

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2014-10-14
Docket Number / Aktenzeichen:	X ZR 35/11
Name of Decision / Name der Entscheidung:	Access rights

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Reference work:     yes  
BGHZ:               no  
BGHR:             yes

[stamp:]  
Received  
19 December 2014  
Jordan & Hall  
Attorneys to the Federal Court of Justice

Access rights

German Patent Act section 14; EPC article 69

An interpretation of the patent claim that would result in none of the embodiments characterized in the patent specification being covered by the subject matter of the patent only comes into consideration if other interpretation possibilities, which result at least in the inclusion of a part of the embodiments, necessarily do not apply or if sufficiently clear indications can be inferred from the patent claim that something is actually claimed which so extensively deviates from the description.

German Patent Act section 4, EPC article 56

The fact that a solution has been demonstrated only in an earlier version of a technical standard but has not been further pursued in a later version does not automatically mean that this path should not be regarded as obvious.

German Code of Civil Procedure section 263, section 269 (3)

In the event of a change in plaintiff, the departing plaintiff according to section 269 (3) German Code of Civil Procedure has to bear the added costs incurred as a result of the change in parties, but not that portion—also—of the costs which would have to be imposed on it in the event of a withdrawal of complaint.

Federal Court of Justice, judgment of 14 October 2014 - X ZR 35/11 - Federal Patent Court



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

**X ZR 35/11**

Pronounced on:  
14 October 2014  
Wermes  
Judicial Inspector  
as Registrar of the Court

in the patent nullity action

IPCom GmbH & Co. KG, represented by the general partner IPCom Beteiligungs GmbH, which is represented in turn by the managing directors, Zugspitzstrasse 15, Pullach,  
Defendant, Appellant and Appellee

-Counsel of record: The attorneys of Quinn Emanuel, Mollstrasse 42,  
Mannheim;  
with the cooperation of: Patent Attorneys and Attorneys at Law Frohwitter,  
Possartstrasse 20, Munich  
Patent Attorneys df-mp, Theatinerstrasse 16,  
Munich -

v.

1. Microsoft Mobile Oy, represented by the management board,  
Keilalahdentie 4, Espoo (Finland),  
2. HTC Corporation, represented by the Chief Executive Officer,  
23 Xinghua Rd., Taoyuan City (Taiwan),

Plaintiffs, Appellee and Appellant

- Counsel of record 1: Attorneys Jordan und Dr. Hall, Karlsruhe;  
with the cooperation of: Patent Attorneys Samson & Partner,  
Widenmayerstrasse 5, Munich -

- Counsel of record 2: Attorneys Dipl.-Phys. Engel und Rinkler,  
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with the cooperation of: Patent Attorneys and Attorneys at Law Wagner &  
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Former intervenor of the Plaintiffs:

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Former Plaintiff 1:

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The 10<sup>th</sup> Civil Division of the Federal Court of Justice at the oral hearing of 14 October 2014 by order of presiding judge Prof. Dr. Meier-Beck and the judges Gröning, Dr. Bacher, Dr. Deichfuss, and Dr. Kober-Dehm

ruled as follows:

In response to the appeal by the Plaintiffs, the judgment pronounced on 1 December 2010 by the 5<sup>th</sup> Division (Nullity Division) of the Federal Patent Court is modified.

European patent 1 186 189 is fully revoked with effect on the Federal Republic of Germany.

The appeal by the Defendants is rejected.

The Defendants will bear the costs of the legal dispute with the exception of the out-of-court costs for the former intervenor and the added costs incurred by the change in plaintiff; the former Plaintiff 1 will bear these latter costs.

By law

Facts of the case:

The Defendant is the owner of European patent 1 186 189 (Patent in Suit) granted with effect on the Federal Republic of Germany which was filed on 15 February 2000 claiming priority of 8 March 1999 and relates to a method for allocating access rights to a telecommunications channel.

Patent claim 1 to which a total of 10 claims refer, and patent claims 2 and 11 have the following wording in the granted version:

"1. Method for allocating access rights to at least one telecommunications channel of a telecommunications network shareable by a plurality of subscriber stations to at least one subscriber station (5, 10, 15, 20) of the telecommunications network, wherein information signals are transmitted to the at least one subscriber station (5, 10, 15, 20) characterized in that with the information signals, access authorization data (45, 50, 55) on at least one subscriber station (5, 10, 15, 20) are transmitted, and that upon receipt of the access authorization data (45, 50, 55) in an evaluation unit (60) of the at least one subscriber station (5, 10, 15, 20) there is a test as to whether the access authorization data (45, 50, 55) comprise an access threshold value (S), wherein the access threshold value (S) is compared with a random number or a pseudo-random number (R), and that the access right to a telecommunications channel is assigned to the at least one subscriber station (5, 10, 15, 20) as a function of the comparison results.

2. Method according to claim 1 characterized in that in the evaluation unit (60) of the at least one subscriber station (5, 10, 15, 20) there is a test as to whether the access authorization data (45, 50, 55) comprise access authorization information (45, 50, 55) with access class information (S0, S1, S2, S3, S4, Z0, Z1, Z2, Z3) for at least one predefined user class (35, 40) wherein in this case and under the condition that the at least one subscriber station (5, 10, 15, 20) is assigned to the at least one predefined user class (35, 40), the access to at least one telecommunications channel is granted to the at least one subscriber station (5, 10, 15, 20) as a function of the access class information (Z0, Z1, Z2, Z3) for this user class (35, 40).

11. Subscriber station (5, 10, 15, 20), to which access to at least one telecommunications channel shareable by a plurality of subscriber stations can be granted, with means (65) for receiving information signals characterized in that an evaluation unit (60) is provided for testing with respect to access authorization data (45, 50, 55) received with the information signals whether the access authorization data (45, 50, 55) comprise an access threshold value (S), for comparison of the access threshold value (S) with a random number or a pseudo-random number (R), and for determining as a function of the comparison result whether access to the at least one telecommunications channel is approved for the at least one subscriber station (5, 10, 15, 20)."

The former Plaintiff 1 and Plaintiff 2 have asserted that the subject matter of the Patent in Suit is not patentable. The Defendant defended the Patent in Suit in a version containing only two patent claims of which the first combines the features of the granted version of the patent claims 1 and 2 and the second is analogously directed at a subscriber station which is suitable to execute the method according to the defended version of the first patent claim.

The Patent Court revoked the Patent in Suit to the extent that its subject matter goes beyond the version defended by the main motion at trial, and rejected the complaint in other respects. Both the Defendant and the Plaintiffs objected to this in their appeal. The Defendant defends the Patent in Suit with its main motion most recently in a version in which patent claim 1 in the version of the contested judgment is joined by eight related method claims and patent claim 10 directed at a subscriber station provides all features of the granted version of patent claim 11 and two other features related to the granted version of patent claim 2. With a total of six auxiliary motions, it further defends the Patent in Suit in versions modified again. The Plaintiffs continue to request the complete revocation of the Patent in Suit.

Former Plaintiff 1 and the new Plaintiff 1 further request that a change of parties be permitted. The Defendant consents to this.

The former intervenor of the Plaintiffs did not dispute the judgment at trial. In the course of the appeal proceedings, it declared withdrawal of its intervention with reference to an out-of-court settlement.

On behalf of the Division, Univ.-Prof. Dr.-Ing. Jochen H. Schiller, Freie Universität Berlin, prepared a written report which he has explained and supplemented in the oral hearing. The Defendant has submitted private expert opinions from Prof, Dr.-Ing. habil. Peter Jung, Universität Duisburg-Essen (QE9) and Dr. sc. techn. Heinz Ochsner (QE10).

Grounds of decision:

The admissible appeal by the Plaintiff is founded and results in the complete revocation of the Patent in Suit. The Defendants' appeal is unfounded.

I. The requested change in parties is permitted.

According to the case law of the Division, in the patent nullity proceedings a change in plaintiff is to be treated like a change in complaint, the admissibility of which is in principle based on the general rules of civil procedure law (Federal Court of Justice, judgment dated 28 June 1994 - X ZR 44/93, GRUR 1996, 865, 866 [change of parties]). Pursuant to section 533 German Code of Civil Procedure, therefore, it is a requirement that the Defendant give approval or the Division consider the change in plaintiff to be relevant and that the decision in the main matter be possible on the basis of the facts which the Division nonetheless has to adopt as a basis for its hearing and decision on the appeal.

These preconditions have been satisfied in the case in dispute. The Defendant approved the change in plaintiff. It has no influence on the decision in the main action.

II. The Patent in Suit relates to a method for allocating access rights to a telecommunications channel.

1. According to the statements in the specification of the Patent in Suit, methods for controlling access to a telecommunications channel were known in the prior art. The specification of the Patent in Suit cites as examples US patent 4 707 832 and the international patent application WO 97/19525 which both disclose methods in which a

control channel is used which is accessible for all connected subscriber stations and through which the assignment of data channels takes place to the individual network nodes or subscriber stations.

In the specification of the Patent in Suit, it is not expressly demonstrated which technical problem the invention concerns. Instead, the advantages of the method according to the invention are characterized. It is stated, among other things, that the proposed distribution of the access rights using a random number and a variable threshold value uses minimal transmission capacity and the test—referred to as particularly advantageous—using access class information makes it possible to allow subscriber stations to be used even if they would not be authorized for access due to the random distribution.

In light of this, the Patent in Suit concerns the technical problem of providing a method for allocating access rights in which the quantity of the transmitted data is low and which enables great flexibility in the allocation.

2. To solve this problem, the Patent in Suit in the version of patent claim 1 defended with the main motion at trial and at the appellate level, proposes a method, the features of which can be broken down as follows:

- 1.1 The method is used to allocate access rights to at least one telecommunications channel of a telecommunications network shareable by a plurality of subscriber stations to at least one subscriber station (5, 10, 15, 20) of the telecommunications network.
- 1.2 For this purpose, information signals are transmitted to the subscriber station (5, 10, 15, 20).

- 1.3 The information signals contain access authorization data (45, 50, 55).
  - 1.4 In an evaluation unit (60) of the subscriber station (5, 10, 15, 20), there is a test as to whether the received access authorization data (45, 50, 55) comprise an access threshold value (S).
  - 1.5 The access threshold value (S) is compared to a random number or a pseudo-random number (R).
  - 1.6 The access right of the subscriber station (5, 10, 15, 20) to a telecommunications channel is assigned as a function of the comparison results.
  - 1.7 In the evaluation unit, there is a test as to whether the access authorization data (45, 50, 55) comprise access authorization information (SO, S1, S2, S3, S4, ZO, Z1, Z2, Z3) with access class information (Z0, Z1, Z2, Z3) for at least one predefined user class (35, 40).
  - 1.8 In this case and under the condition that the subscriber station (5, 10, 15, 20) is assigned to a predefined user class (35, 40), the access to at least one telecommunications channel is granted as a function of the access class information (Z0, Z1, Z2, Z3) for this user class (35, 40).
3. The testing mechanisms that are defined in features 1.4 to 1.6 and features 1.7 and 1.8 have central importance.

a) Both of these feature groups provide two different methods to test whether a subscriber station receives access to the shared channel.

aa) The option presupposed in feature 1.4 of transmitting a variable threshold value, and the comparison of this value provided in feature 1.5 with a random number generated in the subscriber station make it possible to avoid overloading the shared channel. The higher or lower the predefined threshold value, the lower is the probability that a subscriber station will generate a random number above or below the threshold and will receive access to the shared channel. Additionally, as a consequence of recourse to a random number, all stations over time will receive an equal amount of access possibilities.

The option provided in feature 1.7 for transmitting access class information and the evaluation of this information provided in feature 1.8 likewise make it possible to limit access to the shared channel. Unlike features 1.4 to 1.6, however, access is not entirely or partially made dependent on chance, but rather on whether the subscriber station is assigned to a certain user class. This opens up the possibility of granting certain users priority access to the network, for example to make emergency calls or to guarantee communication among members of the police department.

bb) From features 1.4 to 1.8, it can be derived that both testing mechanisms must be available. This is confirmed by the embodiments characterized in the description of the Patent in Suit.

In the first embodiment, a data sequence of 10 bits is transmitted which contains either an access threshold value or access class information. The first bit of the data

sequence serves as an evaluation bit and displays the manner in which the following data are to be interpreted (paragraph 25, lines 37 to 42, paragraph 28 lines 18 to 25). With respect to this configuration, each individual data sequence is tested in each case only using one method. But the subscriber station must make both testing possibilities available because depending on the content of the evaluation sometimes one method and sometimes the other method is to be applied.

In the second embodiment, a data sequence of 13 bits is transmitted which contains both an access threshold value and access class information. For this, it is stated that users which belong to a corresponding user class could access the shared channel independent of the access threshold value and therefore if necessary without being evaluated while other users would have to go through the evaluation of the access threshold value (paragraph 36). The flowchart presented in Figures 4a to 4c and explained in the description (paragraph 39 ff.) corresponds to this. This shows that for a data length of more than 10 bits (Figure 4a, program point 200) at first the membership in a predefined user class is tested (Figure 4c, program point 280 and 285) and only subscriber stations which do not belong to any user group or which do not belong to the right user group, are subsequently submitted to a test using a transmitted access threshold value (Figure 4a, program point 210 and 215). For this configuration, the subscriber station must provide both testing possibilities.

b) The Patent Court has interpreted the version of patent claim 1 defended with the main motion such that at first a test using the access threshold value is to be conducted according to the Features 1.4 to 1.6 followed in all cases by a test using access class information according to Features 1.7 and 1.8. The allocation of an access right on the basis of the first test does not result

in ultimate access, but only in an option. The final decision is said to be made only upon the second test. In this test, users which have not received any access right in the first test are given a second chance.

c) This interpretation is incorrect.

As the Patent Court has not failed to recognize, it would mean that none of the embodiments characterized in the patent specification would be covered by the subject matter of the patent. An interpretation with such a result is not automatically excluded. But it would only come into consideration if other interpretive possibilities which result at least in the inclusion of a part of the embodiments necessarily are excluded or if the patent claim gave sufficiently clear indications that in fact something is claimed that deviates so widely from the description. Contrary to the opinion of the Patent Court in the case in dispute, this condition has not been satisfied. The patent claim instead—still— indicates with sufficient clarity that with the Features provided therein both the embodiments characterized in the description should be covered.

aa) Which of the two testing methods applies depends according to Features 1.4 and 1.7 on whether the received access authorization data comprise information of the kind relevant in each case—that is to say, an access threshold value or access class information.

bb) The Patent Court has rightly concluded that embodiments also belong to the subject matter of patent claim 1 in which the received access authorization data contain both an access threshold value and access class information.

Both Feature 1.6 and Feature 1.8 provide that the assignment of the access right or the granting of access depend on the information referenced in each case—that is to say, for Feature 1.6 the threshold access value and for Feature 1.8 the access class information. This does not indicate that each individual data sequence may contain only one of these two information units. Patent claim 1 contains no further specifications on the proportion in which the two testing events should exist if both information units are transmitted. In particular, it is not expressly determined what would take place if the one test results in affirming and the other denying an access right. It cannot be concluded from this however that such situations are to be avoided. The characterization of the second embodiment rather shows that these situations can be overcome by determining the sequence in which and the rules by which both information units are to be processed. Patent claim 1 does not necessarily provide the definition of such rules. But it also does not necessarily exclude the transmission of both information units in a data sequence. Therefore, it should be determined such that it comprises configurations which correspond to the second embodiment, and that it is left up to a person skilled in the art the sequence in which and the rules by which both information units are processed.

cc) Contrary to the opinion of the Patent Court, patent claim 1 should not be interpreted such that each received data packet must be tested always by means of both methods. Instead, it is sufficient if, using the transmitted data and predefined rules, the decision is made on which testing method should be used for the respective data packet.

The wording of patent claim 1, however, considered in isolation, could support the argument that the transmission of an information unit necessarily causes it to be used when testing the access right. But this would not result in a sufficient determination for the case where both testing methods are executed and lead to different results. This conflict could be triggered such that an access right is granted only if both testing methods lead to a positive result. Such a specification, however, cannot be inferred from patent claim 1. In addition, it would contradict the second embodiment in which a test takes place using the access threshold value only if an access right does not result already from the access class information units.

dd) Contrary to the opinion of the Patent Court, patent claim 1 does not indicate any specifications on the order in which the two tests are to be conducted.

Patent claims that concern a method in general, however, ought to be interpreted such that the method steps are to be completed in the stated order. But this principle in any case is granted an exception if sufficient indications of a differing understanding result from the further content of the patent specification to be consulted upon interpretation.

In the case in dispute, patent claim 1 provides two different testing methods which, depending on the individual case, may apply alternatively or cumulatively. The patent claim does not contain express specifications on the time sequence in the case of a cumulative application. For the single embodiment which concerns a cumulative application, as has already been demonstrated above, a test using access class information takes place first and only thereafter—and only when an access possibility has not already

resulted by means of the first test—a test using an access threshold value. Given all of this, patent claim 1 should be interpreted such that the time sequence in which Features 1.6 and 1.8 are implemented is irrelevant.

ee) Contrary to the opinion of the court expert and the private expert Prof. Dr. Jung, it is not absolutely mandatory that access be already granted when one of the two testing methods leads to a positive result.

Features 1.6 and 1.8, which state that the access right or access is granted "as a function" of the threshold value comparison or the access class information, as the case may be, could support the argument that it is sufficient for the granting of access if one of these two produces a positive result especially since such a procedure is described in the second embodiment of the Patent in Suit. Patent claim 1 in this respect, however, does not include any findings. In addition, the description of the Patent in Suit, as the High Court of Justice for England and Wales (Floyd J in *Nokia GmbH v ICom GmbH & Co. KG*, [2009] EWHC 3482 (Pat) margin no. 237) has correctly demonstrated, optionally provides that mobile stations, which on the basis of the test using the access threshold value are entitled to access, are subjected to another test using priority classes and only receive access when this test produces a positive result as well (paragraph 26). Patent claim 3 referring to this in the granted version of the Patent in Suit or patent claim 2 in the version of the Patent in Suit defended with the main motion likewise provides that the access is granted "as a function" of the comparison results. In light of this, this specification should be interpreted such that the result of each executed test must be incorporated into the decision about the granting of access, but the configuration of the rules definitive for this is left up to the person skilled in the art. This is not a matter of

"withdrawing" again granted access but rather that the granting of access depending on configuration of the method also can be a function of a plurality of successive tests having been successfully past.

ff) Contrary to the opinion of the Defendant, the fact that in Feature 1.6 the assignment of an access right is mentioned, but in Feature 1.8 the granting of the access is mentioned, cannot be used with sufficient clarity to infer that an additional test would be possible only for Feature 1.6, but not for Feature 1.8.

The different formulations in both features correspond to the wording of the description (paragraphs 5 and 7). In this context, the possibility of a further test using priority classes, however, is not yet mentioned. This is characterized in the following passages of the description (paragraph 8) and in the embodiment only for the case where a subscriber station is entitled to access due to the threshold value comparison. A corresponding limitation, however, is not even provided in the granted version of patent claim 3 which takes up this additional test. In light of this, patent claim 1 also cannot be interpreted restrictively such that another test after a successful test using the access class information is excluded.

gg) The test provided in Features 1.4 and 1.7 as to whether the transmitted data comprise an access threshold value or access class information relates to the question, as the court expert has correctly demonstrated, of whether such information is present.

(1) The differing opinion of the Defendant that it should be sufficient if there is a test as to whether the information in question should be considered in the decision on

granting access is only compatible with the wording of the patent claim with difficulty. It also contrasts with both embodiments characterized in the patent specification.

With respect to the first embodiment, only one of the two information units is always transmitted. Therefore, a test of whether information about the kind in question in each case is present is indispensable. The fact that this test is limited to the evaluation of an evaluation bit which displays the manner in which the following data are to be interpreted does not oppose this. This contains only a special configuration of a test for presence. By signaling that the following data are to be understood as an access threshold value or as access class information, it is expressed that the data contained information of the one or the other kind. The evaluation of this signal is therefore a test for the presence of corresponding information but not a relevancy test in the sense postulated by the Defendants.

With respect to the second embodiment, it is certain that a bit sample with a length of 13 bits always contains both types of information. But this embodiment comprises the test of whether the transmitted bit sample has a length of 10 bits or 13 bits (as the description expressly states, paragraph 39 column 11, lines 57 to column 12, line 6, Figure 4a, program point 200). With a 13-bit length, the additional test of an evaluation bit is not conducted. But this is only possible because the presence of both information units can be already concluded from the length of the bit sample. Therefore, as the court expert has confirmed, the length test already constitutes a test for presence. A relevancy test at most takes place for the access threshold value but not for the access class information which is always consulted as the first test standard.

(2) The Division cannot agree with the opinion of the High Court of Justice for England and Wales ([2009] EWHC 3482 (Pat) margin no. 234) that Feature 1.4 in arrangements in which all transmitted data sequences have the same sample is already fulfilled whenever there is a test as to whether the transmitted information should be used for the comparison with a determined random number.

The procedure described in the specification of the Patent in Suit may also be possible in arrangements in which only one uniformly structured bit sample is always transmitted containing both information units by definition. But this does not form a sufficient basis for giving importance to a feature provided in the patent claim which conforms neither with the embodiment characterized in the patent specification nor with the other content of the description. In light of this, Feature 1.4 cannot be interpreted such that in certain arrangements a test for presence and in other arrangements a test for relevance has to take place.

Nonetheless, this argument could in any case not succeed in connection with Feature 1.7, which the High Court of Justice did not address. In the second embodiment of the specification of the Patent in Suit, for a bit sample having a 13 bit length after the length test provided in program point 200 there is branching directly to program point 280 (paragraph 39, column 12, lines 1 to 4) which provides the test for whether the mobile station belongs to a certain user class (paragraph 39, column 12, line 57 to column 13, line 6). Insofar as this is the case, there is branching to program point 285 (paragraph 39 column 13 lines 10 to 14). There it is tested whether this user class on the basis of the received access class information is entitled to access (paragraph 39 column 13, lines 21 to 25). The test of whether the transmitted data contain access class information therefore consists merely of the length test, but not another test of whether this information should

be used for deciding on granting access. In light of this, it is far-fetched in any case for Feature 1.7 to interpret the test provided therein as a test for relevance. Instead, everything argues for the position of seeing in this a test for presence. A differing interpretation of Features 1.4 and 1.7, however, appears to be excluded not only due to matching wording but also because both features are similarly realized in the embodiment of the specification of the Patent in Suit.

(3) A different assessment does not result from the notion that a test for presence when using a single data structure which always contains both information units is not absolutely necessary. A patent claim can also comprise features that are not absolutely necessary to achieve the intended goal. The stated fact alone is also in principle not sufficient to give the relevant features a significance which differs from the meaning of the patent claim as is evident when taking into account the description and the drawings.

Whether a different assessment may be necessary in the individual case if the claimed method would not otherwise be reasonably executable can remain unanswered. In the present context, a test for presence—whether through the evaluation of bits provided for this purpose, whether through the test of the length—is also possible whenever the data structure is determined from the outset.

III. The Patent Court has explained the dismissal of the complaint essentially as follows:

The subject matter of patent claim 1—in the interpretation adopted by the Patent Court—is novel. The mobile radio standard GSM 04.60 submitted in the versions 6.1.0

(K 20) and 6.2.0 (K 4 and K 4a) describes a method for allocating access rights to a communications channel shared by a plurality of subscriber stations in which a test using a persistent threshold value and a test using information on user classes can be executed. From the described method sequence, a person skilled in the art will conclude that in advance of the actual assignment it is definitively decided whether the test is to be conducted based on the one or the other value by which the standard differs from the method according to the invention. In the additional citations, the subject matter of the Patent in Suit is likewise not anticipated.

The subject matter of patent claim 1 is said to be based on inventive step. In K 20 and K 4, an access method has already been disclosed to a person skilled in the art which has secured a preferred access by user classes. In light of this, there was no reason to convert this method into a graduated method with initial threshold value test and subsequent user class path. Other citations would have led a person skilled in the art away from the method according to patent claim 1 or in any case would not have suggested certain features.

IV. This assessment does not stand up to review in the appeal proceedings.

1. But the Patent Court has rightly regarded the subject matter of patent claim 1 in the version defended with the main motion as being novel.

a) Feature 1.7 is not disclosed in the specification GSM 04.60 V 6.2.0 (K 4a) published by the European Institute for Telecommunications Standards (ETSI).

aa) In K 4, a protocol for the access of mobile stations to a mobile radio network for transmission of data packets in the General Packet Radio Service (GPRS) is described.

In section 7.1, the structure of a connection (temporary block flow, TBF) is specified by the mobile station. In section 7.1.1, it is provided that the network sends a list of authorized access classes to all mobile stations and the access to the network is permitted if the mobile station belongs to at least one of these access classes. In section 7.1.2.1.1, it is determined that the mobile station listens to a specified channel on which information elements are sent with control parameters. These control parameters include a persistent value (Persistence\_Level), which can accept the values 0 to 16. Before any access attempt, the mobile station generates a random number between 0 and 15. It may send a request to structure a connection (packet channel request) if the sent persistence value is less than or equal to the generated random number. If the control parameters do not contain any persistence value, the value 0 should be used, the consequence being that the access is always permitted.

The structure of the control parameter information is further demonstrated in section 12.14, table 85. According to this, the transmission of a persistence value is optional. Whether such a value is contained in the information is displayed by an information element which can accept the values L (no persistence value) or H (persistence value present).

bb). Therefore, as the Patent Court has correctly decided in effect, Features 1.1 to 1.6 are disclosed.

(1) Contrary to the opinion of the Defendant, this is not opposed by the fact that in K 4 generating a random number and comparing it to a persistence value is provided even

for the case where a corresponding parameter is not transmitted.

Features 1.4 and 1.6 provide that a comparison be performed if it is evident based on a test that a persistence value has been transmitted. This is also determined in this way in K 4. If the control bit displays the transmission of a persistence value, it is used to carry out the comparison.

In the event that no persistence value is transmitted, Features 1.4 to 1.6 do not make any further findings. Therefore, a configuration is comprised in which in this case a comparison is performed and the comparison value is used which always results in the granting of access. Such a configuration, as the court expert has explained, nonetheless constitutes only one of several programming options for always granting access whenever a persistence value is not transmitted.

(2) Contrary to the opinion of the Defendant, a disclosure of Feature 1.6 should not be denied because K 4 leaves open the possibility of permitting a first access attempt of each mobile station independent of threshold value comparison.

It can remain unresolved whether Feature 1.6 comprises such configurations. The passage in K 4 consulted on this point by the Defendant and its private expert Dr. Ochsner (section 7.1.2.1.1, top of page 25) in any case does not indicate that the first access attempt would be permitted without prior threshold value comparison. In the first of the two relevant sentences, it is merely determined that for the first access attempt the first frame suitable for this (TDMA frame) may be used. In the very next sentence, it is stated that each access depends on the result of a threshold value test. This indicates, as

the court expert has accurately stated, that the first sentence concerns only the question of which transmission possibility may be used for the first access attempt, for the question of the criteria by which an access attempt is permitted, but does not include any divergence from the determinations that are expressly made for all access attempts in the following sentence.

cc) Feature 1.8 is likewise disclosed.

Contrary to the opinion of the Defendant, this is not opposed by the fact that the transmission of a list of access classes provided in K 4 and the subsequent granting or non-granting of network access concern not only the access of a specific channel, but also access to the network as a whole. Feature 1.8 does not make any further determinations as to whether the granting or non-granting of the network access refers only to individual channels or to the network as a whole. Therefore, the subject matter of patent claim 1 also comprises configurations in which the granting or denial of access refers to the network as a whole.

dd) But Feature 1.7 is not disclosed.

A test for the presence of access class information is not provided in K 4. As the court expert has confirmed, it is not necessary because this information is always an element of the transmitted data.

b) Feature 1.7 is likewise not disclosed in the prior versions of K 4 (GSM 04.60 V 6.1.0, K 20).

aa). As in K 4, it is already provided in K 20 to make access to the network dependent on the membership of the mobile station in an access class that is listed in a

transmitted list (section 7.1.1). The comparison between a random number generated by the mobile station and a transmitted persistence value follows (section 7.1.2.1.1).

Alternatively to this test step, a time-based access control is provided in which the mobile station delays the access attempt for a certain amount of time dependent on chance (section 7.1.2.1.2). The selection between these two methods is supposed to be controlled by parameters (RO\_PRI, K\_IJ) that are sent to all mobile stations (section 7.1.2.1) and which according to the list in section 12.14, table 101, are part of the control parameter information element.

In K 20, a priority class for packet access is provided as an additional control parameter. Packet access according to this is supposed to be permitted only if the mobile station belongs to unauthorized access class and if the packet to be transmitted belongs to a priority class the value of which is equal to or greater than the transmitted threshold value (section 7.1.1). In section 12.14, table 101, it is provided that either priority class information together with parameters for the time-based access control (TX\_INT, S) or a persistence value is transmitted. The first-named parameters are supposed to be dependent on the already mentioned parameters RO\_PRI and K\_IJ. The type of transmitted information is displayed by an information element which can have the conditions L and H.

bb) Therefore, as the Patent Court has also correctly decided on this point in effect, Features 1.1 to 1.6 are disclosed.

Contrary to the opinion of the Defendant, K 20 likewise discloses the test provided in Feature 1.4 for the presence of an access threshold value. Unlike with K 4, it is provided in K 20 that the comparison with a random number is carried out only if this is displayed through corresponding control parameters (RO\_PRI, K\_IJ, L/H). This is

comprised by Feature 1.4 and corresponds to the procedure in the first embodiment of the specification of the Patent in Suit. The fact that in K 20 the parameters (RO\_PRI, K\_IJ) are not further specified does not result in a different assessment because the Patent in Suit likewise does not provide further specification.

cc) Feature 1.8 is likewise disclosed.

The test provided in K 20 using user classes corresponds to the procedure disclosed in K 4. Therefore, Feature 1.8 is disclosed for the reasons demonstrated in connection with K 4.

dd) Feature 1.7 is not disclosed, and likewise for the reasons already demonstrated in connection with K 4.

In connection with the additional possibility for transmitting and evaluating priority class information, K 20 demonstrates a method which corresponds in its structure to the procedure established in Feature 1.7. A test of priority classes is provided in K 20 in fact only in the event that corresponding information is transmitted and this is displayed by an information element provided for that reason (L/H.). As the court expert has confirmed, however, this test does not refer to access classes for users, but rather to priority classes for data packets.

c) The Features 1.4 and 1.7 are not disclosed in the specification of the mobile radio standard TIA/EIA/IS-95-A (K 16).

aa) In K 16, a method for the access of a plurality of mobile stations on a shared channel is described.

According to this method, the mobile stations evaluate a message with access parameters sent from the base before transmitting. These are represented in section 7.7.2.3.2.2 and comprise seven different persistence values for a total of 16 classes of

mobile stations. These persistence values are compared by the mobile station with a random number RP determined by it. Access takes place only if this random number is less than a threshold value. A threshold value is calculated according to a fixed formula in which the persistence value for the class is incorporated to which the mobile station belongs (section 6.6.3.1.1.2, line 20 ff.). A threshold value can also accept the values 0 and 1, which results in the refusal or granting of access independent of the value of the random number.

bb) The Features 1.1, 1.2, 1.3, 1.5, 1.6 and 1.8 are therefore disclosed.

Access is always made dependent only on the result of a single comparison between a random number and a transmitted value. In effect, however, the access depends both on the transmitted value and the membership of the subscriber station in a certain user class because different values are transmitted for different user classes and they can be structured such that access is granted or denied to certain user classes independent of the value of the random number generated by the mobile station.

Contrary to the opinion of the Defendant, a different assessment does not result from the fact that K 16 for the calculation of the threshold value provides several different formulae that differentiate according to individual user classes and the reason of the access attempt (registration, message transmittal, other reason). As the court expert has correctly stated, notwithstanding this differentiation, it is always a matter of the access to the same channel. The fact that the fine gradation provided in K 16 results in a great degree of complexity is irrelevant because patent claim 1 does not make any further determinations either with respect to length or with respect to the complexity of the transmitted information.

cc) The Features 1.4 and 1.7 are not disclosed.

The transmission of seven persistent values for different user classes is always necessarily provided in K 16. A test for the presence of corresponding specifications is therefore not required. It is also not disclosed in K 16.

2. Contrary to the opinion of the Patent Court, the subject matter of the version of patent claim 1 defended with the main motion is not based on inventive step.

a) From the mobile radio standard disclosed in K 4 and K 20 (GSM 04.60), a person skilled in the art, the Patent Court's definition of which the parties do not doubt, was able to infer methods in which the granting of access rights is made dependent on a threshold value comparison, the membership in the specified user classes and—in K 20—the membership in a priority class. From K 20, he was also able to infer that with the assistance of a corresponding information element it is possible to display whether the transmitted data comprise information on priority classes.

This gave the person skilled in the art tasked with developing a flexible assignment method implementable with low data quantities reason to provide corresponding information elements also for other information units which are transmitted only in specified arrangements or are to be used for the assignment.

b) Contrary to the opinion of the Defendant, a person skilled in the art had reason to also consult earlier versions in addition to the version current on the priority date.

The fact that a solution was demonstrated only in an earlier version of the standard but was not pursued in a later version does not automatically mean that this path should be regarded as non-obvious. Such a conclusion may come into question if a more

recent version of the standard demonstrates a better, more elegant, or a simpler solution for a certain technical problem. The contemplations that have resulted in the change to a standard, however, as the court expert has confirmed, do not necessarily have to occur in the technical field. Even if technical contemplations were determinative, this also does not rule out again considering the rejected solution if the starting conditions have changed.

In the present context, the person skilled in the art was already able to infer from K 20—just like other mobile radio standards, e.g. K 16 (IS-95-A)—that the question of the criteria according to which access rights should be granted may depend on numerous factors. This includes not only technical aspects such as the receptivity of the respective channel or the network as a whole, but also, for example, the requirement of granting certain groups of users or certain communications events increased priority. The stated standards further indicated that not every criterion which may be relevant to the assignment is actually relevant in every situation. This gave a person skilled in the art reason to consider the possibility, disclosed in K 20 information on priority classes, of displaying their presence by means of a certain information element for other information units as well. Therefore, Feature 1.7 not disclosed in K 20 was suggested.

c) The decision submitted by the Defendant by the British courts ([2011] EWHC 1470 (Pat), BB6; [2012] EWCA Civ 567, QE13) and the Opposition Division of the European Patent Office (QE12) dated 11 February 2014 (QE12) on European patent 1 841 268 and the ruling from the German Patent and Trademark Office of 6 March 2013

(QE11) on the German patent 199 10 239 with respect to the version of patent claim 1 defended with the main motion do not lead to a different assessment because the subject matter of those patents diverges from the subject matter of this claim.

The patents to be judged in those proceedings, by further specification of Feature 1.8, provide that the information about the access classes are used as a criterion for whether a mobile station automatically receives access or whether it must undergo an additional test using the access threshold value. As has already been demonstrated above, this determination is not evident from Feature 1.8 in the version of the Patent in Suit defended with the main motion. Without this restriction, the subject matter of the Patent in Suit—as the British courts have also decided in effect ([2009] EWHC 3482 (Pat) margin no. 254 ff.; [2012] EWCA Civ 567 margin no. 155)—in any case is not patentable.

3. The situation is no different for the version of patent claim 1 defended with auxiliary motion 0a.

According to auxiliary motion 0a, patent claim 1 is supposed to be directed at the protection of a subscriber station which contains, among other things, an evaluation unit that makes it possible to test whether the received access authorization data contain an access threshold value and access authorization information, and to approve access as a function thereof.

A subscriber station with this suitability is likewise suggested by the prior art. If a person skilled in the art had reason to develop a method with the features according to patent claim 1 in the version of the main motion, this also gave him reason to configure mobile stations such that they can execute this method. Particular difficulties that could

appear here and which are considered by the Features of the patent claim have not been asserted nor are they otherwise evident.

4. The subject matter of patent claim 1 in the version defended with auxiliary motion 1 is likewise not patentable.

According to auxiliary motion 1, patent claim 1 in Feature 1.8 is to be augmented such that the access is granted as a function of the access class information and independent of the access threshold value insofar as the received access authorization data receive access class information for at least one user class and the mobile station belongs to this user class. Even with this augmentation, the subject matter of patent claim 1 is suggested by the prior art.

a) From the mobile radio standard disclosed in K 4 and K 20 (GSM 04.60), a person skilled in the art nonetheless could not infer any method in which an access right is granted to mobile stations that are assigned to a preferred user class independent of any threshold value comparison. The membership in a certain user class, instead, according to the method disclosed there is a necessary precondition so that a mobile station may even execute a threshold value comparison.

With the possibility of transmitting information about priority classes and parameters for time-based access control instead of a persistence value, a method is nonetheless already disclosed in K 20 for which access is granted to the mobile stations for transmitting certain data packets, to which a higher priority is given, independent of any threshold value comparison. For a person skilled in the art it was evident from this that the access control with the assistance of a threshold value comparison did not necessarily result in subjecting each access attempt to this restriction.

b) The person skilled in the art tasked with further development moreover had reason to address the access control in other mobile radio standards. Here he could infer from K 16 (IS-95-A) a method that makes it possible to assign to various user groups in a finely granular manner a different persistence value and to define this in the individual case so that access is always or never granted to certain user groups.

For the method disclosed in K 16, a threshold value comparison is always formally conducted. But for the person skilled in the art it was discernible that this involves only the programming implementation of an access concept which makes the access dependent both on the persistence value and the assignment to user classes and provides the possibility of granting or denying access to certain user classes independent of the value of the generated random number.

A similar implementation is already disclosed in K 4 where it is provided on the one hand that a threshold value comparison is always performed but the specification of the threshold value 0 or the non-transmittal of a threshold value in effect means that the comparison is positive for all mobile stations. As the court expert has confirmed, this is likewise only a special programming configuration of the specification to grant access to the mobile stations in certain cases independent of the value of the determined random number.

c) By looking at K 4 and K 20 together, there was sufficient reason for the person skilled in the art to further develop the method disclosed in K 4 such that the granting of access with respect to membership in a certain user class does not additionally depend on the result of a threshold value comparison.

This is not opposed by the fact that in K 4 such a configuration was not provided. As has already been demonstrated, the fundamental methods to make the granting of access rights, depending on situation, dependent on various criteria were already disclosed in K 4 and K 20. These methods included enabling access for certain data packets on the basis of the membership in a priority class and independent from a threshold value comparison. Given the similarities between a prioritization of data packets and a prioritization of user classes, it was therefore suggested to the person skilled in the art to use these methods also for prioritizing user classes. Therefore, he had at his disposal a complete set of tools to avoid overloading the network and nonetheless give preferential treatment to individual user classes. The selection from this set of tools, as the court expert has confirmed, largely depends on organizational questions, in particular the user classes to which the network operator wants to grant special rights. In light of this, the selection of a certain method from the—easily understandable—number of all possibilities suggested by K 4 and K 20 cannot result in the assumption of inventive step.

d) The decisions submitted by the Defendant from the British courts also in this context do not lead to a different assessment.

In these decisions, inventive step was affirmed with the contemplation that it was not obvious to a person skilled in the art to modify the method disclosed in K 4 such that mobile radio stations which belong to a certain user class are exempt from the test using a persistence value ([2011] EWHC 1470 (Pat) margin no. 68 ff.). But this assessment concerns an argument which is solely based on K 4. The Division's different opinion, by

contrast, is based on the citation K 20 to be considered additionally in the case in dispute.

e) The fact that in K 4 a specified method was already provided for the allocation of access rights and the aspect of backward compatibility is of major significance in the continued development of a standard likewise does not lead to a different assessment.

The person skilled in the art who has the task of further developing a solution known in the prior art has reason to be guided by common standards. But this does not form a sufficient basis to refrain from any change to the standard.

5. The situation is the same for the versions of patent claim 1 defended with the other auxiliary motions.

a) According to auxiliary motion 1a, patent claim 1 is supposed to be directed toward protecting a subscriber station with an evaluation unit which can execute the method claimed with auxiliary motion 1. For the reasons already demonstrated in connection with auxiliary motion 0a, this subject matter is not patentable because the method in question was suggested by the prior art.

b) According to auxiliary motion 2, patent claim 1 in the version of auxiliary motion 1 in Feature 1.3 is supposed to be augmented such that the access authorization data (always) contain an access threshold value and access class information for user classes. Therefore, embodiments according to the first embodiment of the specification of the Patent in Suit are excluded from protection.

The subject matter claimed thereby is suggested by the prior art for the reasons demonstrated in connection with auxiliary motion 1.

The question additionally raised with the change of Feature 1.3 as to whether, of several parameters that may be significant for the granting of an access right, all are always transmitted within a single data sequence or whether the transmitted data sequence in certain situations contains only a partial quantity of these parameters is essentially a question of expediency. The representation of the two embodiments in the specification of the Patent in Suit is based on this premise. In the description of the Patent in Suit it is even called preferable to provide a method which optionally can handle both types of bit sequences. Indications that, notwithstanding, suggest that particular importance is attached to the selection between these two possibilities are neither asserted nor evident.

c) According to auxiliary motion 2a, patent claim 1 is supposed to be directed toward the protection of a subscriber station with devices that are configured to execute the method claimed with auxiliary motion 2. On this point, the same applies as with the auxiliary motions 0a and 1a.

d) According to auxiliary motion 3, patent claim 1 in the version of auxiliary motion 2a is to be modified such that the evaluation unit using the access class information tests whether the subscriber station is given access independent of the access threshold value or whether the access authorization must be granted to the execution of the threshold value comparison.

The further specification of the method claimed with auxiliary motion 1 contained in this does not result in a different assessment with respect to inventive step.

As has already been demonstrated in connection with auxiliary motion 1, the person skilled in the art on the priority date had reason to configure a method for access control so that mobile stations which belong to a certain user class are granted access

independent of the result of a threshold value comparison. Whether this involves refraining from a threshold value comparison from the outset or whether the comparison is executed with a value that always leads to a positive result is, as has likewise already been demonstrated, essentially a question of expedient implementation. In light of this, settling on one of a plurality of variants cannot substantiate the affirmation of inventive step.

V. The decision on costs is based on section 121 (2) Patent Act and section 91, section 96 and section 269 (3) German Code of Civil Procedure.

1. The costs of the former intervenor, which withdrew its intervention during the appeal proceedings, are not to be imposed on the Defendant since it reached a different agreement with the intervenor.

2. The former Plaintiff 1 has to bear the added costs incurred by the change in parties according to section 269 (3) German Code of Civil Procedure.

a) The costs to be borne accordingly in any case include the added costs incurred because its counsel of record represented both the former as well as the current Plaintiff 1 (see Federal Court of Justice, ruling of 19 October 2006 -V ZB 91/06, NJW 2007, 769 margin no. 12 ff.). Whether separate added costs were additionally incurred may have to be decided in the proceedings to determine costs.

b) Contrary to the opinion of the Defendant, the former Plaintiff 1 does not also have to bear the share of the costs which would have to be imposed on it in the case of a withdrawal of complaint.

The opinion stated by the Defendant is nonetheless shared by a portion of the case law and the scholarly literature (see for instance Higher Regional Court of Brandenburg,

MDR 2004, 842; Higher Regional Court of Stuttgart, NJW 1973, 1756; Zöller/Herget, 30<sup>th</sup> ed., § 91 ZPO margin no. 13 [change of parties]).

According to the dissenting opinion, the departing Plaintiff by contrast only has to bear the added costs incurred as a result of the change in parties (BPatG, GRUR 1994, 607, 608; Higher Regional Court of Celle, OLGReport 1994, 270 f.; Higher Regional Court of Düsseldorf, MDR 1974, 147; Higher Regional Court of Hamm, MDR 2007, 1447 f.; Higher Regional Court of Munich, MDR 1971, 673; Higher Regional Court of Zweibrücken, JurBüro 2004, 494, juris margin no. 3). The Federal Court of Justice, albeit only incidentally, already agreed with this opinion in earlier decisions (Federal Court of Justice, judgment dated 11 November 1979 - I ZR 13/78, WM 1980, 164, juris margin no. 40; judgment dated 3 July 1981 - I ZR 190/80, ZIP 1981, 1220, juris margin no. 39). It is correct in the opinion of the Division.

As has already been demonstrated above, a change in parties should be treated in principle not as a withdrawal of complaint, but rather as an amendment of complaint. An amendment of complaint, however, does not automatically lead to application of section 269 (3) German Code of Civil Procedure.

In the event of a change in defendant proceeding from the Plaintiff, the Plaintiff nonetheless has to bear the costs incurred by the departing defendant up to the point of its departure in accordance with section 269 (3) German Code of Civil Procedure (Federal Court of Justice, decision dated 19 October 2006 – V ZB 91/06, NJW 2007, 769 margin no. 7; judgment dated 16 December 2005 - V ZR 230/04, NJW 2006, 1351 margin no. 24). In this case, the duty to bear costs however likewise refers only to added costs which would not have been incurred without the change in parties. The new defendant, by contrast, in principle has to bear the court costs and out-of-court costs of the Plaintiff to the extent that the defendant does not prevail. Nothing else can be true of the case concerning a change in plaintiff to be judged here.

The perspective that it should not be possible for a plaintiff fearing defeat to evade the defendant's claim to reimbursement of the trial costs as a result of a change in

parties does not lead to a differing assessment. Whether the prospects of the defendant to be compensated for the trial costs in the event of prevailing will be impaired by a change in plaintiff is a question of the individual case (correctly, Higher Regional Court of Celle, OLGReport 1994, 270, 271). In so far as there are concerns on this point, this may result in a change in plaintiff being regarded as irrelevant in order to protect the defendant from possibly losing its claim to reimbursement. However, it seems excessive to award the defendant a claim to reimbursement solely due to the change in plaintiff even in the event that it fails in the main action.

3. Contrary to the opinion of the Defendant, the fact that the complaints were originally filed independently of each other and the Patent Court therefore set the full court fees for both proceedings at trial has no impact on the decision on costs.

a) As the Defendant does not even remotely fail to recognize, the costs of the legal dispute can only be distributed among the parties according to the provision in section 91 and section 92 German Code of Civil Procedure which is accordingly applicable pursuant to section 121 (2) Patent Act in the patent nullity proceedings.

b) A decision that the court costs should not be collected entirely or partially is only possible pursuant to section 21 (1) sentence 1 Court Costs Act if the costs in question had not been incurred if the matter had been handled properly.

These preconditions have not been satisfied in the case in dispute. The Patent Court has rightly dealt with both complaints in separate proceedings.

Plaintiff 2 stated in its statement of complaint of 11 November 2008 that Plaintiff 1 already filed a nullity action against the Patent in Suit in the brief of 19 August 2008. It

did not join this complaint but rather filed a separate complaint. It later even raised concerns about the intention expressed by the Patent Court to combine the two proceedings into the joint hearing and decision, and based this on possible interactions and the fact that the two complaints at least partially are based on differing prior art. In light of this, the Patent Court had no reason to treat the two complaints from the beginning in a single proceeding for which court fees are incurred only once.

c) The objection made by the Defendant that the Plaintiffs behaved abusively in order to increase the risk of costs may be of significance in the proceedings to determine costs (see Federal Court of Justice, ruling of 20 May 2014 - VI ZB 9/13, GRUR 2014,

709 margin no. 6; ruling of 18 October 2012 - V ZB 58/12, NJW-RR 2013, 337 margin no. 8 ff.; ruling of 11 September 2012 - VI ZB 59/11, NJW 2013, 66 margin no. 8 ff.). Conversely, it is irrelevant to the decision on the reason for costs.

Meier-Beck

Gröning

Bacher

Deichfuss

Kober-Dehm

Lower court:

Federal Patent Court, decision of 1 December 2010 - 5 Ni 67/09 (EU) -