Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2014-11-25
Docket Number / Aktenzeichen:	X ZR 119/09
Name of Decision / Name der Entscheidung:	Schleifprodukt

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 119/09

Pronounced on:
25 November 2014
Wermes
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Schleifprodukt/
Grinding product

Patent Act Sec. 21(1) No. 3; EPC Art. 138(1) lit. c; German Act on International Patent Conventions Art. II Sec. 6(1) No. 3

a) If features of an embodiment which together, but also individually, promote the success achieved by the invention, serve the more detailed embodiment of the invention for which protection is claimed, it is in principle permissible to limit the patent by including individual or all of these features in the patent claim. However, the claimed combination must in its entirety represent a technical teaching which the skilled person can take from the original documents as a possible embodiment of the invention.

b) If the skilled person can infer from the representation of an example of an embodiment, which is not explained in detail in this respect, that an effect sought by the invention (here: an open and flexible structure of a knitted fabric) is achieved by a certain combination of two technical measures (here: the combination of tricot and satin stitches in a certain arrangement), it is not necessarily disclosed thereby that the same also applies to every other combination of these two measures.

Federal Court of Justice, judgment of 25 November 2014- X ZR 119/09 –
Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 25 November 2014, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Dr. Bacher and Hoffmann as well as the judge Schuster

ruled that:

On appeal by the defendant, the judgment of the 2nd Senate (Nullity Senate) of the Federal Patent Court pronounced on 14 May 2009 is amended.

European patent 779 851 is declared null with effect for the Federal Republic of Germany insofar as its subject matter extends beyond the following wording of its - now sole - patent claim:

> Grinding product with: a cloth made of knitted threads (1); thread parts, such as loops (3), which are located on a surface of the cloth and protrude from the cloth; and an abrasive (4) applied as separate agglomerates to at least the other, substantially flat surface of the cloth, characterized in that the cloth has a structure permeable to the dust formed during grinding, the protruding thread parts loops (3) of threads (1) contained in the cloth or loops of fibers (2) of such threads, and the protruding thread parts form such a gap between the cloth and a support surface to which the cloth can be fixed by means of the protruding thread parts that the dust formed during grinding can be transported away along this gap.

The remainder of the action is dismissed.

The further appeal is dismissed.

The costs of the legal dispute are set off against each other.

By operation of law

Facts of the case:

1 The defendant is the proprietor of European patent 779 851 (patent in suit), granted with effect for the Federal Republic of Germany, which was applied for on 5 September 1995, claiming the priority of two Finnish applications dated 6 September 1994, and 28 October 1994, and which relates to an grinding product and a process for its manufacture. Claim 1 reads in the process language:

> A grinding product comprising: a cloth of woven or knitted threads (1); thread parts, such as loops (3) or thread ends (5), situated on one surface of the cloth and projecting from the cloth; and a grinding agent applied as separate agglomerates (4) to that surface of the grinding product which comprises projecting thread parts (3, 5), at least to the projecting thread parts (3, 5), characterized in that the projecting thread parts comprise loops (3) or ends (5) of threads (1) of the cloth.

2 The plaintiff claimed that the subject matter of the patent in suit was not patentable. The defendant defended the patent in suit at first instance with one main request and six auxiliary requests in amended form.

3 The Patent Court declared the patent in suit to be null. In its appeal, the defendant defends the patent in suit with one main request and five auxiliary requests in a further amended version. The plaintiff opposes the appeal.

4 On behalf of the Senate, Dr.-Ing. H. prepared a written expert opinion which he explained and supplemented at the first hearing. Following this hearing, Ms. E. prepared a German translation of the two priority documents on behalf of the Senate and provided written explanations on the meaning of some of the terms used therein. Prof. Dr.-Ing. Ü. prepared a written expert opinion on behalf of the Senate on some questions from the field of textile technology and explained and supplemented it at the second hearing date.

Grounds of the decision:

5 The admissible appeal is only well-founded with regard to part of the subject matter of the dispute.

6 I. The patent in suit concerns a grinding product.

7 According to the statements in the patent in suit, the grinding effect of such products is mainly reduced by the fact that the grinding dust clogs the product. In order to counteract this, various measures had been proposed in the state of the art, for example, varying the grain density, different types of binding agents, a dust-repellent surface or the attachment of perforations in order to be able to extract the dust at certain points. However, these measures had proved insufficient.

8 Against this background, the patent in suit concerns the technical problem of providing a grinding product that allows a significantly longer service life than known products.

9 2. In order to solve this problem, the patent in suit, in the version of the patent claims defended at second instance by the main application, proposes two grinding products whose features can be divided as follows:

a) According to claim 1, the grinding product comprises:

1. a cloth

1.1 made of knitted threads (1),

1.2 which is a warp knitted fabric with a combined weave,

1.2.1 wherein in all wales of the warp knitted fabric stitches alternately have a thread connection to a stitch of the adjacent wale on one side and to a stitch of the adjacent wale on the other side,

1.3 having an open structure permeable to dust formed during grinding;

2. Thread sections (parts) such as loops (3), which

2.1 are located on a surface of the cloth,

2.2 protrude from the cloth, and

2.3 consist of loops (3) of threads (1) of the cloth;

3. An abrasive, which is applied as separate agglomerates (4) to the surface of the grinding product with protruding thread

parts (3, 5)

3.1 at least to the protruding thread parts;

4. a liquid-absorbing foam layer (11),

4.1 which is attached to the surface of the cloth, which is free of abrasives.

b) According to claim 3, the grinding product comprises:

1. a cloth

1.1 made of knitted threads (1),

1.2 which has a structure permeable to the dust formed during grinding;

2. Thread sections (-parts) such as loops (3), which

2.1 are located on a surface of the cloth and

2.2 protrude from the cloth,

2.2.1 said protruding thread portions comprising loops (3) of threads (1) contained in the cloth or loops of fibers (2) of such threads (comprise), and

2.2.2 form such a gap between the cloth and a support surface to which the cloth can be fixed by means of the protruding thread portions that the dust formed during grinding can be transported away along this gap;

3. an abrasive applied as separate agglomerates (4) at least to the other, substantially flat surface of the cloth.

12 c) The products protected according to the two patent claims differ from each other in particular in that the abrasive is applied in the first product on that side which has protruding thread parts, whereas in the second product it is applied on that side which is essentially flat. The first claim further specifies the structure of the knitted fabric and provides that a liquid-absorbing foam layer is applied to the side of the cloth opposite the abrasive.

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

14 The subject matter of the patent in suit in the versions defended by the first-instance main request and the first-instance auxiliary requests 1 and 3 was obvious to the skilled person, a graduate engineer with a degree in mechanical engineering with many years of experience in the development of abrasive products, from the state of the art. From the US patent specification 2 996 368 (NK9) a grinding product with all features of the generic term of patent claim 1 was known. This product had an open structure and protruding thread parts,

because these features were more or less applicable to all woven, knitted or crocheted textiles. The core idea of the patent in suit, to provide the grinding product with a largely open structure for improved removal of grinding dust, was also inspired by the further state of the art. For example, US patent specification 2 984 052 (NK6) describes grinding products that have an open-mesh textile base layer and a plurality of protuberances or knots. The skilled person would readily understand from this the teaching that the resistance of textile-based abrasives to the clogging effect of the grinding dust can be improved if the base of a cloth material itself is made as open-meshed as possible.

15 The design envisaged according to the first-instance auxiliary claim 4, in which the agglomerates are applied to the essentially flat surface, makes it possible to use the protruding thread parts on the other side as a kind of hook-and-loop connection. This principle had already been known from technologically related grinding products, as evidenced by German published application 1 577 588 (NK4). The use of such a grinding product for grinding under suction of the dust along a gap between the grinding product and the carrier surface, as provided for in the first instance auxiliary request 6, did not show any further technical surplus.

16 The subject matter of the patent in suit in the versions defended by the first instance auxiliary requests 2 and 5 went beyond the content of the documents originally filed. The feature provided for in these versions, namely that the cloth consists of a warp-knitted fabric with a combined weave of satin stitches and tricot stitches, could at most be inferred from Figure 2 of the application documents. It was neither expressly mentioned in the description nor implicitly disclosed as belonging to the invention.

17 III. This assessment stands up to review in the appeal proceedings only with regard to the version of the patent in suit defended at second instance with the main request and with auxiliary request 1, but not with regard to the version defended with auxiliary request 2.

18 1. The defense of the patent in suit in the version provided for in the main request at second instance is inadmissible. The subject matter of patent claim 1 in this version goes beyond the content of the documents originally filed.

The features 1.2 and 1.2.1 provided therein, according to which the cloth consists of a warp knitted fabric with combined weave with thread connection to respective adjacent meshes, are not disclosed in the application as belonging to the invention.

19 a) According to the established case law of the Federal Court of Justice, the disclosure content of a patent application includes only that which can be directly and unambiguously inferred from the originally filed documents as belonging to the invention for which a patent application has been filed, but not any further knowledge which the skilled person can arrive at on the basis of his general knowledge or by modifying the disclosed teaching. An inadmissible extension exists if the subject matter of the patent only becomes apparent to the skilled person on the basis of his own considerations supported by his expertise after he has taken note of the original documents (see only Federal Court of Justice, judgment of 9 April 2013 - X ZR 130/11, GRUR 2013, 809 marginal no. 11 - Verschlüsselungsverfahren). Generalizations are generally unobjectionable if an embodiment of the invention described in the application appears to a skilled person as an embodiment of the more general technical teaching described in the claim and this teaching in the generality claimed can already be inferred by him from the application - whether in the form of a claim formulated in the application or according to the overall context of the documents - as belonging to the invention applied for (Federal Court of Justice, judgment of 11 February 2014 - X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 24 - Kommunikationskanal).

20 b) It is not sufficiently clear from the application for the patent in suit that a warp knitted fabric with a combined weave of the type defined in feature 1.2.1 is part of the subject matter of the invention.

21 A combined weave is not expressly disclosed in the application. The description merely states that the grinding product comprises a cloth of woven, knitted or knitted threads (e.g. p. 1 line 4, p. 3 line 19; p. 4 line 10). In addition, it is stated that the term "knitted cloth" also includes crocheted cloth or the like (p. 14 line 7 f.). However, there are no further details on the structure of the knitted fabric. A warp-knitted fabric with a combination of satin and tricot weave can at best be seen in figures 2 and 9. Even if it were to be inferred from these

figures that the specific embodiment shown there is claimed as belonging to the invention, it would not be sufficiently clear from this that this should also apply to other types of combined weave, in particular including other types of stitch (e.g. velvet, satin or rep stitch), provided that this only has the thread connections provided for in feature 1.2.1. For the skilled person, who recognizes a combination of satin and tricot weave on the basis of the figures, it may indeed be obvious that this is a combined weave within the meaning of features 1.2 and 1.2.1. However, in the absence of corresponding indications, it does not follow from the application that it is precisely a matter of combining several types of stitch in this way for the design of a cloth according to the invention, while the specific type of stitch is irrelevant. 2.

22 2. The defense of the patent in suit in the version according to the second instance auxiliary request 1 is also inadmissible.

23 a) According to this auxiliary request, feature 1.2.1 in patent claim 1 is to be supplemented to the effect that the combined weave is composed of satin stitches and tricot stitches.

24 b) Even with this concretization, the claimed subject matter is not directly and unambiguously disclosed in the originally filed documents as belonging to the invention.

25 It can be left open whether in Figures 2 and 9 of the application a warp knitted fabric with an identical satin/tricot weave is directly and unambiguously disclosed as belonging to the invention. Even if this question were to be answered in the affirmative, this would apply at most to the type of weave mentioned, in which the satin stitches are arranged on the front side and the tricot stitches on the rear side. However, as the defendant does not dispute, feature 1.2.1 in the version of auxiliary request 1 is not limited to this type of weave. Rather, it covers any combination of tricot and satin meshes and thus also the tricot/satin weave in which the tricot meshes are arranged on the front side and the satin meshes on the back side. At least with this generalization, feature 1.2.1 is not disclosed in the originally filed documents as belonging to the invention.

26 aa) According to the case law of the Senate, however, it is not generally impermissible to include only individual features of several features of an embodiment in the patent claim (see only Federal Court of Justice, judgment of 11 February 2014 - X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 24 - Kommunikationskanal).

27 If features of an embodiment which together, but also individually, promote the success achieved by the invention, serve to further specify the invention for which protection is sought, it is generally permissible to limit the patent by including individual or all of these features in the patent claim (Federal Court of Justice, order of 23 January 1990 - X ZB 9/89, BGHZ 110, 123, 126 - Spleißkammer; Federal Court of Justice, judgment of 30 August 2011 - X ZR 12/10, marginal no. 30). In this context, too, the claimed combination must, however, constitute in its entirety a technical teaching, which a skilled person can infer from the original documents as a possible embodiment of the invention (Federal Court of Justice, order of 11 September 2001 - X ZB 18/00, GRUR 2002, 49 - Drehmomentübertragungseinrichtung).

28 bb) This requirement is not met in the case in dispute.

29 As explained by the court expert Prof. Dr.-Ing. Ü., it is clear to a skilled person who is familiar with questions of textile science from Figure 2 of the application that the grinding product reproduced there consists of a knitted fabric in satin/tricot weave. This design does not offer any certain guarantee that the cloth will have the properties desirable according to the description, in particular an open and flexible structure. At least, however, the application of satin stitches to the front of a basic structure consisting of tricot stitches leads to the formation of relatively large loops which tend to favor the occurrence of these effects. Thus, it may be disclosed to one skilled in textile lore that the satin/tricot weave shown serves to bring about the success sought by the invention. However, it does not follow from this that the same applies to any other combination of tricot and satin stitches, in particular to a tricot/satin weave.

30 As explained by the court expert Prof. Dr.-Ing. Ü., numerous other mesh combinations are also possible for achieving the success sought by the patent in suit. Whether they are actually suitable for achieving this success cannot be

assessed with sufficient certainty on the basis of abstract considerations. For the skilled person, who was looking for ways of carrying out the invention on the basis of the examples shown in Figures 2 and 9, it therefore did not follow directly and unambiguously from the fact that a satin/tricot weave was shown as suitable that the same also applied to all other combinations of tricot and satin stitches. With regard to a tricot/satin weave, there would have been reservations here, based on the statements of the court expert Prof. Dr.-Ing. Ü., if only because the arrangement of the loops on the rear side of the knitted fabric tends to be less suitable for achieving the effects intended by the invention. It does not follow from this that such a combination of loops is generally unsuitable. Against this background, however, it cannot be directly and unambiguously inferred from the application that it is already sufficient for the design of a cloth according to the invention to combine tricot and satin stitches with each other, while the concrete arrangement of the two types of stitches is irrelevant.

31 3. It is not necessary to decide whether a version of claim 1 limited to a knitted fabric with satin/tricot weave would be admissible. The defendant explicitly clarified at the oral hearing that it does not defend such a version.

32 The subject matter of the (single) claim defended by auxiliary request 2 - the wording of which is identical to the wording of patent claim 3 in the version defended by the main request - is patentable.

33 a) The German utility model 295 05 847.1 (NK42), published on 27 July 1995, is not part of the state of the art. The patent in suit rightly claims the priority of the Finnish application 944 090 filed on 6 September 1994 (in Swedish).

34 aa) As the translator E. commissioned by the Senate has shown, the term "sticka" includes both the term "knit" and the term "work". The Swedish terminology thus corresponds to the English terminology which, as explained by the court expert Prof. Dr.-Ing. Ü., uses the term "knitting" for both types of production and differentiates - with a differentiation in detail - between "weft knitting" and "warp knitting".

35 bb) Against this background, it is true that the description of the two

priority documents, in which no further distinction is made between individual sub-types, does not directly and unambiguously indicate the configuration of the cloth as warp knitted fabric made of more closely defined combinations of tricot and satin stitches. However, priority document 944 090 already contains figures 2 and 9 reproduced in the patent in suit and its application, in which a knitted fabric is shown.

36 In the description of the priority document - as in the description of the patent in suit and the application - no further distinction is made between knitting, warp knitting or weaving. Rather, all of these manufacturing methods are described as basically suitable. However, it was sufficiently clear to a skilled person from this that in any case all types of manufacture recognizable from the embodiment examples - irrespective of the concrete formation of the stitches or other details - are claimed as belonging to the invention. Therefore, the defendant was free to limit the subject matter of the invention to one of these three types of manufacture.

37 cc) As the Senate already explained in its evidentiary ruling of 18 June 2013, the skilled person, a mechanical engineer with many years of experience in the development of grinding products, had reason to consult a skilled person familiar with issues of textile science for the design of the cloth claimed in the invention. This applies accordingly to the subject matter of the priority document.

38 Contrary to the plaintiff’s view, this is not precluded by the fact that the description of the documents mentioned does not deal with details of the method of manufacture. Rather, it is decisive that the properties of the cloth according to the claimed invention are of central importance. A skilled person wishing to carry out the claimed invention is therefore required to search for textiles suitable for this purpose. If, due to his training in the field of mechanical engineering, he does not have sufficient knowledge to obtain more detailed information from the priority document, he has reason to consult a textile expert to assess these questions.

39 b) As the Senate already explained in more detail in its evidentiary ruling of 18 June 2013, the subject matter of patent claim 1 in the version defended by auxiliary request 2 is neither disclosed nor suggested by the other

citations, in particular by US patent specification 2 984 052 (NK6) and German published application 1 577 588 (NK4). No new findings in this regard arose during the second oral proceedings.

40 IV. The decision on costs is based on Sec. 121(2) Patent Act and Sec. 92(1) Code of Civil Procedure.

Meier-Beck Grabinski Bacher

Hoffmann Schuster

Previous instance:
Federal Patent Court, judgment of 14 May 2009 – 2 Ni 21/07 (EU) –