

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-10-27
Docket Number / Aktenzeichen:	X ZR 11/13
Name of Decision / Name der Entscheidung:	Fugenband



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 11/13

Pronounced on:
27 October 2015
Anderer
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Fugenband/
Joint tape

German Act on International Patent Conventions Art. II Sec. 6(3); EPC Art. 84 sentence 2; Code of Civil Procedure Sec. 62

- a) In the case of a self-limitation by the patentee in nullity proceedings, an examination of the clarity of the limited patent claim is not admissible, at least to the extent that the presumed ambiguity was already contained in the granted claims.
- b) If an action for revocation of a patent has been brought by several plaintiffs or if several legal proceedings concerning the same patent have been joined for the purpose of simultaneous hearing and decision, the plaintiffs are necessary co-joined parties according to Sec. 62 Code of Civil Procedure.

Federal Court of Justice, judgment of 27 October 2015 - X ZR 11/13 –

Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 27 October 2015, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning and Dr. Bacher as well as the judges Schuster and Dr. Kober-Dehm

ruled that:

On appeal by the first applicant, the judgment of the 10th Senate (Legal Complaints and Invalidity Senate) of the Federal Patent Court, delivered on October 4, 2012, is amended, the further appeal being dismissed.

European patent 792 973 is declared partially invalid with effect for the Federal Republic of Germany in that claims 1, 2 and 7 are replaced by the following:

1. Use of a cold-laid tape consisting of polymer-modified road construction bitumen, which is bonded on at least one side with a separate adhesive layer, as a joint tape in road construction.
2. Use of a tape according to claim 1, characterized in that the adhesive layer has a thickness between 0.2 and 4 mm.
7. Use of a tape according to any one of claims 1 to 6, characterized in that the adhesive coating is adjusted so that the adhesive properties are developed by dissolution only when the adhesive comes into contact with a primer containing higher-boiling solvents.

The remainder of the actions are dismissed.

The costs of the 1. instance proceedings are ordered to be borne by the plaintiffs in 4/5 and by the defendant in 1/5. Of the costs of the appeal, the plaintiff shall bear 4/5 and the defendant 1/5.

By operation of law

Facts of the case:

1 The defendant is the proprietor of European patent 792 973 (patent in suit), filed on 25 January 1997, claiming a German priority of 3 February 1996, and granted with effect for the Federal Republic of Germany, which, in the version obtained in opposition proceedings before the European Patent Office, relates to a cold processable joint tape and comprises seven patent claims, of which claims 1, 2 and 7 are attacked. The attacked claims read:

- "1. Cold-applicable joint tape for use in road construction, consisting of polymer-modified road construction bitumen bonded on at least one side with a separate adhesive layer.
2. Joint tape according to claim 1, characterized in that the adhesive layer has a thickness between 0.2 and 4 mm.
7. Joint tape according to any of claims 1 to 6, characterized in that the adhesive coating is adjusted so that the adhesive properties are developed by dissolution only when the adhesive comes into contact with a primer containing higher boiling solvents."

2 The plaintiffs argued that the subject matter of claim 1 of the patent in suit went beyond the content of the application as originally filed and, like that of claim 2, was not patentable. Patent claim 7 also claimed subject matter that was not so clearly and completely disclosed as to be capable of being carried out by a skilled person.

3 The defendant defended the patent in suit in the version obtained in the opposition proceedings and with nine auxiliary claims.

4 The Patent Court dismissed the claims. The appeal of the first plaintiff (hereinafter: plaintiff) is directed against this, with which it continues to pursue the grounds for invalidity of lack of patentability and lack of practicability. The defendant defends the contested judgment primarily with the proviso that the challenged patent claims 1, 2 and 7 are to be given the wording apparent from the operative part as use claims.

Grounds of the decision:

5 The appeal is partially successful.

6 I. The patent in suit, as defended, relates to the use of a tape as a cold-applicable joint tape in road construction.

7 1. According to the patent description, joint tapes are used in particular in road construction for the production of seams, i.e. connections of adjacent paving courses made of mix with comparable properties, and of joints, i.e. connections of paving courses made of mix with different properties. The joints created by seams and connections, which are exposed to road traffic and climatic influences, must meet high quality requirements. They should be watertight and not open up under external influences so that the surface course is not damaged (Descr. para. 2). It was a question of placing more bitumen than before on the tie-in flank and of installing a soft joint, i.e. of placing a maximum quantity of bitumen for sealing, moving and bonding (para. 2). Previously, the solution to this problem had been to use prefabricated bitumen joint strips, which were placed on the flank after painting the flank of the existing old asphalt surface course with a bituminous primer. In order to cause the bitumen joint tape to adhere to the seam flank, it had been heated with a propane flame and then pressed against the flank. The temperature of the mix of the new surface course to be laid, which was brought directly up to the laid joint tape, was not sufficient in itself to compensate for defects in the laying of the joint tape; even the subsequent rolling did not result in a tight seal of the seam (para. 3).

8 2. Against this background, the patent in suit relates to the technical problem of providing a joint tape that is easy to apply and at the same time allows tight sealing of the seam.

9 3. In order to solve this problem, the patent in suit as last defended proposes:

Patent claim 1:

1. Use of a tape as a joint tape in road construction.
2. The joint tape consists of polymer-modified road bitumen.
3. It can be laid cold

4. It is bonded on at least one side with a separate adhesive layer.

Claim 2 includes:

the use of a tape according to claim 1, wherein the adhesive layer has a thickness between 0.2 and 4 mm.

Claim 7 calls for:

the use of a tape according to any one of claims 1 to 6, wherein the adhesive coating is adjusted so that the adhesive properties are developed by dissolution only when the adhesive comes into contact with a primer containing higher boiling solvents.

10 4. The parties dispute which qualification the relevant skilled person must have for the interpretation of the patent and the assessment of patentability.

11 a) The plaintiff assumes that the skilled person is formed by a team consisting of a graduate civil engineer specializing in road construction with special knowledge in the use of bituminous joint tapes and a chemist who has special knowledge in the development, design and manufacture of bituminous joint tapes. The defendant agrees with the Patent Court that the skilled person is a graduate civil engineer who also has the necessary chemical expertise for the development of the joint tapes.

12 b) The relevant skilled person is the person who is involved in practice with the development and manufacture of materials for seams and connections in road construction and the sealing of joints. In addition to knowledge of the (possible) material properties of the tape, this requires experience with the installation of the joint tape. Ultimately, it is irrelevant whether a road construction engineer or a construction chemist, who is primarily concerned with the composition and use of building materials, is to be regarded as a skilled person. In any case, the patent in suit does not concern the production of an adhesive or an adhesive layer, but in the most recently defended version proposes the use of a tape as a joint tape in road construction,

which can be laid cold and is provided with a separate adhesive layer. The plaintiff's submission does not provide sufficient factual indications to the effect that, in view of this, the classification of the skilled person as a road construction engineer by the Patent Court is not correct. Even if one sees the focus of the solution of the technical problem of the patent in suit in the application of materials, the skilled person is in any case not an adhesive specialist, but a construction chemist who has experience in the composition and application of building materials and, for example, like the private experts commissioned by the defendant, is active in the field of polymeric building materials and materials testing. Therefore, it cannot be assumed that special adhesive experts would be employed in the field of road construction; the plaintiff has not submitted this either. Against this background, special knowledge of the composition and mode of action of adhesives is not to be expected from the specialist in question (see Federal Court of Justice, judgment of 22 September 2015 X ZR 53/13).

13 5. The term "joint tape", the meaning of which is disputed between the parties, requires closer consideration. According to the plaintiff, the teaching of the patent in suit cannot be limited to joint tapes to be installed vertically, i.e. in the joint. The term also includes, for example, tapes used to cover a joint.

14 a) The meaning of the terms used in a patent claim must be determined by interpreting the patent claim, which is always required according to the established case law of the Federal Court of Justice and may not be omitted even if the wording of the patent claim appears to be unambiguous (see only Federal Court of Justice, judgment of 12 May 2015 X ZR 43/13, GRUR 2015, 875 Rotorelemente, with numerous further references). The description of the patent, the function of which is to explain the protected invention, can define terms independently and in this respect constitute a lexicon inherent to the patent (Federal Court of Justice Rotorelemente, marginal no. 16; judgment of 2 March 1999 X ZR 85/96, GRUR 1999, 909 Spanschraube). In case of doubt, the claim must be understood in such a way that the two parts of the patent specification do not contradict each other, but are understood as interrelated parts of the technical teaching made available to the skilled person by the patent as a meaningful whole (Federal Court of Justice Rotorelemente, marginal no. 16).

- 15 In this context, indications of purpose, effect or function, as components of a patent claim, participate in its task of distinguishing the protected subject matter from the state of the art if they define the device element to which they refer as one that must be designed in such a way that it can perform the relevant function (Federal Court of Justice, judgment of 7 June 2006 X ZR 105/04, GRUR 2006, 923 marginal no. 15 Air separator for milk collection system).
- 16 b) This is the situation here. The term joint tape contained in the patent claims does not in itself indicate any properties of the joint or the (joint) tape. However, it follows from the statements in the description that the joint tape according to the patent is intended to be such a joint tape with which a tight production of seams and connections in road construction, resistant to weathering and mechanical influences, can be achieved. In order to be able to withstand the effects of weather and traffic, more bitumen than before is to be applied to the tie-in edge (par. 1, 3). The use of the term "tie-in slope" indicates that the joint tape is to be placed on the side of the existing pavement, i.e. vertically in the joint. This view is confirmed by the further explanations in the description. For example, it is stated in the explanation of the invention that the use of a propane flame can be dispensed with when laying on the seam side. With appropriate adjustment of the adhesive, it is also possible to achieve adhesion between the joint tape and the seam flank at temperatures slightly above the freezing point (para. 7). Also in the explanation of the embodiments and in particular also of the article according to claim 7, the description speaks of the adhesion of the joint tape to the seam flank (para. 12), the pressing of the tape to the seam flank (para. 15) and of reliable adhesion of the joint tape to the seam flank (para. 16).
- 17 c) This understanding of the term "joint tape" is supported by the leaflet submitted by the defendant in 2nd instance for the production of seams and connections in traffic surfaces made of asphalt, published by the Research Association for Roads and Traffic, Working Group for Asphalt Roads, from 1989 (Annex GPR 3).
- 18 (1) Although this is a new means of defense, it is, contrary to the opinion of the plaintiff, not admissible pursuant to Sec. 117 Patent Act in conjunction with Sec. 531(2) Nos. 1 and 3 Code of Civil Procedure. The Patent

Court did not deal with the term "joint tape" in the sense understood by the plaintiff, as is clear from the court's reference under Sec. 83(1) Patent Act and from the contested judgment. The plaintiff itself did not place particular emphasis on the interpretation until the appeal. The submission of the leaflet with which the defendant responded to the appellant's submission is therefore not based on negligence on the part of the defendant.

19 (2) Section 4.2.2 of the data sheet contains information on joints with fusible joint tape. Here, too, mention is made of the joint edge, which was to be provided with a suitable primer as was customary with the state of the art at that time. The joint tape was to be melted on one side and pressed firmly onto the prepared joint face. It follows from this that a joint tape used in road construction is to be applied to the joint flank, i.e. to the side of the joint and thus vertically upright.

20 II. The Patent Court, in this point unchallenged by the appeal, assumed that the ground for nullity of the inadmissible extension was not present. Moreover, the invention contained in patent claim 7 was disclosed in an executable manner. The skilled person could rework the teaching of claim 7 with the explanations given in the description with the aid of suitable results either known or obtained from experiments. According to paragraph 15 of the description, the adhesive could, for example, be adjusted so that it still exhibits no or only slight adhesive properties at temperatures of up to a maximum of 30°C. The adhesive could also be adjusted so that it exhibits no or only slight adhesive properties at temperatures of up to a maximum of 30°C. Only when the joint tape provided with the adhesive layer comes into contact with the primer by pressing it against the seam flank, does the adhesiveness and thus the adhesion occur.

21 The subject matter of the challenged claims was also patentable. German published application 2 225 358 (K6), which was used to examine novelty, referred to a prefabricated sheet- or web-shaped material provided with at least one layer of a polymer-modified bituminous composition, wherein layer 1 (Figure 1 of K6) had a substantially non-adhesive property on one side, while the other side consisted of a self-adhesive bituminous composition. The material in sheet form is laid for waterproofing on concrete surfaces, including bridges, where a

hot asphalt layer is subsequently applied. The material according to K6 thus exclusively concerned waterproofing membranes and not joint tape.

22 The joint tape according to German patent specification 41 26 090 (K12) is tear-resistant and consists of elastic polymer plastic and not of polymer-modified road construction bitumen, so that characteristic 3 is not fulfilled.

23 The subject matter of patent claim 1 and the challenged subclaims were also based on inventive step. From the German utility model 93 13 030 (K2) a bitumen-containing sealing material was known, which was used as a joint tape in road construction. The sealing material is compressed into a joint tape by slight heating; it is self-adhesive and no further heating is required for its installation. The composition of the joint tape material causes the self-adhesive property, with the entire layer being self-adhesive. However, the joint tape according to K2 is not connected on any side with a separate adhesive layer. The skilled person also receives no indication from K2 that the known adhesive layer should be provided with a further adhesive layer on one side for the purpose of better adhesion, because bonding or adhesion of the tape is already achieved with a single-layer joint tape.

24 In Zeller's paper "A new joint tape, a cover tape and new plugs for sealing boreholes" in: Neue Deliwa-Zeitschrift Heft 12/94 (K22a), a preheating of the cut and milled edges is suggested as a solution in case of insufficient adhesion, which does not lead the skilled person to the solution according to the patent.

25 Also the band according to the German published application 1 965 092 (K7) shows nothing that goes beyond what is known from K2 and K22a. Even a synopsis of the publications discussed did not lead to the subject matter of the patent. From K6, the skilled person would primarily recognize waterproofing membranes in different widths. There, the bonding of the membranes to the concrete substrate by means of an adhesive layer applied to the membranes was described. The purpose of the two-layer structure was not to improve the adhesion of the waterproofing membranes lying flat on the concrete substrate, but to create a non-adhesive side that could be exposed to the outside. The two-layer structure of the waterproofing membranes in K6 thus served completely different purposes than those of the patent in suit. In the patent in suit, the focus

was on increasing the adhesive properties of vertically applied joint tapes.

26 The German patent specifications K12 and DD 258 259 (K10) showed a two-layer structure, but concerned tapes that were not suitable for road construction from bitumen-bound asphalt layers. Unlike the patent in suit, the joint tapes disclosed in K12 and also in K10 did not fill the joint but bridged it. K12 and K10 could therefore not offer a solution to the problems described in the patent in suit.

27 III. This assessment essentially withstands the attacks of the appeal. Insofar as the defendant no longer defends the patent in suit, it must be declared invalid without further examination of the merits (Federal Court of Justice, judgment of 19 December 2006 X ZR 236/01, BGHZ 170, 215 marginal no. 15 Carvedilol II). To the extent that it is defended, it proves to be legally valid.

28 1. The limited defense by changing the substantive claims into use claims is admissible.

29 a) The transition from a product claim to a use claim in patent nullity proceedings is admissible according to the established case law of the Senate. The inventor should receive protection for the new and non-obvious use of a product known per se (Federal Court of Justice, judgment of 2 November 2011 X ZR 23/09, Mitt. 2012, 119 Notablaufvorrichtung).

30 b) Contrary to the plaintiff's view, the restricted patent claim is not to be examined with regard to clarity of the term "separate" contained in feature 4.

31 (1) In the case of a self-limitation by the patent proprietor in nullity proceedings, it must be examined whether the intended self-limitation is inadmissible, for example because the subject matter thus defined would go beyond the original disclosure or would extend the scope of protection of the patent. Furthermore, an examination criterion for the admissibility of features and terms included in the patent claim may be whether the claim is sufficiently clear and distinct by their inclusion (cf. Federal Court of Justice, judgment of 24 January 2012 X ZR 88/09, GRUR 2012, 475 marginal no. 29 Elektronenstrahltherapiesystem). This follows from Art. 84 sentence 2 EPC; for national law this requirement follows from Sec. 34(3) No. 3 Patent Act in

conjunction with Sec. 9(6) Patent Regulation. However, neither the European Patent Convention nor the Patent Act provides for an examination of already granted claims for clarity. With the granted patent or the patent amended in the opposition proceedings, the patent proprietor has obtained a legal position which can only be wholly or partially revoked in the cases provided for by law, i.e. if there is a ground for opposition or nullity. The European Patent Convention, like national law, exhaustively regulates the grounds for opposition or nullity, which do not include lack of clarity (Articles 100, 138 EPC; Sections 21, 22 Patent Act). It follows that an examination of clarity is not admissible, at least to the extent that the presumed ambiguity was already contained in the granted claims (cf. EPO, decision of 24 March 2015 G 3/14).

32 (2) According to these principles, an examination of the patent claims amended into use claims is not admissible in the case in dispute. The word "gesondert" (separate), which is in dispute here, was not included in the patent claim amended as a use claim by way of an amendment. It was already part of the subject matter claim as amended in the opposition proceedings, which remained unchanged with the exception of the formulation as a use claim.

33 2. The subject matter of the last defended claim 1 is new (Art. 54(1) and (2) EPC).

34 a) The use of a tape as a joint tape according to the patent is not anticipated by citation K6. K6 concerns a prefabricated sheet- or web-shaped material suitable as a sealing material for various surfaces, for example for roofs or floors and in particular for application to concrete surfaces and also as a bridge covering (pp. 1, 7). A layer of the material preferably consists of two layers, one of which may be a self-adhesive bituminous adhesive compound and the other a non-adhesive bituminous compound (pp. 3, 4). The adhesive side of the layer is applied to the surface to be sealed, and a plurality of overlapping sheets may be required to obtain a continuous membrane over the entire surface (p. 6). The width of the material may vary, ranging from 2.5 to 120 cm or more, for example (p. 4). Thus, K6 may present an object that is objectively suitable as a joint tape. However, as the plaintiff does not dispute, K6 does not disclose the use of a tape as a joint tape.

35 b) The Patent Court correctly assumed that also citation K12 does not anticipate the subject matter of the patent in suit. This also applies to the last defended use claims. The appeal also does not attack this.

36 3. The subject matter of the defended claims was not suggested by the state of the art from the point of view of the skilled person (Art. 56 EPC). The Patent Court correctly assumed that the claims K2, K22a, K7, also in connection with K6, as well as K10 and K12 do not lead to the invention. This assessment also applies to the defended use claims. The plaintiff has not challenged the Patent Court's statements on claims K10 and K12 on appeal.

37 a) K2 concerns a bituminous sealing material which can be used, among other things, as a joint tape for sealing joints in road construction.

38 (1) The sealing material is said to conform completely to the joint walls in close material contact (K2, p. 1). According to the description, the disadvantage is that the components whose joints are to be sealed have to be provided with a special bitumen-based protective layer from the outset or that this is applied in the form of a solvent-containing paint (primer) immediately before the joint tape is applied. The task of the invention is to produce a self-adhesive bituminous sealing material, preferably in the form of joint tapes, sheets or bandages, which allows the effort for painting or heating to be saved (p. 2). The joint tape is pressed under slight heating (p. 3 aE); it is self-adhesive and does not need to be heated during installation. This joint tape differs from the tape according to claim 1 of the patent in suit in that it is single-layered and not bonded on at least one side with a separate adhesive layer.

39 (2) From this and also in connection with the disclosure of K6, the skilled person receives no suggestion to use a tape as a joint tape which is provided with a separate adhesive layer. The web-shaped sealing material of K6 is used for sealing surfaces (p. 2, 1st para.). K6 contains no reference to the use of the disclosed material as a joint tape as understood by the patent in suit. If anything, the contents of K6 lead away from such a use. The citation speaks of a "layer", a web-like material (p. 3, 4), which is applied horizontally to surfaces to make them waterproof, as explained (p. 6), and to provide a permanent bond to the substrate, while the non-adhesive side can be exposed to the outside.

The two-layer material structure of K6 also serves different purposes than the separate adhesive layer in the patent in suit, which focuses on increasing adhesion. It offers, as the Patent Court correctly pointed out, the possibility of further treating the non-adhesive side to protect it from damage and to improve the anchoring of subsequently applied materials such as concrete or asphalt (K6, p. 6, 2nd para.). Finally, the material structure also allows reinforcing material to be placed within the layers of the ply (K6, p. 4, 1st para.).

40 (3) Contrary to the plaintiff's view, it cannot be concluded from the reference in paragraph 4 of the patent in suit that the material disclosed in K2 is made of a bituminous compound which is obviously not adhesive that this criticism indicates that the skilled person had reason to seek a further development of the state of the art outside the trajectories outlined by the proposal of K2. This criticism can be seen as an analysis made in retrospect after finding the solution according to the patent in suit (see Federal Court of Justice, judgment of 31 August 2010 X ZR 73/08, Mitt. 2011, 26 Gleitlagerüberwachung). From the criticism that the material was made from an obviously non-adhesive bituminous compound, it is only clear that the adhesive capacity of the material is to be improved. However, it was neither specified by which means an improved adhesive ability was to be achieved, nor that this could be achieved with the formation of a separate adhesive layer.

41 (4) Nor does the fact that the material according to K6 and joint tapes according to K2 are possibly offered in the same catalog lead to the negation of inventive step. The technical proximity of the material according to K6 and the joint tape according to K2 did not, at least until the priority date of the patent in suit, lead to the transfer of properties of the one material to the other.

42 b) In the article K22a it is pointed out that the deformable tape presented there is simply pressed on and adheres. On cool days, it could be expedient to preheat the cut or milled edge (p. 626 re. sp., 7th indent). Whether the expert, as the plaintiff believes, received a suggestion from this recommendation to further improve the adhesion of the joint tape can ultimately be left open. K22a specifies the requirements for joints to be sealed in road construction: little manual work should be required, environmental compatibility should be ensured, the "pre-painting" operation should be eliminated in order to

reduce costs, the tape should be self-adhesive and fill the joint at milled, rougher edges and ensure a watertight seal. To meet these requirements, the author considers the presented product to be a very successful solution; he states: "Surprisingly, the manufacturer from the new German states succeeded in meeting all requirements within a very short time with a new joint tape" (K22a, p. 626 r. sp.). Against this background, the quoted remark about preheating does not, from a skilled person's point of view, aim to designate a defect or a weak point of the presented joint tape that needs improvement. Rather, the reference to warming up appears as a possible supporting measure when applying the tape under certain weather conditions. However, even if the skilled person would have seen in the quoted passage a suggestion to improve the adhesion of the joint tape, the citation does not indicate the solution proposed by the patent in suit to provide the joint tape with a separate adhesive layer.

43 c) K7 discloses, as the Patent Court correctly pointed out, a plastic-elastic, strongly adhesive joint tape with high extensibility, which is formed in a single layer. This joint tape differs from the subject matter of claim 1 of the patent in suit, as does the joint tape shown in K2, in that it is not intended to be bonded on at least one side with a separate adhesive layer. Consequently, the skilled person also receives no suggestion from K7 to provide a joint tape with a separate adhesive layer.

44 4. The invention is disclosed in patent claim 7 so clearly and completely that a skilled person can carry it out (Art. 138(1) lit. b EPC in conjunction with Art. II Sec. 6(1) No.2 German Act on International Patent Conventions). The plaintiff claims that it is not obvious to a skilled person what a suitable higher boiling solvent can be. Therefore, there is no meaningfully comprehensible technical teaching. This is not true.

45 a) A teaching is practicable if the skilled person is able, without inventive step and without unreasonable difficulties, to realize the teaching of the patent claim on the basis of the overall disclosure of the patent specification in combination with the general knowledge of the art in such a way that the desired success is achieved. In this context, it is sufficient if a general solution scheme is provided to the skilled person. The patent claim does not have to contain all the details required to carry out the invention (cf. Federal Court of

Justice, judgment of 11 May 2010 X ZR 51/06, GRUR 2010, 901, marginal no. 31 Polymerizable cement mixture; judgment of 13 July 2010 Xa ZR 126/07, GRUR 2010, 916, marginal no. 17 Clamp seam device).

46 b) The statements in patent claim 7 and the explanations in paragraph 15 of the description meet these requirements. There, the skilled person is instructed to adjust the adhesive in such a way that it still exhibits no or only slight adhesive properties up to a maximum temperature range of 30°C. The adhesive is then adjusted to the desired temperature. Adhesive strength and thus adhesion should not occur until the joint tape is pressed against the seam flank and comes into contact with the primer, so that the higher-boiling solvents contained in the primer act on the adhesive layer. As the plaintiff does not deny, such solvents were known to the skilled person. It was therefore possible for him to carry out tests on adhesive strength with various known solvents and thus arrive at the result specified in the patent in suit. This is not contradicted by the fact that in claim 7 the term "higher boiling point" is not contrasted with a comparative term. Rather, the skilled person is instructed to select a solvent which does not have too low a boiling point and can find the suitable solvent by appropriate tests.

47 IV. The decision on costs is based on Sec. 121(2) Patent Act, Sec. 92 (1) sentence 1, Sec. 100(1) Code of Civil Procedure.

48 If an action for nullity of a patent has been brought by several plaintiffs or if several actions relating to the same patent have been joined for the purpose of simultaneous hearing and decision, the plaintiffs are necessary co-joined parties under Sec. 62 Code of Civil Procedure. The decision on the declaration of nullity of a patent is rendered by way of a judgment; it must be rendered uniformly, since the judgment granting the action for nullity has effects vis-à-vis each of the plaintiffs (cf. on the action for avoidance under stock corporation law Federal Court of Justice, judgment of 5 April 1993 II ZR 238/91, BGHZ 122, 211, 213, 240). Furthermore, a complete or partial declaration of invalidity of the patent pursuant to Art. 68 EPC or Sec. 22(2), Sec. 21(3) Patent Act has a constructive effect vis-à-vis anyone to the effect that the effects of the patent are deemed not to have occurred from the beginning to the extent of the declaration of nullity.

49 The necessary joinder of parties has the consequence that the second applicant continues to be a party to the proceedings, even if it has not challenged the judgment of the Patent Court with the appeal (see Federal Court of Justice, judgment of 24 January 2012 X ZR 94/10, BGHZ 192, 245 marginal no. 22 Ink Cartridge II). Accordingly, the amended decision on the 1st instance costs also concerns the 2nd instance plaintiff.

Meier-Beck

Gröning

Bacher

Schuster

Kober-Dehm

Previous instance:

Federal Patent Court, judgment of 4 October 2012 – 10 Ni 36/10 (EU) –