Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2018-03-27
Docket Number / Aktenzeichen:	X ZB 18/16
Name of Decision / Name der Entscheidung:	Feldmausbekämpfung

FEDERAL COURT OF JUSTICE

ORDER

X ZB 18/16

of

27 March 2018

in the appeal proceedings

Feldmausbekämpfung/
Field mouse control

Utility Model Act Sec. 2 Nr. 3, Sec. 8(1); German Constitution Art. 14(1) A, Art. 3(1)

a) In utility model registration proceedings, the utility model authority shall examine whether one of the grounds for refusal listed in Sec. 2 Utility Model Act applies.

b) The exclusion of utility model protection for proceedings is in accordance with Art. 14(1) and Art. 3(1) German Constitution.

Federal Court of Justice, judgment of 27 March 2018 – X ZB 18/16 – Federal Patent Court

ECLI:DE:BGH:2018:270318BXZB18.16.0

The X. Civil Senate of the Federal Court of Justice on 27 March 2018, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Bacher and Hoffmann as well as the judges Dr. Kober-Dehm and Dr. Marx,

ordered that:

> The appeal against the order of the 35. Senate (Utility Model Appeal Senate) of the Federal Patent Court of 6 September 2016 is dismissed.

Grounds of the order:

1 A. The applicant filed utility model application 21 2012 000 187.5, which arose from an international application filed on 11 October 2012, claims priority from a German application filed on 11 October 2011, and concerns the control of field mice. Claims 1 to 3 for protection read:

> 1. A method for controlling field mice, comprising the following steps:
>
> (a) a field mouse bait station (10) is formed in a tubular shape;
>
> a1) the tube (12) being open at both ends (14) to allow entry of field mice;
>
> b) the tube (12) is formed of a biodegradable material;
>
> c) at least one grain of poison wheat (20) is fixed centrally inside the tube (12) of the field mouse bait station (10);
>
> c1) wherein the grain of poisonous wheat is fixed by means of a waterproof adhesive in such a way that vibrations cannot loosen this adhesive; and
>
> d) by means of a throwing process, the field mouse bait station (10) is applied to the surface of an agricultural area infested by field mice.
>
> 2. Method according to the preceding claim; characterized in that instead of a poison wheat grain (20), a mixture of a bait substance (18) and a poison lens (20) is used.
>
> 3. Method according to any one of the preceding claims, characterized in that the throwing operation is carried out over a distance of up to 12 m or up to 15 m.

2 Further claims 4 to 19 relate to a field mouse baiting station.

3 The utility model office rejected the application. In the appeal proceedings, in which the President of the Patent Office intervened, the applicant pursued his request and, in the alternative, requested that the matter be referred to the Federal Constitutional Court for a decision with regard to Sec. 2 No. 3 Utility Model Act. The Patent Court rejected the appeal. The applicant challenges this with the appeal on points of law admitted by the Patent Court.

4 B. The appeal is admissible, but unfounded.

5 I. Despite the limitation pronounced by the Patent Court, the contested order is subject to full legal review.

6 According to the established case law of the Federal Court of Justice, the admissibility of an appeal on points of law in patent and utility model cases may be limited to a separable part of the subject matter of the proceedings or to individual parties to the proceedings (Federal Court of Justice, order of 30 October 2007 X ZB 18/06, GRUR 2008, 279 marginal no. 8 - Kornfeinung; order of 17 July 2012 - X ZB 1/11, GRUR 2012, 1243 marginal no. 4 - Feuchtigkeitsabsorptionsbehälter). However, the limitation of the admission to a single legal question is not admissible and therefore null (Federal Court of Justice, order of 15 March 1984 X ZB 6/83, BGHZ 90, 318 = GRUR 1984, 797 - Zinkenkreisel).

7 In the case in dispute, the Patent Court allowed an appeal on points of law as to whether Sec. 2 No. 3 Utility Model Act is compatible with Art. 14(1) and (2) German Constitution, with Art. 3(1) German Constitution and with the European Convention on Human Rights. This restriction relates to individual legal questions. It is therefore null. The right of appeal is therefore unrestricted.

8 II. The Patent Court essentially justified its decision as follows:

9 The utility model office was allowed to examine in the registration procedure whether one of the grounds for refusal under Sec. 2 Utility Model Act exempts the requirements of novelty, inventive step and industrial applicability from examination in the registration procedure, and from the purpose of Sec. 2 Utility Model Act.

10 The utility model office had rightly rejected the application because it comprised a process which was excluded from utility model protection under Sec. 2 No. 3 Utility Model Act. A registration limited to claims 4 to 19 does not correspond to the applicant's request.

11 Sec. 2 No. 3 Utility Model Act was a permissible content provision within the meaning of Art. 14(1) sentence 2 German Constitution, which was also compatible with the general principle of equality of Art. 3(1) German Constitution. The provision did not affect the core area of the property guarantee. Patent law already granted complete property protection for process inventions. For the remaining area, the protection of the constitution of property,

the legislature had considerable leeway. This was all the greater in the present context, because legal provisions in the field of intellectual property always affected the fundamental principle of the free movement of goods and services. Against this background, the explanatory memorandum to Sec. 2 No. 3 Utility Model Act continues to provide useful considerations.

12 The provision was also not in conflict with Article 3(1) German Constitution. The legislature's scope of discretion is only exceeded if its decision appears to be simply arbitrary. In view of the considerations set out in the explanatory memorandum to the Act, this condition is not met.

13 III. This assessment stands up to legal review.

14 1. The Patent Court correctly assumed that in the registration procedure, and thus also in subsequent appeal and appeal proceedings, it must be examined whether one of the grounds for refusal listed in Sec. 2 Utility Model Act applies.

15 Sec. 8(1) Utility Model Act does not expressly provide for such an examination. However, from the fact that Sec. 8(1) sentence 2 Utility Model Act only excludes an examination of the subject matter of the application for novelty, inventive step and industrial applicability, it must be concluded that the existence of the further substantive requirements must be examined. This is also in line with the purpose of Sec. 2 Utility Model Act, as the Patent Court correctly pointed out.

16 2. The Patent Court rightly decided that the subject matter of claims 1 to 3 is excluded from utility model protection under Sec. 2 No. 3 Utility Model Act because it concerns a process.

17 a) According to the statements in the application, poisonous lentils and poisonous wheat with the active ingredient zinc phosphide are approved for the control of field mice according to Directive 2010/85/EU, however, under the condition that the bait is applied covertly. In the state of the art, grains enriched with poison would have to be applied to the mice holes by workers using special laying guns, and these would have to be kicked shut with the foot. This is time-consuming and expensive and difficult to carry out in wet soil conditions.

18 Against this background, the application addresses the technical problem of providing simple and cost-effective control of field mice.

19 b) To solve this problem, the application proposes in claim 1 a method, the features of which can be divided as follows:

> The method serves to control field mice and comprises the following steps:
>
> 1. A field mouse bait station (10) is designed in the form of a tube.
>
> 1.1 The tube (12) is open at both ends (14) to allow entry of field mice, and
>
> 1.2 is formed of a biodegradable material.
>
> 2. At least one grain of poisonous wheat (20) is fixed centrally inside the tube (12) by
>
> 2.1 by means of a waterproof adhesive, and
>
> 2.2 in such a way that vibrations cannot loosen this adhesive.
>
> 3) The field mouse bait station (10) is applied to the surface of an agricultural area infested by field mice by means of a throwing process.

20 c) The solution thus claimed is a process within the meaning of Sec. 2 No. 3 Utility Model Act.

21 aa) The term "process" used in Sec. 2 No. 3 Utility Model Act corresponds to the conventional definition in connection with technical property rights, which is also the basis of Sec. 9 No. 3 Patent Act. This includes in particular working processes and manufacturing processes (Federal Court of Justice, order of 17 February 2004 - X ZB 9/03, BGHZ 158, 142, 148 f. = GRUR 2004, 495, 497 Signalfolge; order of 5 October 2005 - X ZB 7/03, BGHZ 164, 220 = GRUR 2006, 135 marginal no. 9 - Arzneimittelgebrauchsmuster). In the case of manufacturing processes, the technical action teaching consists of the description of the two actual process measures, namely the choice of starting materials and the type of action on these materials (Federal Court of Justice, order of 11 July 1985 - X ZB 26/84, BGHZ 95, 295, 296 et seq. = GRUR 1986, 163 - Boron-containing steels).

22 bb) Against this background, claims 1 to 3 are directed to a manufacturing process.

23 It is true that feature groups 1 and 2 predominantly define characteristics of the bait station. Nevertheless, protection is not claimed for a product with these properties, but for a process by which such a product is manufactured by selecting the specified starting materials by means of the specified steps. Thus, it is a manufacturing process.

24 In view of this, it can be left open whether feature 3 in itself also relates to an individual step of a manufacturing or processing method or merely aims at an abstract result of action, as is typical for use claims (see Federal Court of Justice, order of 5 October 2005 - X ZB 7/03, BGHZ 164, 220 = GRUR 2006, 135 marginal no. 10 - Arzneimittelgebrauchsmuster). Classification as a claim relating to the use of a product would require that the other features also relate to a product or its use. In the case in dispute, however, feature groups 1 and 2 concern a process. The additional objective provided in feature 3 cannot change this classification, but at most limit the extent to which the process is protected.

25 Whether the applicant could instead also claim protection for a product or its use is not relevant in this context. If different possibilities are open to the applicant according to the nature and scope of the disclosed technical teaching, he may determine the category he wishes (Federal Court of Justice, order of 11 July 1985 - X ZB 26/84, BGHZ 95, 295, 297 = GRUR 1986, 163 - Boron containing steels).

26 3. The Patent Court rightly concluded that Sec. 2 No. 3 Utility Model Act is not unconstitutional on this understanding.

27 a) Contrary to the opinion of the appeal, Sec. 2 No. 3 Utility Model Act is in conformity with Art. 14 German Constitution.

28 aa) The Patent Court correctly assumed that Sec. 2 No. 3 Utility Model Act contains a provision on the content and limitations of the right to an invention which qualifies as property within the meaning of Art. 14(1) German Constitution.

29 The provision does not provide for expropriation within the meaning of Art. 14(3) German Constitution. Rather, it regulates the conditions under which an invention is eligible for utility model protection.

30 bb) The Patent Court rightly came to the conclusion that the legislator did not exceed the scope for assessment and design to which it was entitled.

31 (1) According to the established case law of the Federal Constitutional Court, the legislature shall have a discretionary power of assessment and design in regulating the content and limits of property. However, the legislature must take into account the core of the right to property, which is protected by the German Constitution. In the case of intellectual property rights, the constituent features include the fundamental allocation of the pecuniary result of the intellectual performance to the beneficiary by way of private-law standardization and his freedom to dispose of it on his own responsibility. The property guarantee, on the other hand, does not require that every conceivable economic exploitation possibility be assigned to the right holder (for copyright: Federal Constitutional Court decision (BVerfGE) 31, 248 = GRUR 1972, 485, 486; Federal Constitutional Court decision (BVerfGE) 77, 263 = GRUR 1998, 687, 689; for the right to inventions: Federal Constitutional Court (BVerfGE) 36, 281 = GRUR 1974, 142, 144).

32 (2) The provision in Sec. 2 No. 3 Utility Model Act meets these requirements.

33 (a) Sec. 2 No. 3 Utility Model Act does not affect the core of the property right in an invention relating to a process.

34 As the Patent Court correctly pointed out, an inventor who claims protection for a process is not deprived of rights. He can obtain protection by a German or European patent in accordance with the relevant provisions (cf. Federal Court of Justice, order of 17 February 2004 - X ZB 9/03, BGHZ 158, 142, 148 = GRUR 2004, 495, 497 Signalfolge). The exclusion from utility model protection provided for in Sec. 2 No. 3 Utility Model Act thus only leads to the fact that the legal position of the inventor is restricted with regard to certain aspects. Thus, the owner of a patent can assert rights against third parties only

after substantive examination and grant of the property right, which typically takes more time than the examination, which is essentially limited to formal aspects, that precedes the registration of a utility model. In addition, the grace period provided for in Sec. 3(1) sentence 3 Utility Model Act does not apply to patents with regard to the applicant's own descriptions or acts of use.

35 These regulations do not affect the core of the property right. They merely exclude an inventor seeking protection for a process from individual possibilities of exploitation.

36 (b) These restrictions are justified by the conflicting interests of the legal system, which the legislator has taken into account with Sec. 2 No. 3 Utility Model Act.

37 As the Patent Court explained in detail, the exclusion of utility model protection for proceedings serves legal certainty. This is generally affected by the registration of a utility model, because the applicant is thereby formally enabled to assert rights against third parties without it having been verified whether the substantive requirements for protectability - novelty, inventive step and industrial applicability - are met. The resulting risk that third parties are materially unjustly impeded in their economic activity protected by Art. 12(1) German Constitution tends to be higher in the case of rights directed to the protection of processes, because these typically cannot be described on the basis of drawings or chemical formulae, but only verbally (cf. BT-Drucks. 11/5744, p. 33). This justifies the decision of the legislator to provide protection for processes only in accordance with the Patent Act and the European Patent Convention.

38 The fact that utility model applications directed to protection for a product or use do not necessarily have to contain a drawing or a chemical formula and that at least certain processes are amenable to a graphic representation in the form of a flow chart or the like does not lead to a different assessment. The abstract and general provision in Sec. 2 No. 3 Utility Model Act is already justified by the fact that the description of a process in typical situations is not possible with the same precision as that of a product or a use and therefore the

dangers resulting for legal transactions are typically greater in the case of a utility model directed to protection for a process.

39 (c) Contrary to the opinion of the appeal on points of law, the changes that have occurred since the decision of the legislator in 1990 also do not lead to a different assessment.

40 According to the case law of the Federal Court of Justice, the fact that the use of a product is eligible for utility model protection is based on the circumstance that such use cannot be equated with a manufacturing or working process, but is exhausted in an abstract result of action (Federal Court of Justice, order of 5 October 2005 X ZB 7/03, BGHZ 164, 220 = GRUR 2006, 135 marginal no. 10 - Arzneimittelgebrauchsmuster). In the meantime, the legislator has taken this into account by stating that the use of a product can at least be subject to limited substance protection if it serves the surgical or therapeutic treatment of the human or animal body or a diagnostic procedure on the human or animal body (Sec. 3(3) and (4) Patent Act; see Federal Court of Justice, order of 25 February 2014 - X ZB 5/13, BGHZ 200, 229 = GRUR 2014, 461 marginal no. 15 et seq. - Kollagenase I).

41 The fact that advances in the field of information technology have opened up extended possibilities for searching for patents and utility models may mean that a third party wishing to use or market a certain process is more easily able to find property rights that may conflict with this intention. However, this does not eliminate the uncertainty as to how far the scope of protection of a found right extends and whether its subject matter meets the substantive requirements for protectability.

42 b) Contrary to the opinion of the appeal on points of law, Sec. 2 No. 3 Utility Model Act does not violate Art. 3(1) German Constitution.

43 aa) In view of the special features already pointed out in connection with Art. 14(1) German Constitution, it is objectively justified to exclude applications directed to protection for a process from utility model protection.

44 Contrary to the opinion of the appeal, this differentiation does not lead to unequal treatment of individual groups of inventors. Whether an invention is

eligible for protection as a product or use or for protection as a process does not depend on the person of the inventor, but on the subject matter of the invention. Moreover, as the dispute vividly illustrates, in many cases an inventor has a choice as to which category of protection he claims.

45 Sec. 2 No. 3 Utility Model Act therefore only leads to a restriction of the possibilities of exploitation also under this aspect. This is objectively justified in the interest of legal certainty for the reasons already cited in connection with Art. 14(1) German Constitution.

46 bb) Against the background shown, it is also objectively justified to assess applications directed to patent protection for a process differently from applications directed to corresponding utility model protection.

47 The described difficulties in defining a process also exist in connection with patents. There, however, the interest of legal certainty is additionally taken into account by the fact that the grant - and thus the grant of a legal position enabling the applicant to claim third parties from the property right - only takes place after a substantive examination. In the course of this procedure, the examiner can, if necessary, work towards clarifications that enable a sufficient delimitation from the state of the art. An application which does not meet these requirements shall be rejected.

48 4. If Section 2 No. 3 Utility Model Act proves to be constitutional after all, it is neither necessary nor permissible to interpret the provision by way of constitutional interpretation contrary to its wording and its meaning and purpose.

49 IV. A decision on costs is not required (cf. Sec. 18(4) sentence 2 Utility Model Act, Sec. 109(1) sentence 1 Patent Act, Sec. 22(1) Act on Court Costs).

50 V. The Senate does not consider an oral hearing to be necessary (Sec. 107(1) Patent Act).

Meier-Beck Bacher Hoffmann

Kober-Dehm Marx

Previous instance:
Federal Patent Court, judgment of 06 September 2016 – 35 W(pat) 1/15 –