Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-12-15
Docket Number / Aktenzeichen:	X ZR 120/18
Name of Decision / Name der Entscheidung:	Nachrichtenübermittlungsdienst

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Arbeitskreis Patentgerichtswesen in Deutschland e.V.

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 120/18

Pronounced on:
15 December 2020
Anderer
Judicial Secretary
as Clerk of the
Court Registry

in the patent nullity proceedings

Nachrichtenübermittlungsdienst/
Messaging service

IntPatÜbkG Art. 2 Sec. 6(1) No. 4

The scope of protection of a patent, the granted version of which protects a process carried out on a mobile radio device in cooperation with a server, is not necessarily extended merely because the patent claim is supplemented in the nullity proceedings by a process step carried out on the server (supplement to Federal Court of Justice, judgment of 20 December 2018 - X ZR 56/17, GRUR 2019, 389 - Schaltungsanordnung III).

Federal Court of Justice, judgment of 15 December 2020 – X ZR 120/18 – Federal Patent Court

ECLI:DE:BGH:2020:151220UXZR120.18.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 27 October 2020, attended by the presiding judge Dr. Bacher, the judge Dr. Deichfuß, the judges Dr. Kober-Dehm and Dr. Marx, and the judge Dr. Rensen

ruled that:

On appeal by the defendant, the judgment of the 5th Senate (Nullity Senate) of the Federal Patent Court of 24 January 2018 is amended and the further appeal dismissed.

European patent 2 177 072 is declared partially null with the remainder of the action being dismissed in that claim 1 is replaced by the following, to which claims 1 to 16 refer back directly or indirectly, and claims 17 and 18 are omitted:

> A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network;
>
> the method comprising:
>
> the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wireless device (122), from an outgoing message on the sender's mobile wireless device (112);
>
> the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,
>
> wherein the step of verifying the destination address involves sending an address verification request to a message server;
>
> wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;
>
> upon receiving the address verification request, the message server (170) checks whether the destination

address is on a list of subscribing addresses, and checks whether the destination message queue length has not exceeded a predetermined maximum length;

in the event verification is affirmative, the sender's mobile wireless device then automatically sends the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;

but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

The defendant shall bear nine-tenths and the plaintiff one-tenth of the costs of the proceedings.

By operation of law

Facts of the case:

1 The defendant is the owner of European patent 2 177 072 (patent in suit), granted with effect for the Federal Republic of Germany, which was filed on 18 July 2008, claiming Australian priorities of 24 July 2007, and 13 November 2007, and relates to a messaging service in a wireless communications network. Claim 1, to which fifteen claims refer back, reads as follows after a limitation procedure:

> A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network; the method comprising:
> the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wireless device (122), from an outgoing message on the sender's mobile wireless device (112);
> the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer, wherein the step of verifying the destination address involves sending an address verification request to a message server;
> wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;
> in the event verification is affirmative, the sender's mobile wireless device then automatically sends the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;
> but otherwise, the sender's mobile wireless device automatically sends the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

2 Claims 17 and 18 protect, mutatis mutandis, a mobile radio device and a computer program product capable of carrying out such a method.

3 The plaintiff argued that the subject matter of the patent in suit did not involve an inventive step. The defendant defended the patent in suit as amended and, in the alternative, in five amended versions.

4 The Patent Court declared the patent in suit to be null. This is challenged by the defendant's appeal, which pursues its claims at first instance and submits five further auxiliary claims. The plaintiff opposes the appeal.

Grounds of the decision:

5 The admissible appeal is partly well founded.

6 I. The patent in suit relates to a messaging service in a wireless communications network.

7 1. The patent in suit states that the Short Messaging Service (SMS) is very popular but has the shortcoming that a message may not exceed 160 characters. Furthermore, a message must pass through several Short Messaging Service Centres (SMSC) or SMSC gateways if the recipient's network is operated by a different provider or uses different radio standards from the sender's network.

8 The Enhanced Messaging Service (EMS), which uses the SMS infrastructure, makes it possible to bundle up to 255 SMS messages into one EMS message, the content of which can be enriched with animations, images, sounds and formatted text.

9 Multimedia Messaging Service (MMS) could be used to send multimedia messages that could include pictures, audio clips and videos. Unlike SMS and EMS, MMS transmits messages via a packet-switched carrier. This would allow messages to be transmitted in unlimited sizes and at higher speeds.

10 Mobile instant messaging (MIM) technology would allow mobile devices to join real-time instant messaging over an IP data network. To do this, users would have to register with an instant messaging service provider with either a user name (tag) or an alias name (handle) in order to send and receive messages. In some cases, it is also required that the connection to the Internet is maintained at all times during a chat session.

11 2. The patent in suit does not specify the technical problem to which the invention relates.

12 Against this background, the technical problem can be seen in the provision of a procedure that enables the sending and receiving of messages with the help of different services as uncomplicatedly and inexpensively as

possible.

13 3. In order to solve this problem, the patent in suit, as amended by claim 1, proposes a method for providing a messaging service, the features of which can be divided as follows:

1.	Das Verfahren dient der Bereitstellung eines Nachrichtenübermittlungsdienstes auf einer Mobilfunkeinrichtung eines Senders in einem Funkkommunikationsnetzwerk und umfasst folgende Schritte:	A method for providing a messaging service on a sender's mobile wireless device in a wireless communications network; the method comprising:
2.	Die Mobilfunkeinrichtung (112) des Senders ruft eine mit der Mobilfunkeinrichtung (122) eines Empfängers assoziierte Zieladresse ab,	the sender's mobile wireless device (112) retrieving, a destination address associated with a recipient's mobile wireless device (122),
2.1	und zwar aus einer abgehenden Nachricht auf der Mobilfunkeinrichtung (112) des Senders.	from an outgoing message on the sender's mobile wireless device (112);

3.	Die Mobilfunkeinrichtung des Senders verifiziert, ob die Zieladresse die abgehende Nachricht über einen paketvermittelten Träger empfangen kann.	the sender's mobile wireless device verifying whether the destination address is capable of receiving the outgoing message via a packet-switched bearer,
3.1	Dieser Schritt beinhaltet, dass eine Adressverifikationsanforderung an den Nachrichtenserver (170) gesendet wird,	wherein the step of verifying the destination address involves sending an address verification request to the message server;
3.2	und zwar über eine Basisstation (180) und das Internet (160) unter Verwendung eines WPAN oder WLAN.	wherein the verification request is sent to the message server (170) via base station (180) and the Internet (160) using a WPAN or WLAN;
4.	Wird die Verifikation bestätigt, sendet die Mobilfunkeinrichtung des Senders die abgehende Nachricht automatisch über den paketvermittelten Träger an die Mobilfunkeinrichtung des Empfängers unter der Zieladresse.	in the event verification is affirmative, the sender's mobile wireless device then automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via the packet-switched bearer;
5.	Wird die Verifikation nicht bestätigt, sendet die Mobilfunkeinrichtung des Senders die abgehende Nachricht automatisch über einen SMS-Träger an die Mobilfunkeinrichtung des Empfängers unter der Zieladresse.	but otherwise, the sender's mobile wireless device automatically sending the outgoing message to the recipient's mobile wireless device at the destination address via an SMS bearer.

14 4. The objects protected by claims 17 and 18 have comparable features and are therefore subject to the same assessment as the subject matter of claim 1.

15 5. Some characteristics require further consideration.

16 a) A major advantage of the method is that a message can be sent via a packet-switched or an SMS carrier, depending on the circumstances.

17 According to feature 2, the basis is a destination address of an outgoing

message that is associated with a mobile radio device of the recipient. According to feature 3, a query is made on a message server to check whether this destination address can also receive the message via a packet-switched carrier. If this is the case, the transmission is packet-switched according to feature 4, otherwise via an SMS carrier according to feature 5.

18 b) The way in which the destination address is associated with the mobile radio device of the receiver is left to the skilled person.

19 According to the description of the patent in suit, it can be a mobile telephone number or a short numerical code which can stand for a telephone number, an e-mail address, the user name (user handle) in an IM system, an IP address or a combination of these. This should make it possible to identify all users with the help of their mobile phone number, so that the user - unlike with conventional MIM clients - would not have to register with a user name (user name, tag, handle) (para. 12).

20 c) The specification in feature 2.1 that the destination address is retrieved from an outgoing message on the sender's mobile radio equipment assumes that a message intended for transmission containing this address information has already been created.

21 aa) The structure of this message is not specified in claim 1.

22 Contrary to the appellant's view, no restrictions in this respect result from the statements in the description which describe the use of XML structures. These explanations merely describe an example of an embodiment and are not reflected in the patent claim.

23 The fact that the structure of the message has not yet been finally determined at the time the destination address is called up is also clear from the description of the execution example, the sequence of which is shown schematically in Figure 3 below.

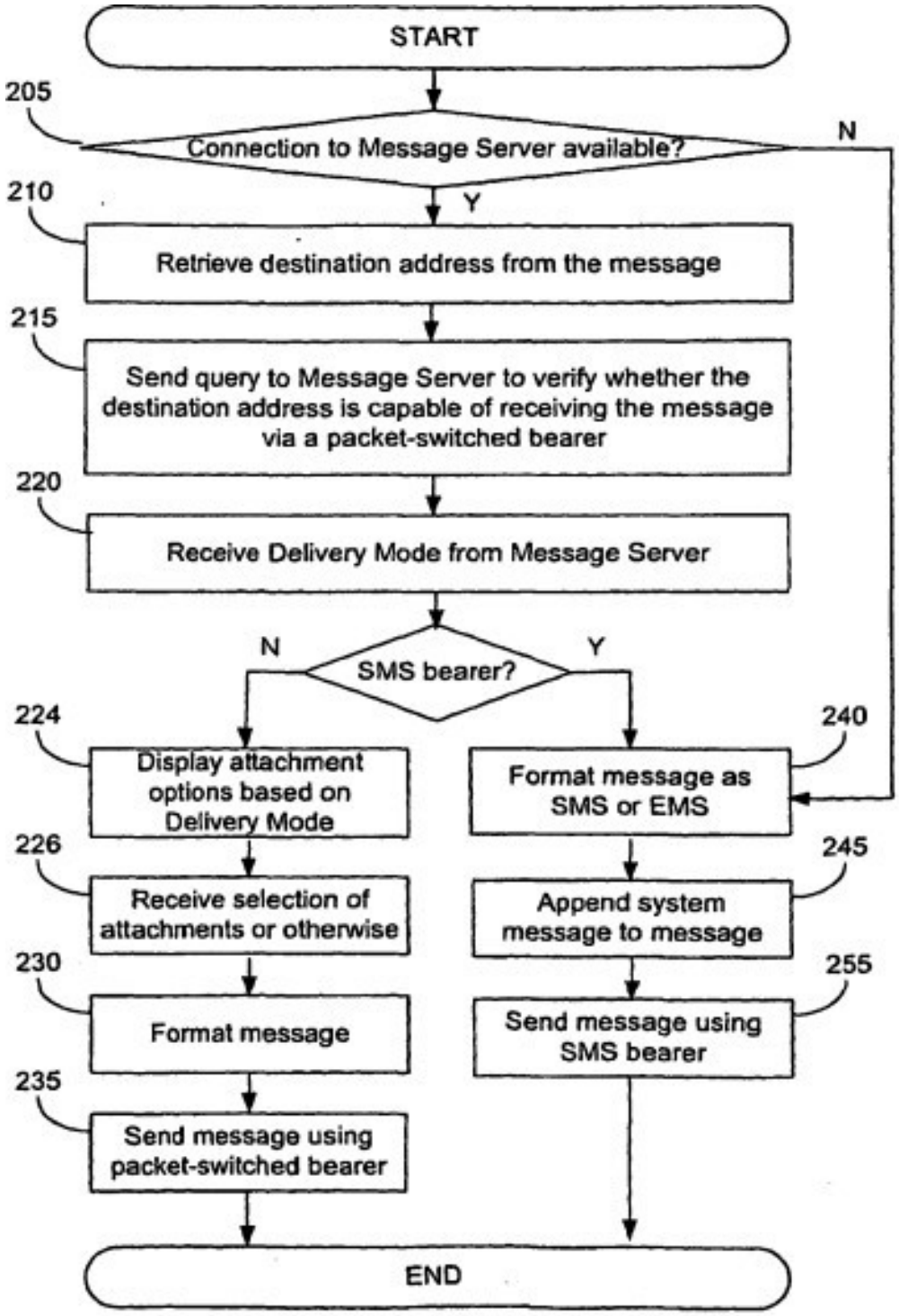

FIG. 3

24 After the system has received information about the possible dispatch route from the message server in step 220, the message is formatted for the respective carrier in steps 230 or 240. When sending via an SMS carrier, a system message is added in step 245 (par. 57). Both actions have an effect on the structure of the message. This means that the message does not

necessarily have the same structure at the time it is sent as it does when the destination address is retrieved.

25 bb) The example shown in Figure 3 also shows that the content of the message does not have to be known at the time the destination address is called up.

26 When sending via a packet-switched carrier, the user is given the option to add attachments prior to formatting at step 224 (para. 57). The provision of this option is expressly protected in claims 9 and 10. It can be seen from this that changes to the content of the message remain possible before it is sent.

27 Against this background, it cannot be inferred from patent claim 1 that the message must already have a certain minimum content at the time of retrieval of the destination address. It is true that in the example shown in Figure 3, the user must enter the text of the message before the specified time, while after that he only has the option of adding attachments. However, patent claim 1 does not make this distinction, but does not contain any requirements regarding the content of the message at this early stage.

28 cc) It can be concluded from this that it is sufficient if a basic structure is present which can be supplemented at a later stage of the procedure to form a message ready for dispatch. With regard to the content of this basic structure, only the minimum requirement that at least one indication must be present which enables the destination address to be queried results from feature 2.1.

29 d) In the light of the above, features 4 and 5 cannot be understood to mean that the transmission process is triggered immediately after completion of the verification process.

30 However, the wording of the two features, which provide that the outgoing message is automatically sent via a packet-switched or SMS carrier depending on the result of the verification process, could argue in favour of immediate sending without the possibility of modification. This interpretation, however, would be in contradiction with the description, which provides for a modification of the message between the verification process and the sending.

31 In the light of the description, features 4 and 5 must be interpreted as meaning that the term "automatic" refers only to the definition of the carrier and the use of that carrier after the user has initiated the transmission.

32 e) The verification provided for in feature 3 as to whether the destination address can receive an outgoing message via a packet-switched carrier may be limited to the question whether the recipient of the message can be reached at all via such a carrier. However, a limitation to this is not mandatory.

33 aa) Patent claim 1 does not contain any specifications with regard to the requirements which must be fulfilled in order that the suitability of the destination address for receiving the message via a packet-switched carrier can be affirmed. Therefore, it is basically left to the skilled person which criteria he defines in this respect.

34 bb) The general statements in the description of the patent in suit, according to which the method may comprise the step of queuing the outgoing message for later delivery (paragraph 31), do not give rise to a narrower understanding of the claim.

35 Claim 1 does not take up this feature, which is only optionally provided in the description. Accordingly, the subject matter of the patent is not limited to methods that can serve such a queue and do not make the sending via the packet-switched carrier dependent on the recipient being currently connected to the message server.

36 cc) The example of an embodiment described in the description does not give rise to a narrower understanding either.

37 In this embodiment, the message server first checks whether the destination address is listed in a subscriber directory. If this is the case, the server also checks whether the message queue of the recipient has exceeded a certain length. If one of the two checks is negative, the message server informs the recipient that an SMS carrier must be used (para. 55 f.).

38 This embodiment does indicate that a transmission can take place even

if the recipient is not connected to the message server. However, this requirement is not reflected in claim 1 either. The claim does not necessarily provide for a queue, nor does it contain any requirements as to the conditions under which transmission via a packet-switched medium is to be regarded as possible.

39 The understanding postulated by the appeal that the ability to receive the destination address must also be necessarily affirmed if the recipient is temporarily not ready to receive due to a lack of connection to the message server would also be in contradiction to the example described. In this case, the abstract possibility of transmission is not regarded as a sufficient criterion, but rather the length of the queue is used to additionally check whether a message can be expected to be received in the foreseeable future. This confirms the understanding already suggested by the wording that the skilled person is basically free to determine the criteria.

40 II. The Patent Court gave the following main reasons for its decision:

41 The subject matter of patent claim 1 as amended was suggested to the skilled person, a graduate engineer in electrical engineering specializing in communications engineering, who had practical experience in the design of messaging systems in the field of mobile and Internet communications and was familiar with the relevant standards, by Korean patent application 10 2006 0077401 (K4a) in conjunction with his skilled knowledge. K4a discloses an instant messaging (IM) method that combines an IM message transmission operating over the Internet, and thus packet-switched, with an SMS message transmission. This would provide a uniform interface for sending messages via both the IM service and the SMS, thus improving usability. The only difference between the method according to the invention and this method is that the verification request is made via WPAN or WLAN and not via a packet-switched service. This did not constitute an inventive step, since at the time of priority mobile radio devices with short-range radio interface (WLAN/WPAN) were ready for series production and thus known to the skilled person. For cost reasons, there was a reason for the skilled person to transmit the verification request via WLAN or WPAN, since the use of the packet-switched service via

the mobile network was very expensive at the time of priority. Contrary to the defendant's view, the user did not have to be registered with a service only in the K4a method in order to use the method. Also with the method according to the patent in suit, the user has to connect to a message server, for which he needs corresponding connection data. Only then could a verification request be sent to the message server and it be checked whether a user was entered in a subscriber directory and thus registered. The fact that a cell phone number is sufficient as an identifier in the method according to the invention does not mean that registration is not required. Rather, the user is registered with this telephone number. The fact that in the method according to K4a the receiving device must necessarily be online, whereas in the method according to the invention the basic suitability of the receiving device to receive a message via a packet-switched carrier is sufficient, does not lead to a different assessment. This test is not part of the claimed method. Patent claim 1 also covers the case that the receiving device is online at the time of the verification query.

42 The additional feature provided according to auxiliary claim 1' in patent claim 1 as amended, that the message sender checks whether the destination address is on a subscriber list after receipt of the verification request, is obvious to the skilled person from K4a in connection with his expertise. The IM server, which provides the instant messaging service in the method according to K4a, manages the status and the reception mode of the respective user as well as the message reception list and the environment information of the subscribed users. This corresponds to a subscriber address list within the meaning of the feature added by auxiliary request 1' and suggests the verification provided for by that feature.

43 The additional features provided according to auxiliary request 2' compared to the valid version of patent claim 1 are also suggested to the skilled person by K4a. Sending a packet-switched message using a WiFi protocol is an everyday implementation variant for the skilled person. If he had already considered sending the verification request via WLAN for cost reasons, it would be obvious to him to also send the packet-switched message via WLAN and thus in accordance with the WiFi protocol on the data link layer.

44 The subject matter defended by auxiliary request 3' was suggested to the skilled person by international application 01/414777 (K16). This citation disclosed an instant messaging system which used telephone numbers as addresses. It was therefore obvious to the skilled person to also use telephone numbers as destination addresses in the method according to K4a, since it was part of the state of the art at the time of priority to provide a single telephone number as an address for a large number of services.

45 The subject matter defended by auxiliary request 4' was not based on inventive step for the same reasons as the versions defended by the main request and auxiliary request 3'.

46 The defence of the patent in suit in the version of auxiliary request 5' is inadmissible, since the subject matter of patent claim 1 in this version goes beyond the content of the documents originally filed. According to the feature added by this version of the application, the verification server checks, after receipt of the verification request, whether the queue of messages at the destination address has not exceeded a predetermined maximum length. However, in contrast to the embodiments described in the original documents, patent claim 1 does not contain any provision on the consequences of the check to be carried out according to the added feature with regard to the selection of the carrier to be used for the transmission of the message and the corresponding feedback to the transmitting mobile radio device.

47 III. This assessment withstands review on appeal with respect to the version of the patent in suit in force and with respect to the versions defended by auxiliary requests 1', 2', 3' and 4', which the defendant again submitted for decision on appeal as auxiliary requests 1, 2, 3 and 9.

48 1. Whether the subject matter of claim 1 in the current version was suggested to the skilled person by K4a can be left open. In any case, it is suggested to the skilled person by the publication of the international patent application WO 2004/061583 (K5).

49 a) K5 concerns a method and a device for supporting wireless communication (messaging).

50 The citation deals with the problem of incompatibility of different transmission standards such as SMS and MMS (para. 2). K5 sees the fact that the sender can only determine the incompatibility after the message has been sent as particularly disadvantageous (para. 4).

51 To remedy this, K5 proposes to query which type of message format the receiving device is capable of receiving before sending a message (para. 23).

52 aa) Figure 2 of K5 reproduced below shows several examples of embodiments:

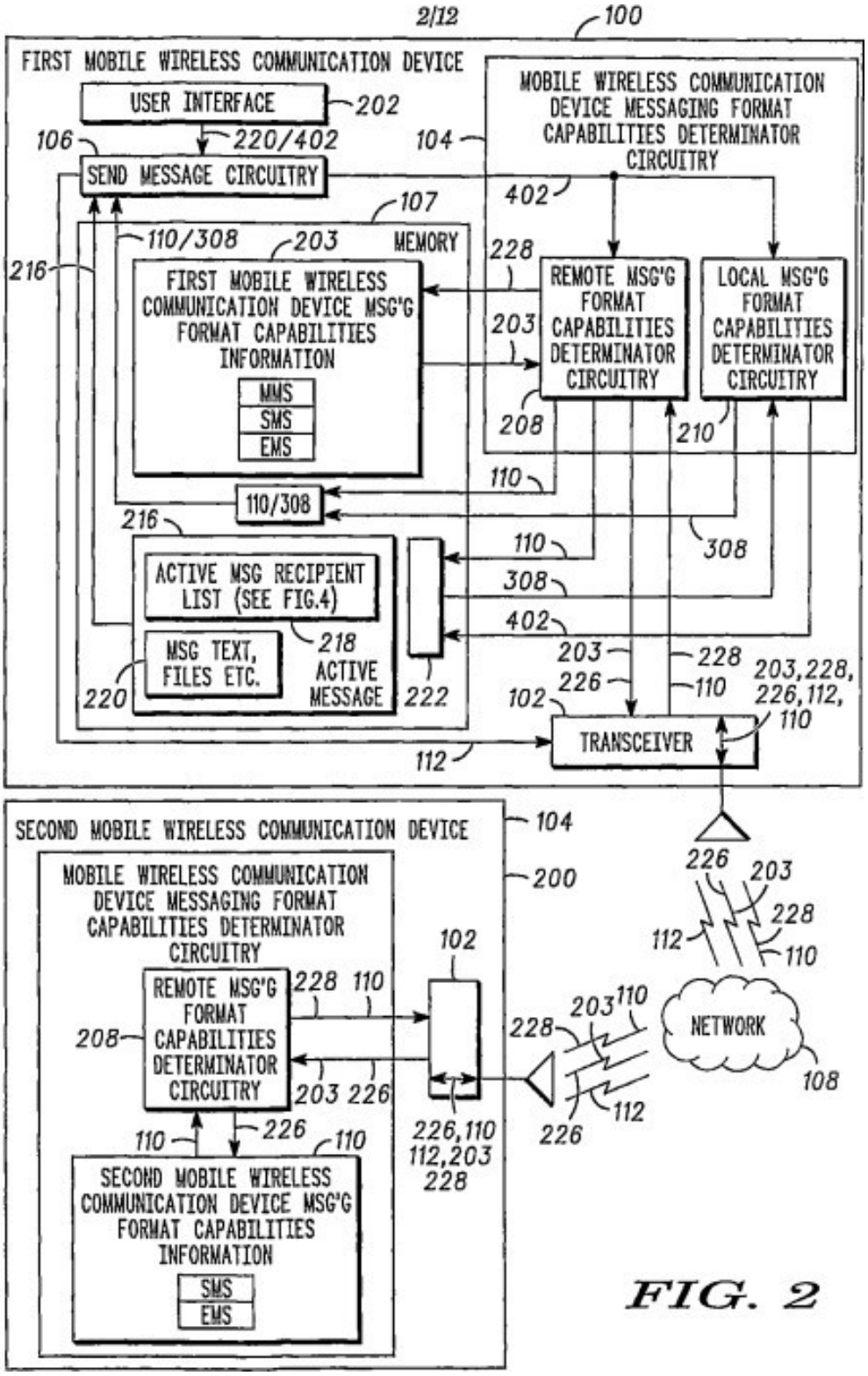

FIG. 2

53 bb) The mobile radio device (100) proposed in K5 communicates with the network (108) by means of a special circuit (104) to request information about which message transmission formats the mobile radio device of the receiver can process. This information is stored in the mobile device (100) and associated with the receiver's device (para. 25).

54 However, the information about which messaging formats are supported by the recipient's mobile device does not necessarily have to be stored (only) in the recipient's mobile device. In an alternative embodiment of K5, the information about the message delivery formats supported by the recipient's device may also be stored in an address book associated with the sender's mobile radio device (para. 64). In a further embodiment of K5, such information on capacities of the recipient device may also be stored elsewhere, for example in a network device such as a web server or other server in which details of the supported messaging formats for various devices may be stored (para 39).

55 cc) A circuit (106) is used to send the message in a supported format (par. 25).

56 In one of the embodiments disclosed in K5, the user can decide whether to send the message at all depending on the message formats supported by the recipient's mobile device. Thus, he can abort the transmission if it is determined that the recipient device does not support the message format selected by the sender (paras. 26 and 33).

57 In an alternative embodiment, as the sender enters the current message, the sender's mobile device contacts the network to connect to the recipient's address (e.g., MSISDN) and its Home Location Register (HLR) to determine whether the address is capable of receiving a message in MMS format. If this is the case, the appropriately formatted message is transmitted to the recipient's mobile device. If, on the other hand, the MMS format is not supported by the recipient's mobile device, the mobile device informs the sender of this and suggests that the message be formatted as an SMS message and sent, noting that attached multimedia files will be lost. The user can then decide whether to send the message via SMS or MMS or to cancel the sending process (par. 61-62).

58 b) Thus, as the appeal also does not doubt, characteristics 1, 2, 2.1, 3 and 3.1 are disclosed.

59 c) Contrary to the view of the appeal, characteristic 4 is also open-

60 If the recipient's mobile device supports a messaging format supported by the sender's mobile device, the message is sent in that format. If the format supported by both devices is a packet-switched bearer, the message is accordingly also sent via such a bearer (paragraphs 25 and 61).

61 d) By contrast, feature 3.2 is not disclosed, as the plaintiff does not dispute.

62 e) Contrary to the plaintiff’s view, feature 5 is also not disclosed.

63 The procedure according to K5, in the case that the mobile device of the recipient is not able to receive messages via a packet-switched carrier (MMS messages in the described embodiment), does not automatically determine that the message is sent via an SMS carrier, but offers the sender the choice between transmission as an SMS or MMS message or aborting the transmission process (par. 26 and 62).

64 f) The subject matter of claim 1 was suggested to the skilled person on the basis of K5.

65 aa) Based on K5, the skilled person had reason to check whether the destination address can receive messages via a packet-switched carrier, either via WPAN or WLAN.

66 K5 deals with devices that master different standards. This suggested to the skilled person that the K5 solution should also be considered for devices that not only have mobile radio but also WPAN or WLAN functions. For such devices, it made sense to use the generally more cost-effective WPAN or WLAN for packet-switched communication, provided that the respective device is capable of this and a corresponding network is available.

67 The appeal's objection that technical difficulties and aspects of system security would have prevented the skilled person from sending the address verification request using a WPAN or WLAN because mobile network operators have secured their networks against external interference by third parties and special authorisation is required to access the mobile network from the WPAN or WLAN is not valid. Contrary to the view of the appeal, an

address verification request in the sense of feature 3.1 cannot be considered for the system disclosed in K5 only in the form of a query to the Home Location Register (HLR) of the mobile network. As already explained above, according to the description of K5, the required information can also be stored on a web server (para. 39). At least with this variant, the technical difficulties and security concerns pointed out by the appeal did not stand in the way of an address verification request via WPAN or WLAN.

68 bb) Whether the user is given the opportunity to cancel the transmission process if it turns out that the transmission can only take place on the SMS carrier is a question of the appropriate design in the individual case. Thus, K5 provides that the proposed method in the individual embodiments described can optionally be designed either with or without user prompts (paragraph 55). Against this background, a design of the method with which the selection between an SMS carrier and a packet-switched carrier is made automatically depending on the existence of the respective applicable requirements cannot lead to the affirmation of inventive step.

69 2. The patent in suit does not prove to be legally valid in the versions of auxiliary claims 1 to 9 either.

70 a) The subject matter of claim 1 according to auxiliary request 1 (at first instance: auxiliary request 1') is not based on inventive step.

71 aa) According to auxiliary request 1, claims 17 and 18 are to be deleted. In claim 1 the following additional feature is provided:

3.3	Der Nachrichtenserver (170) prüft nach Erhalt der Verifikationsanforderung, ob die Zieladresse auf einer Teilnehmerliste steht.	Upon receiving the address verification request, the message server (170) checks whether the destination address is on a list of subscribing addresses.

72 bb) Whether the subject matter thus defended is disclosed in the documents originally filed as belonging to the invention can be left open. In any case, it was suggested to the skilled person by K5. The method proposed in K5 also provides, in the above-mentioned example of an embodiment, for

checking the availability of a subscriber on the basis of a subscriber list (paras. 33, 39).

73 b) The subject matter of claim 1 defended by auxiliary request 2 (at first instance: auxiliary request 2') is also not based on inventive step.

74 aa) According to auxiliary request 2, the following additional features are provided compared to the version according to the main request, whereby patent claim 17 is to refer back to the amended version of patent claim 1 and patent claim 18 is to be adapted accordingly:

3.3	Die Verifikationsanforderung schließt die Verifikation ein, dass die Zieladresse auf einer Teilnehmerliste steht.	The verification request involves verifying whether the destination address is on a subscriber list.
4.1	Ein WiFi-Protokoll wird zur drahtlosen Kommunikation auf der Sicherungsschicht verwendet, um die abgehende Nachricht von der Mobilfunkeinrichtung des Senders (112) an das drahtlose Kommunikationsnetzwerk zu übermitteln.	A WiFi wireless protocol is used in a data link layer to deliver the outgoing message from the sender's mobile wireless device (112) to the wireless communications network.

75 bb) Characteristic 3.3 corresponds in substance to characteristic 3.3 under auxiliary request 1 and is not subject to a different assessment.

76 cc) Feature 4.1 cannot establish patentability even in combination with this feature.

77 As the Patent Court rightly pointed out, sending a message using a WiFi protocol is an obvious measure for the skilled person. If WiFi, i.e. a WLAN network, is available, it is obvious to send not only the verification request but also the message itself via it.

78 Contrary to the view of the appeal, there were no obstacles to the transmission of MMS via a WLAN at the priority date which would have prevented the skilled person from finding such a solution. The difficulties identified by the appeal in determining the IP address of a recipient device in the WLAN are irrelevant if only because, as the plaintiff rightly points out,

feature 4.1 concerns only the sending of the message from the sender to the wireless communications network and not the receipt of the message.

79 c) The subject matter of claim 1 defended by auxiliary request 3 (at first instance: auxiliary request 3') is also not patentable.

80 aa) According to auxiliary request 3, the following additional features are provided compared to the version according to the main request, whereby patent claim 17 is to refer back to the amended version of patent claim 1 and patent claim 18 is to be adapted accordingly:

2.2	Die Zieladresse ist eine Mobiltelefonnummer.	The destination address is a mobile phone number.
4.1	Ein WiFi-Protokoll wird zur drahtlosen Kommunikation auf der Sicherungsschicht verwendet, um die abgehende Nachricht von der Mobilfunkeinrichtung des Senders (112) an das drahtlose Kommunikationsnetzwerk zu übermitteln.	A WiFi wireless protocol is used in a data link layer to deliver the outgoing message from the sender's mobile wireless device (112) to the wireless communications network.
5.1	Die abgehende Nachricht wird zu einem Kernnetzwerk (140) gesendet.	The outgoing message is sent to a core network (140).

81 bb) The use of a mobile telephone number as the destination address, as provided for in the newly added feature 2.2, was suggested to the skilled person by K16, as the Patent Court correctly assumed.

82 This citation discloses an instant messenger system and method for transmitting instant messages that allow a sender to send an instant message to a recipient when the sender knows only the recipient's mobile phone number, but not the recipient's instant messenger address.

83 cc) With regard to characteristic 4.1, the same applies as to auxiliary request 2, which also provides for this characteristic.

84 dd) According to the unchallenged findings of the Patent Court, an SMS message according to the GSM standard is always sent to the core

network due to the system. These findings support the conclusion drawn by the Patent Court that feature 5.1 is a matter of course for the skilled person.

85 d) The auxiliary requests 4 to 8, which were filed for the first time in the appeal proceedings, are not to be taken into consideration pursuant to Sec. 116(2) and Sec. 117 sentence 1 Patent Act and Sec. 531(2) Code of Civil Procedure, because they are not relevant and the plaintiff did not agree to them.

86 The Patent Court already indicated in the reference issued under Sec. 83(1) Patent Act that the subject matter of claims 1, 17 and 18 is not likely to be inventive with regard to K4a, but also on the basis of K5. The defendant therefore had cause to file these auxiliary requests, which serve to further delimit the aforementioned citations, already at first instance (cf. Federal Court of Justice, judgment of 15 December 2015 - X ZR 111/13, GRUR 2016, 365 marginal no. 26 - Telekommunikationsverbindung).

87 e) The subject matter of claim 1 defended by auxiliary request 9 (at first instance: auxiliary request 4') is also not based on inventive step.

88 aa) According to auxiliary request 9, claims 17 and 18 are to be deleted. In claim 1, the following additional features are provided compared to the version according to the main request:

1.1	Die Mobilfunkeinrichtung des Senders ist verbunden mit	the sender's mobile wireless device being connected to
1.1.1	dem Kernnetzwerk (140) und	a core network (140) and
1.1.2	einem zweiten Netzwerk, das von einem unabhängigen Internet-Service-Provider bereitgestellt wird, das dem Mobilfunkgerät des Senders erlaubt, über WLAN oder WPAN auf das Internet (160) zuzugreifen.	a second network provided by an independent mobile Internet service provider allowing the sender's mobile wireless device to access the Internet (160) using a WPAN or WLAN.
2.2	Die Zieladresse ist eine Mobiltelefonnummer.	The destination address is a mobile phone number.

89 The following changes are also envisaged:

90 Feature 3.1 is to be supplemented to the effect that the address verification request is sent to the message server over the second network.

91 In characteristic 3.2, the words "the wireless Internet" should be inserted before the words "base station".

92 Feature 4 is to be amended to state that the outgoing message is sent by the message server via WLAN or WPAN over the second network.

93 Finally, feature 5 is to be supplemented to the effect that the outgoing message is sent via the core network (140; over the core network) to the mobile radio equipment of the recipient.

94 bb) With regard to characteristic 2.2 and the addition of characteristic 5, the comments on auxiliary request 3 apply mutatis mutandis.

95 cc) The other newly added or supplemented features relate to the transmission of the verification request and the outgoing message via WLAN or WPAN. In this respect, the comments on the current version and on auxiliary request 2 apply accordingly.

96 IV. On the other hand, the patent in suit - contrary to what the Patent Court assumed - is valid in the version of auxiliary request 10 (at first instance: auxiliary request 5').

97 1. According to auxiliary request 10, claims 17 and 18 are to be deleted. In claim 1, the following additional feature is provided compared to the version according to auxiliary request 1:

3.4	Der Nachrichtenserver (170) prüft nach Erhalt der Verifikationsanforderung, ob die Warteschlange der Nachrichten an der Zieladresse eine vorher festgelegte maximale Länge nicht überschritten hat.	upon receiving the address verification request, the message server (170) checks whether the destination message queue length has not exceeded a predetermined maximum length.

98 2. Contrary to the view of the Patent Court, the subject matter thus disclosed is sufficiently apparent from the documents originally filed.

99 It is not necessary to determine whether the notification establishes a link between the result of the two checks provided for in characteristics 3.3 and 3.4 and the automatic selection of a carrier.

100 Contrary to the view of the Patent Court, such a connection also results from the version of the patent claim defended by auxiliary request 10, and in any case from the interaction of the two features mentioned with features 4 and 5, which expressly provide for automatic selection of a carrier. A confirmed verification within the meaning of feature 4 is only present if both checks provided for in features 3.3 and 3.4 have produced a positive result.

101 3. Contrary to the plaintiff's view, auxiliary claim 10 is also not directed at extending the scope of protection.

102 a) According to the case law of the Senate, the subsequent inclusion in a claim of subject matter which is not protected by the patent in suit in the granted version leads to an extension of the scope of protection.

103 Patent nullity proceedings do give the patent proprietor the opportunity to defend the IP right in a limited form. However, it does not serve to shape the patent beyond that. Therefore, a patent claim may not be amended in nullity proceedings to include subject matter not covered by the granted version (Federal Court of Justice, judgement of 20 December 2018 - X ZR 56/17, GRUR 2019, 389 marginal no. 33 - Schaltungsanordnung III; judgment of 14 September 2004 - X ZR 149/01, GRUR 2005, 145, 146 - Electronic Module).

104 b) In the case in dispute, the insertion of feature 3.4 does not result in the patent claim being directed to subject matter not covered by the current version.

105 Contrary to the plaintiff's view, the subject matter of patent claim 1 is already in its current version not limited to a method that is executed solely on the mobile radio device. On the contrary, patent claim 1 already in the applicable version presupposes that a message server is present and that this server answers a verification request.

106 It is true that the current version does not contain any specifications as

to which criteria must be fulfilled in order for the message server to respond to the request with "affirmative". However, in the case of a dispute, the specification of such criteria is tantamount to a concretisation of the request addressed to the server. In substance, the insertion of feature 3.4 means that the server is no longer asked to provide information as to whether the specified recipient can be reached at all by a particular means of communication, but to provide information as to whether the recipient can probably be reached without complications. Compared to the subject matter of the current version, this is merely a concretisation of the procedure that the mobile radio device carries out in cooperation with the server.

107 4. The new feature 3.4 added by auxiliary claim 10 is not suggested to the skilled person by any of the citations in the proceedings.

108 a) In particular, contrary to the plaintiff’s view, the technical specification 3G TS 22.140 version 0.1.0 (K21) did not suggest to the skilled person that carrier selection should be made dependent on exceeding a certain message queue length at the receiving end.

109 K21 merely states that messages are queued if the recipient's mobile device cannot be reached by the network, and that a controlled delivery mechanism is required as soon as reachability is restored (Section 5.2, p. 8 under "Message queuing"). This does not suggest that the selection of the carrier used for sending a message should already depend on the length of the queue.

110 b) The plaintiff’s argument, which is not specified in more detail and is disputed by the defendant, that measuring the length of the queue was already a customary and obvious means of checking the availability of the recipient in the state of the art, is not capable of leading to a different assessment.

111 The plaintiff has neither submitted any citations nor shown any other concrete circumstances from which the customary or obvious nature of this approach can be inferred. On this basis, patentability cannot be denied.

112 V. The decision on costs is based on Sec. 121(2) Patent Act in conjunction with Sec. 92(1) Code of Civil Procedure.

Bacher Deichfuß Kober-Dehm

Marx Rensen

Previous instance:
Federal Patent Court, judgment of 24 January 2018 - 5 Ni 22/16 (EP) -.