

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-03-01
Docket Number / Aktenzeichen:	X ZR 10/15
Name of Decision / Name der Entscheidung:	Ankopplungssystem

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**Arbeitskreis**  
**Patentgerichtswesen**  
in Deutschland e.V.



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 10/15

Pronounced on:  
1 March 2017  
Anderer  
Judicial Secretary as  
Clerk of the court  
registry

in the patent nullity proceedings

Ankopplungssystem/  
Docking system

Patent Act Sec. 82

A patent may be defended by the nullity defendant in a limited manner only to the extent that it is attacked by the nullity plaintiff. The limited defense of the patent in suit by combining an attacked claim with a non-attacked subclaim or with one of several variants of a non-attacked subclaim is inadmissible.

Federal Court of Justice, judgment of 1 March 2017 - X ZR 10/15 –

Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 1 March 2017, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Hoffmann, the judge Schuster and the judge Dr. Deichfuß

ruled that:

On appeal by the plaintiff, the judgment of the 4th Senate (Nullity Senate) of the Federal Patent Court of 29 December 2014, is amended and European patent 1 302 147 is declared null to the extent of patent claim 1 with effect for the territory of the Federal Republic of Germany.

The defendant shall bear the costs of the legal dispute.

By operation of law

Facts of the case:

1           The defendant is the proprietor of European patent 1 302 147 (patent in suit), which was filed on 30 December 1998, claiming the priority of a Swedish patent application of 8 January 1998, and was granted with effect in the Federal Republic of Germany. The patent in suit is based on a divisional application; the parent application is published as WO 99/08237 (N3).

2           The patent in suit is attacked by the plaintiff's action for nullity solely to the extent of independent claim 1, which is worded as follows in the language of the proceedings:

1.     A docking system (1) which essentially comprises
  - a)     at least one self-propelled working-tool (3), preferably intended for attendance of ground or floor, such as grass-cutting, moss-scratching, watering, vacuum-cleaning, polishing, transportation etc., having a body (16) and
  - b)     at least one docking station (2) for the at least one working tool (3),
  - c)     wherein the docking station and the tool can by way of emitted signals establish contact with each other, so that the tool can drive up to the docking station, characterized by that
  - d)     the docking station is provided with at least one first transmission part (5, 6; 5', 6') and the working tool is provided with at least one cooperating second transmission part (7, 8) for transmission of energy between the docking station and the working tool,
  - e)     wherein the docking station is provided with at least one rising part (10, 11, 12, 13), of which at least one part is used for mounting of the first transmission part(s),
  - f)     wherein the tool's second transmission part(s) (7, 8) is/are

located on the upper side of the body.

- 3           The plaintiff argued that the subject matter of the patent in suit was not patentable to the extent challenged and went beyond the content of the application as originally filed. The defendant defended the patent in suit. The Patent Court dismissed the action. In its appeal, the plaintiff continues to pursue its claim. The plaintiff opposes the appeal and defends the patent in suit alternatively in the version of six auxiliary requests.

Grounds of the decision:

4           The appeal of the plaintiff is admissible and well-founded.

5           I.       The patent in suit relates to a docking system comprising a self-propelled implement, in particular for working on a floor or ground, such as mowing the lawn, removing moss, watering, vacuuming, polishing or transporting, and a docking station for the implement.

6           1.       The patent specification of the patent in suit states that a docking system is known from US patent 5 440 216 (N5), which has a floor cleaning robot and a docking station for charging the robot's battery. The robot is guided to the neighborhood of the docking station by ultrasonic waves emitted from the station. Accurate docking is achieved by means of magnets and magnetic sensors mounted on the robot and the docking station. A DC plug on the docking station engages a charging socket on the robot in a horizontal direction. The docking station includes a base plate and a rising portion on which the charging plug is mounted. During the docking maneuver, the robot moves with its wheels onto the base plate of the docking station (patent in suit, paragraph 5; translation, paragraph 6).

7           2.       According to the explanations of the patent specification of the patent in suit, the invention is based on the problem of creating a docking system which is protected against dirt (patent in suit, para. 6; translation para. 7). 3.

8           3.       According to claim 1, this is to be achieved by the following device:

1.       Docking system (1), which essentially comprises:

1.1     at least one self-propelled implement (3), preferably for working a floor or ground, such as lawn mowing, moss removal, watering, vacuuming, polishing, transporting, etc., with a body (16) and

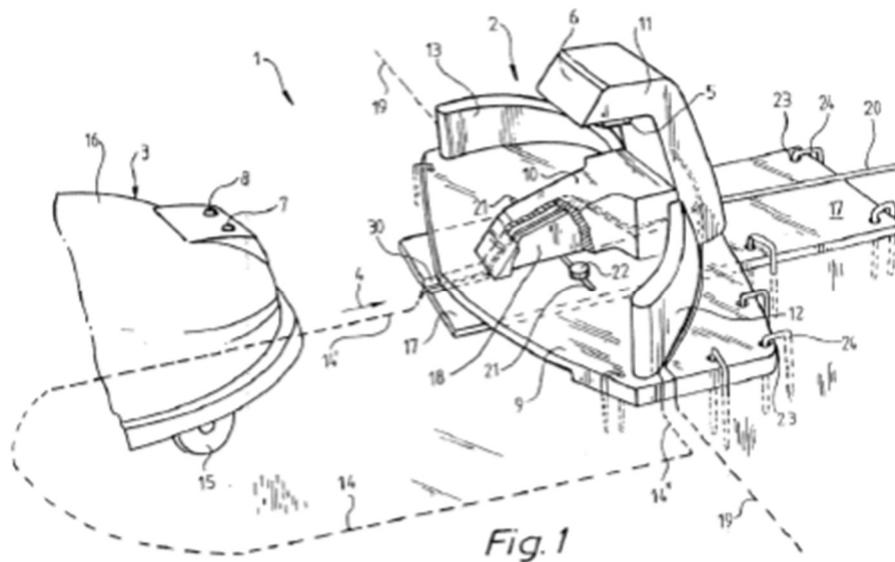
1.2     at least one docking station (2) for the one implement (3).

2.       The docking station and the implement can make contact

with each other by emitted signals, so that the implement can move into the docking station.

3. The docking station is provided with at least one first transmission part (5, 6, 5', 6') and the working implement is provided with at least one second transmission part (7, 8) (cooperating with the first) for the transmission of energy between the docking station and the working implement.
4. The docking station is provided with at least one rising part ( 10, 11, 12, 13), at least one part of which serves for mounting the transmission part.
5. The second transmission part (7, 8) of the working device is arranged on the upper side ("on the upper side") of the body.

9            Figure 1 reproduced below is taken from the patent in suit and shows an example of an embodiment according to the invention:



10            4. According to the teaching of the invention, the (at least one) self-propelled working implement and the (at least one) docking station of the docking system according to the invention are set up in such a way that they can communicate with each other with regard to two functions. The one function relates to the transmission of information between the working implement and

the docking station. In this respect, feature 2 provides that the working implement and the docking station can make contact with each other so that the implement can travel to the docking station. The other feature is for supplying power to the working implement. According to feature 3, for this purpose the docking station is provided with at least one first transmission part and the working implement is provided with at least one cooperating second transmission part for transmitting power between the docking station and the working implement. Features 4 and 5 concern the more detailed design of these two cooperating transmission parts with the aim of protecting them from dirt. Although the transmission of signals or information may in principle also involve a transmission of energy, it follows from the separate treatment of the two functions in the context of the teaching of patent claim 1 that the term "energy" according to the invention means solely the transmission of supply energy for the operation of the implement, as the Patent Court has already correctly pointed out.

11           This understanding is in accordance with the description and the drawings, in which an embodiment example is described and shown, in which the first transmission parts 5 and 6 are provided for the transmission of electrical energy between the docking station and the implement for charging and also for discharging an electrical accumulator located in the implement (patent in suit paragraph 27; translation paragraph 28). Accordingly, the description states that the docking station is "normally" used to transmit electrical energy for charging the battery. The fact that it is also stated that "other types of transmission ... are also possible" and that, for example, information could be transmitted from the station to the device or vice versa by means of further transmission parts or by means of the already existing ones, so that both electrical energy and electrical information could be transmitted (patent in suit, para. 27; translation, para. 28), does not contradict this. In this respect, it is a matter of possibilities for the design of the docking system according to the invention, which are at the discretion of the user, but are not mandatory for the realization of the teaching according to the invention.

12           II.       The Patent Court assumed that the subject matter of claim 1 did not go beyond the content of the application as originally filed and was also

patentable. With regard to patentability, it essentially stated the following:

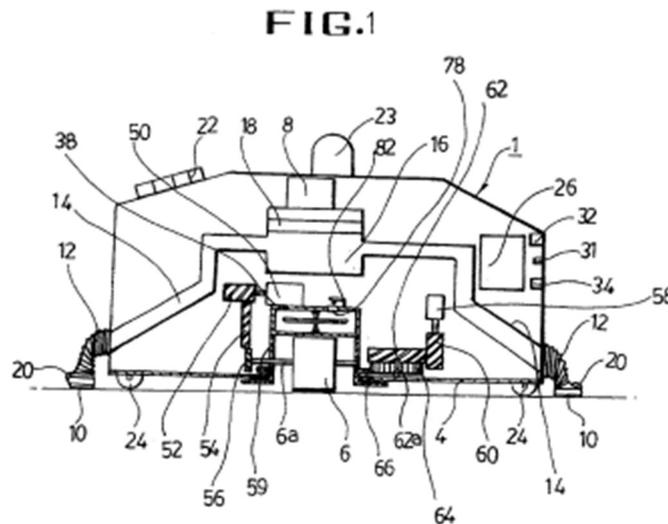
13           An engineer (FH) specializing in mechanical engineering who has extensive knowledge in the field of the development of self-propelled household or horticultural appliances and already has experience in the design of the power and signal supply of such self-propelled appliances is to be regarded as a skilled person.

14           The subject matter of claim 1 of the patent in suit was new and not known from N5. This citation discloses a docking system for a self-propelled automatic cleaning device for cleaning a floor comprising a cleaning body and an automatic charging station for the cleaning device. The automatic charging station and the cleaning device were in contact with each other through ultrasonic wave signals, which allowed the cleaning device to move to the automatic charging station when the battery power dropped below a certain level. The automatic charging station was provided with a DC connection and the cleaning device was provided with a socket cooperating with the connection for charging the battery carried by the cleaning device. According to the plaintiff, the automatic charging station is provided with an upstanding part on which the DC connection is arranged. The docking system according to the invention differs from that disclosed in N5 in that the socket cooperating with the DC connection of the cleaning device is not arranged on the upper side, but on a side surface thereof.

15           The subject matter of claim 1 of the patent in suit was also not obvious to the skilled person from the state of the art. Starting from the problem of a docking system which was better protected against contamination, the skilled person had been able to take from N5 a docking system in which this objective was already solved due to the arrangement of the socket (31) of the plug contact pin (156) at a clear distance from the base as well as the protected position of the contact spring (31a). A suggestion to choose the specific solution according to the invention in contrast to this is not apparent, even with the use of further considerations of the skilled person. This is also not an arbitrary measure or a measure belonging to the standard repertoire, which the skilled person can resort to without further ado on the basis of his technical knowledge.

16 III. The assessment of the Patent Court does not stand up to review in the appeal proceedings. Although the subject matter of patent claim 1 as granted is new, it is not based on an inventive step, since it was obvious to the skilled person from the state of the art.

17 1. The N5, from which the figure 1 reproduced below and showing an example of an embodiment is taken,

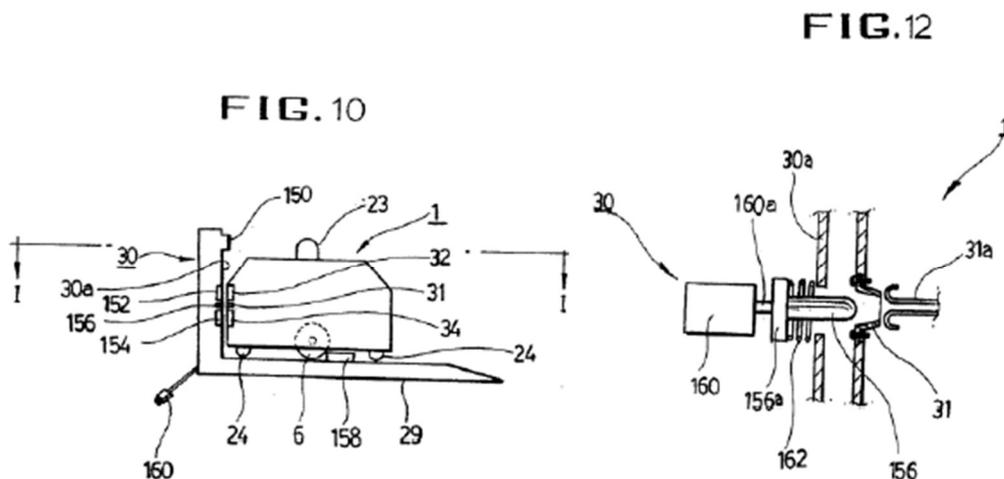


discloses a docking system for a self-propelled automatic cleaning device for cleaning having a cleaning device body and an automatic charging station. The charging station and the cleaning device are in contact with each other through ultrasonic wave signals, allowing the cleaning device to travel to the automatic charging station. For this purpose, a navigation sensor (23) is arranged on the upper side of the implement and an ultrasonic oscillator (150) is arranged at the docking station (N5, sp. 3, lines 31 ff, 44 ff; sp. 7, line 64 ff; sp. 8, line 44 ff; figures 1, 9a and 10). Contrary to the plaintiff's view, however, the N5 does not disclose a second transmission part arranged on the upper side of the device body. The navigation sensor (23), which alone comes into consideration in this respect because of its arrangement on the upper side of the device body, is not to be regarded as a second transmission part, since this serves in cooperation with the ultrasonic oscillator (150) of the docking station for signal transmission, but not for the transmission of supply energy, as this is required - according to the above explanations for the interpretation of the teaching of patent claim 1 - for the existence of feature 5. The subject matter of patent claim 1 is therefore

not known in advance from N5.

18           2.       On the basis of the N5, however, it was obvious to the skilled person when he applied his knowledge and skill in the art.

19           The docking system for cleaning a floor disclosed in N5 has a first and a second transmission part in the form of the DC connection (156) and the socket (31) cooperating therewith, with which energy can be transmitted between the docking station and the implement. However, the second transmission part (conductor 91 and connection socket 31) is located at about two-thirds of the height of the side surface and thus not as required by feature 5 - at the top of the device body. It is also true that first and second transmission parts (plug 156 and connection socket 31) for transmitting power between the docking station and the implement are disclosed to the skilled person in N5, which, due to their arrangement at a clear distance from the ground as well as the protected position of the plug (156) by the side wall (51) and the contact spring (31a) behind a slightly funnel-shaped connection socket (31) having a gradient from the inside to the outside, are largely protected against contamination, as is also made clear by Figures 10 and 12 of the N5 reproduced below:



20           Thus, in the case of a device corresponding to the embodiment example of N5, the desire to protect the transmission parts from contamination may not encourage the skilled person to move them from an arrangement at about 2/3 of the height of the vertical side surface of the cleaning device - as shown

approximately in Figures 1 and 10 of N5 - to the upper side, because the task was already satisfactorily solved by the disclosed arrangement height, this does not mean, however, that the skilled person could not be induced to make such a relocation by a design modification of the cleaning device left to his discretion. It is true that the slope of the outer surface of the device shown in Figures 1 and 10 of N5 between the horizontal surface, on which the navigation transmitter (23) is also located, and the vertical side surface, on which the connection socket (31) and, behind it, the contact spring (31a) are located, may not be well suited for laying the transmission parts, which are designed as a plug-in socket connection, upwards, although this also does not appear to be impossible in the case of a dormer-like design of the connection socket. However, depending on the design wishes expressed to him and depending on the required housing volume, it was in any case readily conceivable to the skilled person, in modification of the device design, either to flatten the sloping surfaces considerably and to raise the vertical side surface approximately up to the height of the horizontal surface (as this tends to be already realized on the left side of the cleaning device shown in Figure 1 of N5,) or to replace it by an arrangement of the horizontal surface and the vertical side surface at an angle of approximately 90°. Since the consideration of protecting the transmission parts from dirt, especially in the case of a low housing, gave reason to arrange the transmission part as far up as possible, as was also realized in the case of the N5, in such an embodiment it made sense to arrange the transmission parts in the angular area of the upper surface and the side surface, so that they are located on the upper side of the body. Thus, for the skilled person, using his technical knowledge and ability and based on the disclosure content of N5, feature 5 also resulted in an obvious way.

21           IV.     Patent claim 1 is also invalid on the basis of the defendant's auxiliary requests.

22           The subject matter of patent claim 1 in the version of auxiliary request 1 is not based on an inventive step, since it was obvious to the skilled person from N5.

23           Auxiliary claim 1 differs from the version of the main claim in that the first and second transmission parts according to feature 3 are no longer provided

only generally for the transmission of "energy", but specifically for the transmission of "electric energy for battery-charging or energy in the form of petrol or other power fuels" ("electric energy for battery-charging or energy in the form of petrol or other power fuels"). The added feature is known from N5, since the first and second transmission parts disclosed there (plug 156; connection socket 31 and contact spring 31a) likewise serve to transmit electrical energy for battery charging (N5, Sp. 3, line 39 ff.; Sp. 4, line 18 ff.).

24           2.       The defense of the subject matter of patent claim 1 as amended by auxiliary request 2 is inadmissible.

25           a)       The subject matter of patent claim 1 as amended by auxiliary request 2 differs from the granted version by the following further features:

"wherein the docking station is designed as a base plate (9), intended to be placed on ground or floor and" and

"wherein the docking station's first transmissions part(s) is/are located in a rising part (11), called transmission head (11), which is located higher up than the base plate (9)"

26           The added features are identical to one of two variants of subclaim 5 as well as subclaim 6, which is why the defendant also suggests that the previous subclaims 5 and 6 be deleted.

27           b)       The limited defense of a patent claim attacked by a partial nullity action by combination with a subclaim not attacked in this respect or with one of several variants of a subclaim not attacked in this respect is inadmissible (Federal Court of Justice, judgment of 24 June 1960 I ZR 109/55, *Liedl*, 395, 410 *Schwingungswalze*; judgment of 11 November 2003 X ZR 61/99, *juris para. 27 Humanmedizinische Abschabungsvorrichtung*; Federal Patent Court, judgment of 19 December 1995 3 Ni 40/94, *BPatGE* 36, 35, 36 f.; *Benkard/Hall/Nobbe*, 11th ed, 2015, Sec. 82, marginal no. 39; *Schulte/Voit*, 9th ed., 2014, Sec. 81 *PatG* marginal no. 122; see also Federal Court of Justice, judgment of 26 May 2009 X ZR 185/04, *GRUR* 2009, 929 marginal no. 50 *Schleifkorn*; *Busse/Keukenschrijver*, 8th ed., 2016, Sec. 82 *PatG* marginal no. 104 and fn. 358).

28           A patent can be defended by the nullity defendant in a limited way only to the extent it is attacked by the nullity plaintiff. With the limited defense of a partially attacked patent by combining an attacked claim with a subclaim that is related back to it but not attacked by the nullity action, the patent in suit is put up for judicial review on the merits to the extent of the subclaim that is not attacked. The possibility of a limited defense of the patent, however, serves solely to defend the nullity defendant against the attack on the validity of the patent led by the nullity plaintiff and not also for judicial review of the patent in other respects.

29           For such a limited defense, a need for legal protection is not to be recognized even if the nullity plaintiff doubts the validity of the subclaim not attacked by the nullity action. This is because the limited defense against a partial nullity action even to the extent of a subclaim not attacked would essentially have the effect of a counterclaim by the patent proprietor against the nullity plaintiff for a declaration of the validity of the patent in suit to the extent of the subclaim not attacked. However, such an action is not provided for in the law and therefore cannot be the subject of a limited defense of the nullity defendant.

30           c)       In the case in dispute, the limited defense of the patent in suit by combining patent claim 1 with subclaims 5 and 6, which are not attacked by the plaintiff, is thus inadmissible. In this respect, it is also irrelevant that of the two variants in subclaim 5 ("the docking station is designed as or provided with a base plate (9)") only the first is to be included in patent claim 1. 3.

31           Furthermore, the defense of the subject matter of patent claim 1 in the version of auxiliary request 3, in which the features added by the versions of auxiliary requests 1 and 2 compared to the granted version of patent claim 1 are combined, is inadmissible. The fact that patent claim 1 in the version of auxiliary request 3, in addition to two non-attacked subclaims, is also to be combined with a feature which is not the subject matter of a non-attacked subclaim, does not change the fact that the defendant thus intends to restrict the patent in suit in a manner which is inadmissible in nullity proceedings.

32           4.       The subject matter of patent claim 1 in the version of auxiliary

request 4 differs from the version of auxiliary request 1 in that the at least one self-propelled implement according to feature 1.1 is to be a lawn-mower ("embodied as a lawn-mover"). Even if patent claim 1 is limited to a lawn-mower as a self-propelled working implement, it was obvious for the skilled person who wanted to further improve such a working implement constructively to take note of other self-propelled working implements such as the automatic cleaning device disclosed in N5 and, in accordance with the above explanations, to consider an arrangement of the second transmission part on the upper side also of a lawn-mower.

33           5.       The defense of the subject matter of patent claim 1 as amended by auxiliary claims 5 and 6, in which the feature of the embodiment of the self-propelled implement is combined with patent claim 1 as amended by auxiliary claims 2 or 3, is also inadmissible for the reasons stated in 2 and 3 above.

34           6.       In the version of auxiliary claims 7 to 13, patent claim 1 as granted as well as in the versions of auxiliary claims 1 to 6 is defended in each case combined with subclaim 7. These auxiliary requests are also inadmissible for the reasons stated under 2 and 3.

35           V.       The decision on costs is based on Sec. 121(2) Patent Act, Sec. 91(1) Code of Civil Procedure.

Meier-Beck

Grabinski

Hoffmann

Schuster

Deichfuß

Previous instance:

Federal Patent Court, judgment of 29 December 2014 – 4 Ni 12/12 (EP) –