
17 February 2015
Beširović
Judicial Clerk
as Registrar
of the Court Registry

in the patent nullity case

Defendant and Plaintiff in the Appeal proceedings,

- Attorneys of Record:

versus

1.

2.

Plaintiff and Defendant in the Appeal proceedings,

- Attorneys of Record 1:

- Attorneys of Record 2:

Following the oral proceedings on 17 February 2015, Civil Division X of the Federal Supreme Court, represented by Presiding Judge Prof. Dr. Meier-Beck (Mr), Judges Hoffmann (Mr), Dr. Deichfuß (Mr), Dr. Kober-Dehm (Ms) and Feddersen (Mr),

held:

Upon Defendants Appeal, the Decision by the fourth Senate (Nullity Senate) of the Federal Patent Court dated 3 July 2012 is set aside.

European Patent 1 088 569 is declared null and void with effect for the Federal Republic of Germany to the extent that its subject matter goes beyond the following version of the patent claims:

- "1. Vorrichtung zum Ausüben eines Unterdrucks auf eine Oberflächenwunde in einem Säuger, die umfasst: ein poröses Polster (102) aus offenem, eine Verbindung schaffendem, zeltförmigen Weichschaum, eine Pumpe (6), eine Saugleitung (101) zum Verbinden des porösen Polsters mit der Pumpe (6), einem Verbinder zum Verbinden des Polsters mit der Saugleitung, eine chirurgische Abdeckung (701) zum Bilden einer luftdichten Abdichtung über der Wundstelle, über dem Polster und über dem Verbinder, wobei der Verbinder einen Ausguss (602) zum Verbinden des von der Pumpe (6) ferngelegenen Endes der Saugleitung (101) mit der Wundstelle aufweist, **dadurch gekennzeichnet, dass** der Verbinder eine scheibenartige Schale (601) umfasst, deren untere Fläche mit dem porösen Polster in Kontakt steht, und wobei die Saugleitung(101) als innere Bohrung (606) in einer Multilumenleitung ausgebildet ist, die ferner Kanäle (607) umfasst, mittels deren ein Aufnehmer (108) den Druck an der Wundstelle misst.
2. Vorrichtung nach Anspruch 1, wobei das poröse Polster (102) einen Polyvinylalkoholschaum umfasst.
3. Vorrichtung nach Anspruch 1 oder 2, wobei die chirurgische Abdeckung (701) ein Loch (702) für den Ausguss (602) aufweist, durch das dieser sich hindurch erstreckt.
4. Vorrichtung nach Anspruch 3, wobei die chirurgische Abdeckung (701) eine Kunststofffolie (701) umfasst, die mit einem druckempfindlichen Klebstoff zum Befestigen des porösen Polsters (102) und des Verbinders an der Wunde beschichtet ist."

[English translation:

1. Apparatus for applying negative pressure to a superficial wound in a mammal which comprises: a porous pad (102) of open, intercommunicating cellular flexible foam, a pump (6), a suction tube (101) for connecting the porous pad to the pump (6), a connector for connecting the pad to the suction tube, a surgical drape (701) for forming an air-tight seal over the wound site, over the pad and over the connector, said connector having a spout (602) for connecting to the end of the suction tube (101) remote from the pump (6) to the wound site, **characterized in that** the connector comprises a disc-like cup (601) having its lower face in contact with said porous pad, and wherein the suction tube (101) is formed as an internal bore (606) within a multi-lumen tube further comprising conduits (607) by means of which a transducer (108) measures the pressure at the wound site.
2. Apparatus according to claim 1, wherein the porous pad (102) comprises a polyvinyl alcohol foam.
3. Apparatus according to claim 1 or 2, wherein the surgical drape (701) has a hole (702) for the spout (602) to project therethrough.
4. Apparatus according to claim 3, wherein the surgical drape (701) comprises a plastics film (701) which is coated with a pressure-sensitive adhesive for securing the porous pad (102) and connector to the wound.]

In any other respect, the case is referred back to the Patent Court for new proceedings and a new decision, also regarding the costs of the Appeal proceedings.

As of right

Facts:

- 1 Defendant is Owner of European Patent 1 088 569 (patent-in-suit) granted with effect for the Federal Republic of Germany resulting from a divisional application filed on 8 January 2001. The latter is based on an international patent application of 14 November 1996 (parent application) which was published as WO 97/18007 and which is registered with the European Patent Office as European patent application 865 304. The patent-in-suit relates to a portable wound treatment apparatus and comprises five patent claims. Patent claim 1 on

which the other claims refer back, either directly or indirectly, reads in the language of the proceedings:

“Apparatus for applying negative pressure to a superficial wound in a mammal which comprises: a porous pad (102) of open, intercommunicating cellular flexible foam, a pump (6), a suction tube (101) for connecting the porous pad to the pump (6), a connector for connecting the pad to the suction tube, a surgical drape (701) for forming an air-tight seal over the wound site, over the pad and over the connector, said connector having a spout (602) for connecting to the end of the suction tube (101) remote from the pump (6) to the wound site, characterized in that the connector comprises a disc-like cup (601) having its lower face in contact with said porous pad.”

2 Plaintiff 1 contested the patent-in-suit in its entirety, Plaintiff 2 contested it within the scope of patent claims 1 to 4. Plaintiffs asserted that the subject matter of claim 1 is not patentable and is based on inadmissible broadening. Defendant defended the patent-in-suit in its granted version and ultimately with six Auxiliary Requests. The Patent Court declared the patent-in-suit null and void.

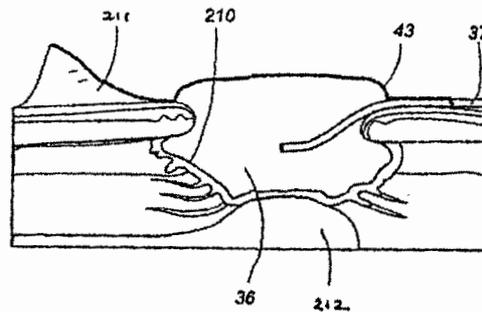
3 With their Appeal which is directed against the Decision by the Patent Court, Defendant first of all requests that the actions be dismissed and, as an auxiliary measure, defends the patent-in-suit in restricted claim versions. Plaintiffs oppose the Appeal.

Reasons:

4 I. The patent-in-suit relates to a portable wound treatment apparatus.

5 1. According to the description in the patent-in-suit, apparatus for the treatment of wounds were known in the prior art, e. g. from the International application WO 96/05873, which stimulate the wound healing process by applying negative pressure. Such an apparatus comprises a porous pad which is permeable for fluid that can be fitted into the wound, a dressing for covering the wound and providing an air-tight seal around the wound, a drainage tube connecting the pad to a suction pump so that negative pressure can be applied to the wound to draw fluids therefrom, and a canister for collecting fluids sucked from the wound.

- 6 Figure 10 of the above-mentioned International application, for instance, shows what such an apparatus known in the prior art looks like,



wherein reference sign 210 refers to the wound, reference sign 36 refers to a porous foam pad which is permeable for fluid, reference sign 37 refers to the tube and reference sign 43 refers to the air-tight wound drape.

- 7 The technical problem which the patent-in-suit is to solve lies in providing an apparatus, which makes a treatment of wounds by means of negative pressure more convenient and which can be applied particularly also with mobile patients, i.e. patients who are not confined to bed.

- 8 2. In order to solve this problem, the specification of the patent-in-suit suggests an apparatus with the following features (sections of the Patent Court in square brackets):

Apparatus for applying negative pressure to a superficial wound in a mammal [1] which comprises

1. a porous pad (102) of open, intercommunicating cellular flexible foam; [1.1]
2. a pump (6); [1.2]
3. a suction tube (101) for connecting the porous pad to the pump; [1.3]
4. a connector for connecting the pad to the suction tube [1.4] having

- a) a spout (602) for connecting to the end of the suction tube (101) remote from the pump to the wound site, [1.6.]
- b) a disc-like cup (601) having its lower face in contact with said porous pad; [1.7a and 1.7b]

5. a surgical drape (701) for forming an air-tight seal over the wound site, over the pad and over the connector. [1.5]

9 3. Some features require clarification:

10 a) According to feature 4 a, the connector comprises a spout for connecting the end of the suction tube remote from the pump to the wound site, while in the prior art, as can be seen from Figure 10 given above, the end of the tube was inserted into the flexible foam pad. According to the description, either the spout can accept the end of the tube or the end of the tube can be passed into the spout and additionally be pressed into the foam (column 5, l. 37 to 39 and l. 45 to 47). The patent-in-suit leaves position and size of the spout to the person skilled in the art who in this case, as the Patent Court disputedly assumed, is a graduate of medical engineering and is familiar with the development of apparatus with negative pressure for wound treatment and who consults a competent physician regarding the medical aspects of wound treatment.

11 b) The connector comprises a disc-like cup according to feature 4b. Thus, it is an apparatus which, on the one hand, has the shape of a cup, i.e. which is not entirely flat, but rather is curved at its rim and, on the other hand, is disc-like, i.e. flat. Thus, the patent-in-suit regards a disc-like cup as a cup the height of which is significantly smaller than its diameter. Such an interpretation of the feature is also suggested as the wound healing apparatus should be suitable to be worn directly on the body (see Figures 3A and 3B), which is why it should be as flat as possible. This interpretation is furthermore confirmed, as Figures 6B and 6C show cups which are practically flat and which have a rim which is only curved minimally.

12 In addition, this interpretation is supported by the fact that the patent-in-suit mentions the International Application WO 94/20041, in paragraphs 6 and 7, as the closest prior art the content of which reflects the superordinate concept of patent

claim 1. The fact that claim 1 provides feature 4b as the only characterizing feature suggests that the devices denoted as 29a, 29b, 29c and 29d in Figures 2 to 5 in D1 are not to be considered disc-like. The view of Plaintiff 1 that paragraphs 6 and 7 of the patent-in-suit are not to be taken into account for the interpretation since they were not contained in the original application is incorrect. For the assessment of the teaching of a patent claim, the description and the drawings explaining and illustrating the technical teaching of the claim are to be considered and thus, according to established case law, are to be taken into consideration not only for determining the scope of protection (Art. 69 Section 1 EPC, § 14 German Patent Act) but also for the interpretation of the patent claim. However, the interpretation of the claim must not depend on what is proven to be patentable after examination of the prior art nor on the meaning of the original documents. Rather, the interpretation is to be based on the patent specification alone (BGH¹, Judgement of 17 February 29012 – X ZR 117/11, BGHZ² 194, 107 Margin No. 27 et seq. – Polymerschaum).

13 Feature 4b further says that the disc-like cup has its lower face in contact with the porous pad which is to be understood in such a way that the concave side of the cup is in contact with the pad in a two-dimensional manner. According to the description of the patent-in-suit, the cup is pressed onto the porous pad over the wound and secured by a surgical drape (column 5 lines 43 to 45). Considering, on the one hand, that the cup is disc-like, i.e. is flat, and, on the other hand, that the porous pad is made of flexible foam, i.e. is flexible, the person skilled in the art concludes that the cup is not necessarily in contact with the pad with its entire surface, and not only punctually or with its rim, i.e. along a line on the from prior art document, but is in contact with the pad in an essentially flat manner. From an expert view this means that the interior of the cup is essentially filled with the pad consisting of flexible foam in any case so that no major open spaces remain. This interpretation of the feature is clear to the person skilled in the art also from the fact that such embodiment contributes to the desired flat design which is advantageous for a portable device.

14 Information about the size of the cup, in particular with regard to it necessarily having to cover the whole flexible foam from prior art document, cannot

¹ BGH = Federal Supreme Court

² BGHZ = Decisions of the Federal Supreme Court in civil cases

be taken from claim 1.

15 c) According to feature 5, the apparatus comprises a surgical drape for
the preparation of an air-tight seal over the wound site, over the pad and over the
connector. Consequently, it follows that not only the pad but also the connector has
to be covered by the surgical drape.

16 II. The Patent Court's reasoning of its decision is essentially as follows:

17 The patent-in-suit is to be declared null and void because its subject matter
in all the defended versions exceeds the content of the earlier application in the
version as originally filed. It cannot be taken from the entirety of the originally filed
documents that feature M1.7b, according to which the lower face of the disc-like
cup comprised by the connector is in contact with the porous pad, is part of the
invention. It is not disclosed in the parent application that the connector of the
claimed apparatus comprises a disc-like cup having its lower face in contact with
the porous pad. This cannot be taken from Figures 6A to 6D of the parent
application. It is not clear from the disclosure taken as a whole either that the cup
has to be designed in such a way that its lower face is in contact with the porous
pad, and it remains unclear in which proportion and to what extent, respectively, the
lower face of the cup is in contact with the pad.

18 The introduction of feature M1.7b cannot be considered a mere limitation of
the subject matter of claim 1 but leads to a different teaching (*aliud*). Whereas the
person skilled in the art takes the teaching from the originally filed application
documents that the disc-like cup is designed in such a way that it is put on the
porous pad with the rim and not with the lower face in any case, this is, however,
exactly what the introduced feature presupposes. Since all the Auxiliary Requests
include this feature, they are inadmissible. Thus, it is irrelevant whether the other
reason for nullity, i.e. lack of patentability, applies.

19 III. This assessment does not withstand the examination in the appeal
instance in its entirety.

20 The Patent Court rightly concluded that the subject matter of claim 1 as
granted goes beyond the content of the parent application as originally filed.

- 21 a) Pursuant to Art. II Section 6 Subsection 1 No. 3 IntPatÜbkG³, a European patent with effect in the territory of the Federal Republic of Germany is to be declared null and void if its subject matter goes beyond the content of the application as originally filed. The relevant content of the application is to be established by means of the entirety of the documents as originally filed. It is not limited to the subject matter of the claims as defined in the application. Rather, what is relevant is what the person of average knowledge and skill in the relevant art can take from the original documents to be part of the invention (BGHZ⁴ 194, 107, Margin No. 45 – Polymerschaum).
- 22 b) In this case, there is inadmissible broadening in that the apparatus of the invention for applying negative pressure to a superficial wound is only characterised by a porous pad, a pump, a suction tube, a connector with a disc-like cup and a spout for connecting the from prior art document with the suction tube, and a surgical drape. In this general form, the apparatus is not disclosed as part of the invention in the original application documents, which, in the present case, is the parent application.
- 23 aa) The description of the parent application, like the one of the patent-in-suit, starts from the International Patent Application WO 96/05873. The apparatus described therein is effective for the treatment of a plurality of wounds of various types and sizes. The treatment, however, might take longer periods of time, which, is not a problem for a bedridden patient but is a problem for a patient who is not confined to bed. The problem of the invention is specified to be the provision of an apparatus which is more convenient to use, in particular with patients who are mobile to some extent, and which has further advantages which are evident from the description. For this purpose, first, a portable apparatus for stimulating healing of wounds is suggested, said apparatus including a housing that contains a vacuum pump wound drainage collection canister and comprises means for dressing up wounds and a strap or belt for supporting the housing, wherein the useful design of the housing, the vacuum pump and its drive, as well as the container are described in detail.

³ IntPatÜbkG = Law on International Patent Conventions

⁴ BGHZ = Decisions of the Federal Supreme Court in civil cases

24 Then, it is explained that with a portable apparatus, it is more difficult to determine the pressure on the wound site to be treated than with a static apparatus as described in the prior art, since the pressure partly depends on the hydrostatic height between the pump and the wound and the height changes in dependency of the patient's movements. This problem is to be solved by means of an additional tube connecting the wound with pressure sensors preferably located in the housing. The pressure sensors themselves can be connected with a microprocessor which ensures maintenance of a pre-determined pressure range. Such device can also be used with a non-portable apparatus. It also makes it possible to detect a container completely filled with wound fluid by means of the changes in pressure.

25 After these general explanations, there is the description of the embodiments illustrated in the drawings. With reference to Figure 1, amongst others, a tube 101 serving as suction tube, and a second tube 106 connecting the wound site for measurement or control of the pressure by means of a pressure relief valve 8 and a sensor 108 are described. Tubes 101 and 106 may be combined in a multi-lumen tube. This is designated to be preferred and illustrated in Figures 5A to 5F and, in a modified form, in 6E. The description then continues with Figures 6A to 6D which show various views of a connector for connecting the multi-lumen tube to the wound site. It is only here that the connector is described to comprise a disc-like cup having a spout suitable to take up the end of the multi-lumen tube (page 8).

26 In accordance with these explanations of the description, claim 1 of the application relates to a portable apparatus having a housing, a suction pump, a container and a carrying strap, dependent claim 3 relates to an apparatus for treatment including, amongst others, means for measurement of pressure and also dependent claims 5 relates to an apparatus for treatment including, amongst others, a suction tube and an additional tube connecting a porous pad with means for measurement of pressure which facilitate monitoring the pressure at the wound site.

27 The embodiments of the invention disclosed in the parent application are characterized on the one hand by the means which allow the apparatus to be portable (claim 1) and, on the other hand, by those which allow measuring pressure (claims 3 and 5). The connector is mentioned only in connection with the measurement of pressure and with the second tube which is required in addition to

the suction tube. The suction tube and the pressure sensor tube transducer can be connected in a multi-partitioned tube (parent application page 5 below), and the spout of the connector can take up this multi-lumen tube.

28 bb) From this, it cannot be taken directly and unambiguously that the invention for which patent protection is sought also relates to an apparatus for applying negative pressure on a superficial wound, wherein the apparatus neither includes means ensuring its portability nor means which allow measuring the pressure at the wound site, but rather, which is merely made up of a porous pad, a surgical drape, a pump, a suction tube and a connector for connecting the pad to the suction tube, which comprises a spout which takes up the suction tube and a disc-like cup.

29 However, formulating a patent claim, which contrary to the parent application contains a generalization, is not excluded by all means. Regarding the question whether priority of a previous application can rightfully be claimed, the Federal Supreme Court decided that this is admissible provided that the person skilled in the art were to understand the technical instructions in the previous application, illustrated by an embodiment or otherwise described, to be a particular form of the more general technical teaching disclosed in the subsequent application, and could already derive that teaching, as disclosed in the general form in the subsequent application, from the previous application as forming part of the invention claimed there (BGH⁵, Judgement dated 11 February 2014 – X ZR 107/12, BGHZ⁶ 200, 63, Margin No. 25 – Kommunikationskanal). The same criteria apply to the question as to whether the granted claim has an inadmissible broadening compared to the parent application documents.

30 According to this criterion, claim 1 is based on inadmissible broadening. From the original application documents, the person skilled in the art cannot readily understand the general technical teaching, to connect pad and suction tube which is part of an apparatus for applying negative pressure and which is connected to the pump by means of a device, which comprises a spout for taking up the suction tube and a disc-like cup for taking up the pad.

⁵ BGH = Federal Supreme Court

⁶ BGHZ = Decisions of the Federal Supreme Court in civil cases

31 Rather, in the parent application, the connector is disclosed only as an element of an apparatus in which it fulfils the purpose specified which is to ensure the connection of a multi-lumen tube to the wound site. Thus, it is inseparably linked to a wound treatment apparatus, also including pressure-detecting means, wherein the additional tube required for this purpose is preferably combined with the required suction tube in a multi-lumen tube, which is taken up by the spout of the connector. Neither the description nor the claims of the parent application give reason to assume that the person skilled in the art takes from it that s/he is introduced to an embodiment of the apparatus for applying negative pressure, i.e. the connector being designed in such a way that it has a flat cup with a spout or a nozzle, for which patent protection is desired, independently from the embodiments which deal with the portable form or the means for detecting pressure, and which is therefore – considered separately – disclosed as being part of the invention applied for.

32 Nothing else can be taken from the fact that, shortly before the above-mentioned passage of the description of the embodiment, the parent application also mentions a tube having only one single bore (*single bore tube*, bottom page 7). From the relevant passage, it is only clear that the partitioned tube (*partitioned tube*) which is provided must not extend to the wound site but may include a short section of a single-lumen tube. This is consistent with the explanation further below (page 8, middle) that the end of the tube may be passed through the spout and may extend into the flexible foam. This does not alter the fact that the cited passages basically refer to a multi-lumen tube and cannot cast doubt on the disclosure regarding the embodiment of the connector with a device for applying *and controlling* a negative pressure, which results from the content of the description as a whole.

33 c) Accordingly, the Patent Court was ultimately correct when they held that claim 1 in the version as granted is based on inadmissible broadening and, thus, cannot be maintained. A different assessment is not justified by the fact that the patent-in-suit results from a divisional application either. In such case, the requirements regarding the original disclosure are the same.

34 2. However, the contested Decision does not stand up to legal review
insofar as the Patent Court held that former Auxiliary Request 6 new, which
Defendant now submit as Auxiliary Request I, is based on inadmissible broadening.

35 According to Auxiliary Request I, a further feature is added to claim 1
wherein the suction tube (101) is formed as internal bore (606) in a multi-lumen
tube which further comprises conduits (607) by means of which a transducer (108)
measures the pressure at the wound site (Feature 6).

36 Contrary to the Patent Courts view, Defendants' defence by limiting the
patent to this Auxiliary Request is admissible.

37 a) The additional Feature (6) guarantees that the subject matter of
claim 1 does not extend beyond the content of the parent application. The
generalisation which according to the above explanations (under III 1) substantiates
inadmissible broadening no longer exists because the transducer (108) as for
pressure-detecting means and the second tube formed by the conduits (607) of a
multi-lumen tube for connecting the pad and the pump have been included in the
claim and the design of the connector is situated in this context since the suction
tube received by the spout forms the internal boring (606) of the multi-lumen.

38 b) The subject matter of claim 1 is based on inadmissible broadening
since Feature 4b states with respect to the disc-like cup that its lower face is in
contact with the porous pad. However, this does not mean that defending the
patent-in-suit limited to Auxiliary Request I is inadmissible.

39 aa) According to Feature 4b, the disc-like cup is in contact with the porous
pad with its lower face. As explained above, the person skilled in the art
understands the feature in such a way that the concave side of the cup is in contact
with the pad in a two-dimensional way.

40 Such two-dimensional contact between the concave side of the cup and the
pad is not disclosed as part of the invention in the documents as originally filed. In
Figures 6B and 6C, the parent application shows very flat cups. Moreover, it is
possible to infer, in particular due to the reference to International application

WO 96/05873 from which Figure 10 shown above is taken, in which way a pad with which the wound is covered may be designed. However, it is not clear from the parent application how the disk-like cup is placed onto the pad. It is merely explained that *the cup (601) is pressed onto the porous dressing and secured by a surgical drape* (parent application, page 8). Even if the fact that the pad consists of flexible foam is taken into consideration, the person skilled in the art cannot take from this information in a clear and unambiguous manner that the disc-like cup has its lower surface in contact with the porous pad. Whether these instructions result in a two-dimensional surface contact when they are carried out, depends, for technical reasons, on several circumstances, in particular on the height of the cup, on the size ratio of the cup, on the one hand, and the pad, on the other hand, on the solidity or flexibility of the pad and on the degree of pressure with which the cup is pressed onto the pad. With this regard, the parent application does not contain any information.

41 bb) However, this does not imply that Defendant's defence based on Auxiliary Request I is inadmissible.

42 (1) According to the case law of the Federal Supreme Court regarding German patents and utility models, such protective rights shall not be declared null and void or cancelled if their subject matter extends beyond the content of the application as originally filed provided that the amendment consists in the introduction of a feature that was not disclosed in the documents as originally filed which results in a mere limitation of the subject matter of the application. In contrast, a revocation or cancellation cannot be avoided if the result of the amendment means that the subject matter of the application is modified so as to be an *aliud vis-à-vis* the content of the documents as originally filed (BGH⁷, Decision of 5 October 2000 - X ZR 184/98, GRUR 2001, 140 - Zeitlegramm; Decision of 21 October 2010 - Xa ZB 14/09, GRUR 2011, 40 - Winkelmesseinrichtung; Judgment of 21 June 2011 - X ZR 43/09, GRUR 2011, 1003 Integrationselement; Decision of 6 August 2013 X ZB 2/12, GRUR 2013, 1135 - Tintenstrahldrucker). So far, the Federal Supreme Court has left open the question whether the case law is also to be applied to European patents (BGH, GRUR 2011, 40 Margin No. 19 - Winkelmesseinrichtung). Contrary to the view held by the Federal Supreme Court

⁷ BGH = Federal Supreme Court

(Judgment of 8 April 2014, Mitt. 2014, 436 – Fettabsaugevorrichtung) - the answer to this question is to be in the affirmative.

43 (2) The cited case law of the Federal Supreme Court is based on the assumption that the inadmissible amendment of the subject matter vis-à-vis the content of the documents as originally filed does not require revocation or annulment if it is possible to take into account the lawful interest of third parties, in particular of the competitors of patentee, and of the public by less severe measures.

44 Accordingly, the revocation or annulment of the patent is not necessary if the subject matter of the patent is generalised in an inadmissible manner vis-à-vis the content of the application documents as originally filed. In this case, the inadmissible broadening can be remedied by deleting the inadmissible generalisation in the patent claim (BGH⁸ GRUR 2011, 40 Margin No. 14 - Winkelmesseinrichtung; BGH, GRUR 2011, 1003 Margin No. 19 - Integrationselement; also EPO, Decision by the Enlarged Board of Appeal of 2 February 1994 – G 1/93, GRUR Int. 1994, 842 Margin No. 11 - Limiting feature /Advanced Semiconductor Products).

45 However, the revocation or the annulment of the patent cannot be avoided if the addition of a feature that was not disclosed in the documents as originally filed results in the subject matter of the claim of the granted patent being an invention other than the one of the original application, i. e. that the patent protects something that is an "aliud" compared to what was disclosed to the experts in the original documents (BGH, GRUR 2001, 140, 141 - Zeitlegramm; BGH, GRUR 2011, 40 Margin No. 21 - Winkelmesseinrichtung; BGH, GRUR 2011, 1003 Margin No. 27 - Integrationselement; BGH, GRUR 2013, 1135 Margin No. 16 - Tintenstrahldrucker). The maintenance of a claim amended in such a way is a risk for the legal certainty of third parties who are entitled to expect that the patent application will not result in a patent that protects subject matter that is broader than the subject matter disclosed in the application or different from it. In this case, the maintenance of a patent contested in an opposition or in nullity proceedings with the proviso that the relevant feature is maintained in the patent claim, however, the

⁸ BGH = Federal Supreme Court

patentee cannot derive any right from it, is precluded since it would mean that, subsequent to the opposition or nullity proceedings, the patent version would protect subject matter differing from the one that was originally disclosed (BGH, GRUR 2011, 40 Margin No. 23 - Winkelmesseinrichtung).

46 However, the revocation or annulment of a patent is not necessary if the introduction of a feature that is not disclosed as part of the invention in the documents as originally filed leads to a mere limitation of the subject matter of the application. In this case, the legitimate interest of the public is safeguarded by the fact that the limiting feature is maintained in the patent claim and that, at the same time, it is ensured that no right can be derived from the amendment, in particular that the undisclosed feature is not to be considered when patentability is assessed insofar as it may not be used in support of patentability (BGH⁹, GRUR 2001, 140. 142 et seq. - Zeitlegramm; BGH, GRUR 2011, 40 Margin No. 16 - Winkelmesseinrichtung; BGH, GRUR 2011, 1003 Margin No. 24 - Integrationselement; BGH, GRUR 2013, 1135 Margin No. 16 - Tintenstrahldrucker).

47 (3) This ruling of the Federal Supreme Court is not in contrast with the provisions of the European Patent Convention.

48 According to the case law of the European Patent Office, the introduction of a limiting feature, which was not disclosed as part of the invention in the original application documents, into the patent claim, as a rule, leads to the revocation of the patent pursuant to Article 123 (2) (c) EPC. If such a feature falls under the provisions of Article 123 (2) EPC, it can neither be maintained in the patent nor be deleted from the claims without violating Article 123 (3) EPC. In exceptional cases, the patent can only be maintained if there is a basis in the application as originally filed that the limiting features can be replaced by other features without violating Article 123 (3) EPC (Decision by the Enlarged Board of Appeal dated 2 February 1994 – G 1/93, GRUR Int. 842 Margin No. 12 et seq. - Beschränkendes Merkmal [Limiting feature]/Advanced Semiconductor Products).

49 In their decision regarding the annulment of a European patent granted with effect for the Federal Republic of Germany, the Federal Patent Court and the

⁹ BGH = Federal Supreme Court

Federal Supreme Court do not apply the Article 123 (2) and (3) EPC but base their decision on Article II Section 6 IntPatÜbkG¹⁰. With this provision, the national legislator made use of the possibility to lay down the reasons for the annulment of a European patent with effect for the Federal Republic of Germany pursuant to Article 138 EPC. Pursuant to Article 138 EPC, a European patent may be revoked, subject to Article 139 EPC, only on the grounds defined in Article 138 EPC. For this reason, the provision is contrary to the decision of a national court which declares a patent null and void even if none of the grounds laid down in Article 138 EPC is given. However, it allows the national court to refrain from declaring the patent null and void, even if such ground was given, without contravening Article 123 EPC as understood by the Enlarged Board of Appeal.

50 (4) Refraining from an annulment of a European patent is called for if the introduction of a feature which is not disclosed in the documents as originally filed or not disclosed as part of the invention results in a mere limitation of the subject matter of the application.

51 The Enlarged Board of Appeal admitted that the view held by the Board has severe consequences for the owner of the patent (EPO, GRUR Int. 1994, 842 Margin No. 13 – Beschränkendes Merkmal [Limiting feature]/Advanced Semiconductor Products) since s/he risks to be in an "inescapable trap" and to lose everything even if the amendment limits the scope of protection of the patent. The case law of the Federal Supreme Court cited above, in contrast, offers the possibility to refrain from declaring the patent null and void in its entirety without interfering the legal interest of third parties and the public. Thus, at the same time, it takes into account the protection of property which is guaranteed by the Constitution (Article 14 GG¹¹) and which also encompasses patent rights and protects the owner of the patent against sovereign acts if these are not necessary. Thus, it is justified to apply said case law on European patents.

52 (5) Insofar as claim 1 contains the feature that the lower surface of the disc-like cup is in contact with the porous pad, this is simply a specification of a technical teaching which is disclosed as part of the invention in the documents as originally filed.

¹⁰ IntPatÜbkG = Law on International Patent Conventions

¹¹ GG = Basic Law of the Federal Republic of Germany

- 53 (a) The question whether an introduction of a feature that was not disclosed in the original documents is a mere limitation of the subject matter of the application or whether it is an *aliud*, is answered by determining whether it is merely a specification of a technical teaching which is disclosed as part of the invention in the original documents or whether it relates to a technical aspect which cannot be taken from these as being part of the invention, neither as a specific embodiment nor in any abstract manner (BGH¹², GRUR 2011, 40 Margin No. 22 - Winkelmesseinrichtung; BGH, GRUR 2011, 1003 Margin No. 29 - Integrationselement; BGH, GRUR 2013, 1135 Margin No. 26 et seq. - Tintenstrahldrucker).
- 54 (b) In the light of the above, Feature 4b cannot be considered an *aliud*, contrary to the view held by the Patent Court. Insofar as the feature provides that the disc-like cup has a lower surface in contact with the porous pad, no new technical aspect is introduced. Rather, it is a mere limitation within the above-described meaning which informs the person skilled in the art that the disc-like cup is to be so flat that substantially two-dimensional contact between its lower face and the porous pad is created if the disc is pressed onto the porous pad and secured with the surgical drape.
- 55 (6) To defend the patent in limited form is admissible even though it is inadmissible to limit the patent claim by a feature that was not disclosed originally. Feature 4b is already contained in claim 1 as granted. For this reason, the fact that it is part of Auxiliary Request I, which is unobjectionable in any other respect, cannot call into question its admissibility.
- 56 3. The assessment by the Patent Court according to which it is not admissible to defend claim 1 in the version of Auxiliary Request I (former Auxiliary Request 6 new) does not withstand examination in the Appeal proceedings.
- 57 As a consequence, the contested Decision is set aside and the matter is referred back to Patent Court for new proceedings and a new decision (Section 119

¹² BGH = Federal Supreme Court

Subsection 2, 3 PatG¹³). A decision on the merits by the Senate is not expedient (Section 119 Subsection 5, Sentence 1 PatG [German Patent Act]). The Patent Court has not assessed the patentability of the subject matter of claim 1 in the version of the relevant Auxiliary Request so far. In the now necessary examination, the Patent Court shall not take into consideration the feature that was not disclosed originally.

Meier-Beck

Hoffmann

Deichfuß

Kober-Dehm

Feddersen

Previous instances:

Federal Patent Court, Decision of 3 July 2012 – 4 Ni 15/10 (EU)

joined with 4 Ni 20/10 (EU) -

¹³ PatG = German Patent Act