

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2014-03-11
Docket Number / Aktenzeichen:	X ZR 139/10
Name of Decision / Name der Entscheidung:	Farbversorgungssystem



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 139/10

Pronounced on:
11 March 2014
Beširović
Judicial secretary
as clerk of the
Court registry

in the patent nullity proceedings

Farbversorgungssystem/
Paint supply system

EPC Art. 56

If a mechanical engineering solution, as a general means to be considered for a multitude of applications, is part of the general technical knowledge of the engineer addressed, there may be reason to consult it if the use of its functionality in the context to be assessed is objectively appropriate and no special circumstances can be identified which, from a technical point of view, make its use appear impossible, associated with difficulties or otherwise impractical.

Federal Court of Justice, judgment of 11 March 2014 - X ZR 139/10 - Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing of 11 March 2014, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Hoffmann, Schuster, Dr. Deichfuß and Dr. Kober-Dehm

ruled that:

The appeal against the judgment of the 4th Senate (Nullity Senate) of the Federal Patent Court, which was, instead of being pronounced, delivered on 8 November 2010, is dismissed at the expense of the Defendant.

By operation of law

Facts of the case:

1 The defendant is the proprietor of European Patent 796 665 (patent in dispute), granted with effect in the Federal Republic of Germany, which was filed on 18 March 1997, claiming priority from 18 March 1996. Claim 1, to which claims 2 to 10 are subordinated, is worded as follows

"Process for supplying paint to a coating plant for the serial coating of workpieces, in particular vehicle bodies,

whereby containers (2, 42) removably mountable on or connectable to a spraying device are provided or filled with coating material of selectable color at a filling location (4) while disconnected and separated from the spraying device,

whereby the containers are transported from the filling point to a transition point(10) distant therefrom, from where they are subsequently fed to the spraying device,

and whereby the containers are returned to the transition point after use and from there are transported back to the filling point".

2 Claim 11, to which Claims 12 to 41 are subordinated, relates to a device (a system) for carrying out the process according to Claim 1.

3 The plaintiff has claimed that the subject matter of the patent in dispute is not patentable. The Patent Court declared the patent in dispute null (judgment of 8 November 2010 - 4 Ni 101/08 [EU], BeckRS 2010, 28367). With its appeal, the defendant continues to pursue its objective of a dismissal of the action, alternatively it defends the patent in dispute with its first auxiliary request by deleting the words "provided or" in claims 1 and 11 and with its second auxiliary request by adding features from claims 15 and 27 in claims 1 and 11.

4 As court expert, Prof. Dr.-Ing. J. D. , University E. , issued a written opinion, which he explained and supplemented during the oral proceedings.

Grounds of the decision:

5 I. The patent in suit concerns a process and a system of devices for supplying paint to a coating plant for the serial coating of workpieces.

6 1. Spraying devices for coating workpieces, in particular vehicle bodies, are supplied with paint either directly from pipes or from a container located near the spraying device. Electrostatic application systems are also particularly suitable for coating, although electrically conductive coating materials may cause problems if the material is connected directly to the spraying device via hoses. The system described as state of the art in the patent in suit with reference to European patent specification 274 322 avoids such problems by the fact that the spraying device with exchangeable paint containers in a spray booth is carried by a painting robot and that there are taps in the spray booth from which the painting robot collects the paint containers filled with paint as required. The patent specification criticizes the fact that the robot has to carry out elaborately controlled movements for coupling the containers to the tapping points (para. 2).

7 According to the patent in suit, it was also known as state of the art to supply a painting robot with exchangeable containers that could be mounted on the robot arm with the quantity of paint required for a vehicle body by transporting filled containers one after the other on a conveyor belt to a transition point, where they are removed by an auxiliary robot and passed to the painting robot (para. 3).

8 2. Against this background, the subject-matter of the patent in suit is based on the problem of keeping losses as low as possible when filling the paint containers, of making the coating process in total as free of delay as possible and preferably with as little control effort as possible.

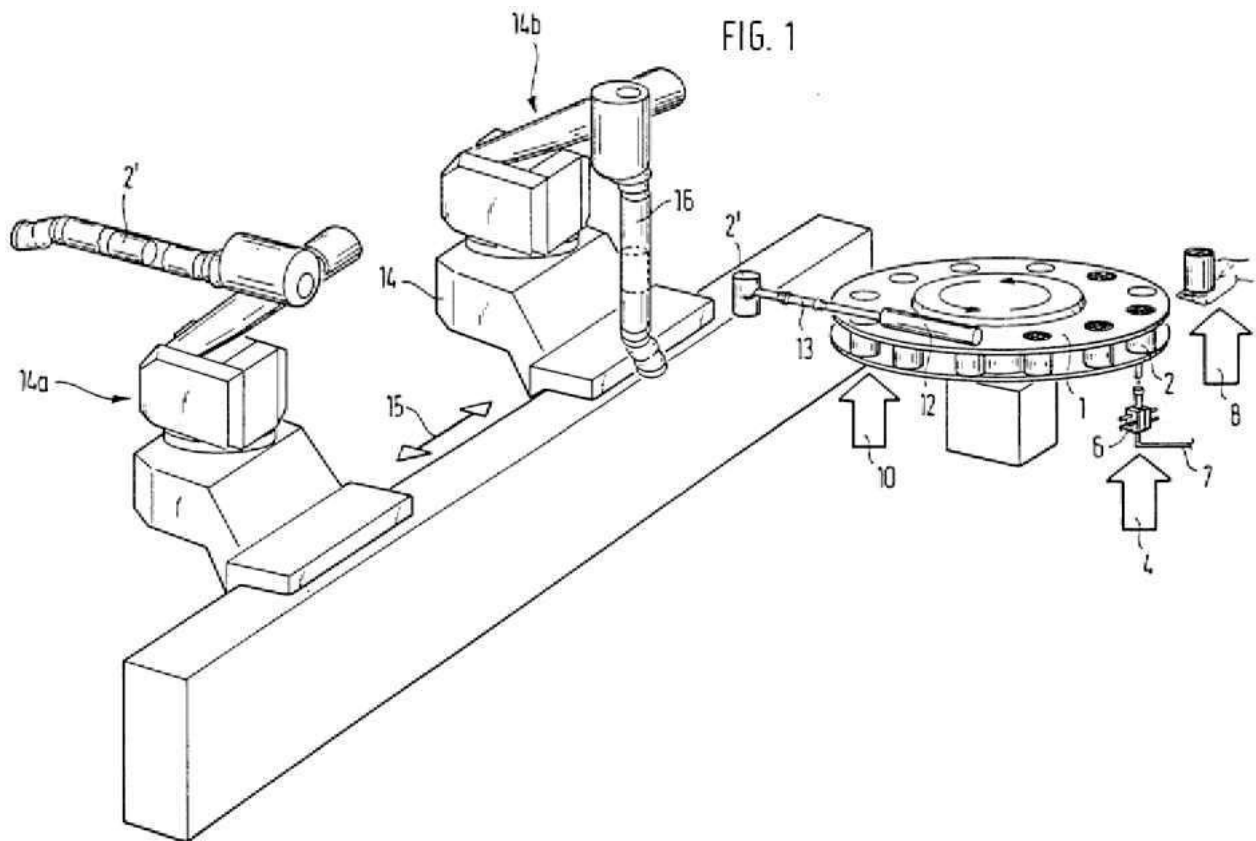
9 To solve this problem, claim 1 in the granted version as well as according to the two auxiliary requests proposes a process whose features can be divided - essentially with the Patent Court - as follows (words crossed out are only in the granted version, *features in italics are only in the version according to auxiliary request II*):

- 1 The process serves to supply paint to a system for series coating of workpieces.
2. Containers (2, 42) are provided which can be exchangeably mounted on or connected to a spraying device, which

- 2.1 - decoupled and separated from the spraying device - ~~are provided~~
or filled at a filling point (4) with coating material of a selectable color,
 - 2.2 are transported from the filling station to a transition point (10) distant
from it,
 - 2.3 are then supplied to the spraying device from the transition point
(10),
 - 2.4 are returned to the transition point after use and
 - 2.5 are transported back from the transition point to the filling point.
- 3. A device supplies the containers at the filling point to a device, fed by at
least one supply line and is capable of holding at least two containers at the
same time.
 - 4. A linear movement device connects the container at the filling point along a
straight track to the device fed by at least one supply device.

10 Claim 11 is directed to a paint supply system, the features of which
essentially correspond to the features of claim 1; the transport function is fulfilled
by a transport device, with which the containers are transportable from a filling point
(4) to a transition point distant from the filling point (cf. feature 2.2), from where the
selected container is supplied to the spraying device (cf. feature 2.3) and is
transported back to the filling point after use (cf. feature 2.5), whereby the
containers are separated from the supply devices during the removal of material
during the coating process and are separated and removed from the spraying
device during filling (cf feature 2.1).

11 An example of an embodiment of the patented subject matter is shown in
Figure 1 of the patent in suit below:



12 3. Two features require a brief explanation:

13 a) The filling point (features 2.1, 2.2 and 2.5) in claims 1 and 11 in the version according to the patent granted does not necessarily indicate the point where the containers are filled with paint. Rather, it refers to the point from which the transport device transports a (re)filled container, whether the container is filled with paint at this point or whether the container was only picked up by the transport device there after it was filled at another point and brought to this filling point in another way. The process described in claim 1 expresses such an equipping with already filled containers (para. 11 aE and figure 1) in feature 1.2 with the alternative of (merely) providing the containers. Claims 1 and 11 leave open how the actual filling of the paint containers takes place; it can also be done manually (para. 41).

14 b) The patent in suit also leaves open the design of the transport device, which provides for the transport of the containers from the filling point to the transition point and back (features 2.2 and 2.5). For example, a rotating magazine is described and shown in figure 1; figure 4 shows a belt or chain conveyor (para.

32). The description explains that the transport "in special cases can also be carried out manually, if necessary on the trolley shown in figure 5" (para. 37 aE), which in turn can also be loaded manually (para. 41).

15 II. The Patent Court considered the subject-matter of the patent in suit to be unpatentable because it was not based on an inventive step and justified this as follows:

16 From the Japanese published patent application Sho 60-1220773 (Annex K3 - submitted in a German translation), a process for supplying paint to a coating plant was known which was intended for serial coating (feature 1). Similar to the patent in suit, K3 was aimed at the creation of a paint supply system that would enable the economical use of both paint and thinner and a reduction in the time required to change paint. For this purpose, instead of long hoses, K3 uses a paint material container that can be detachably mounted on the arm of the painting robot behind the spray gun (feature 2).

17 In order to avoid long supply hoses, K3 suggests that a device for supplying paint material containers be arranged outside the painting area, which, according to the design example shown, is composed of a conveyor system for several containers, namely a belt or chain conveyor (feature 2.2) and a robot for changing containers. The robot is designed to grip the container filled with the predetermined paint material and to attach it to the arm of the painting robot (feature 2.3); according to feature 2.1, the containers are separated from the sprayer when filled with a selectable color.

18 According to the other versions of K3, the container changing robot should remove the container from the robot arm and return it to the conveyor. Consequently, the containers would be returned to the transition point after use according to features 2.4 and 2.5 and transported back from there.

19 A filling station for filling or providing the containers with coating material and the supply devices for coating material of different colors mentioned in claim 11 are not expressly described in the execution examples of K3. However, a

corresponding design was obvious for the person skilled in the art, a graduate engineer (FH) in the field of mechanical engineering with special knowledge and experience in the field of material coating, in particular by means of spraying devices and electrostatic application methods. K3 mentioned color change valves, which make it possible to selectively feed several paint materials of different colors to the spray gun, as the background to the invention described there. Without a supply device, no paint material could reach such valves. This argues for the fact that there is also a filling point for the containers in order to be able to fill them with coating material of a selectable color. Furthermore, such a filling point was suggested by the indication in the description of K3 that the container only had to be filled with the quantity of paint required for a bodywork if coating objects of the same shape, such as vehicle bodies, were to be coated with different layers of paint one after the other, alternating accordingly.

20 The design according to the further characteristics of the sub-claims had also been obvious to the skilled person.

21 III. This holds up to a review in the appeal proceedings. The subject-matter of the patent in dispute is not patentable either in the granted version of the patent in dispute or in the version of one of the two auxiliary requests.

22 1. The technical teaching of claims 1 and 11, both in the granted version and in the amended version according to auxiliary request I, is not based on an inventive step. In this respect, reference may be made to the correct and detailed grounds of the appealed judgment and the statements in the written opinion of the court expert; the defendant as well no longer doubted at the end of the oral hearing that in a process for supplying paint to a coating installation, as disclosed in the K3 citation referred to by the Patent Court, the skilled person would obviously have provided a filling point where the containers are filled with coating material of a selectable color and are transported from there to the painting installations by means of a transport device.

23 2. Claims 1 and 11 also do not prove to be legally valid in their version according to auxiliary claim II, which admissibly includes restrictive features from subclaims 15 and 27 in the two main claims.

24 a) Feature 3 substantiates the process according to patent claim 1 and a device according to patent claim 11 in such a way that the device used for feeding the containers to or from the filling point to a device fed by at least one supply line (paint supply device) can simultaneously hold two containers. Such a course of action was also suggested to the skilled person, which was correctly defined by the Patent Court.

25 To what extent and with what degree of concretization the skilled person requires suggestions in the state of the art in order to further develop a known solution in a certain way is a question of the individual case according to the case law of the Federal Court of Justice. The answer to which requires an overall consideration of all relevant elements of the facts. Hereby, not only explicit references to the skilled person are relevant. Rather, peculiarities of the technical field in question may also play a role, in particular with regard to the training of skilled persons, the usual procedure for the development of innovations, technical needs arising from the construction or application of the object in question and also non-technical specifications (Federal Court of Justice, GRUR 2012, 378 = BIPMZ 2012, 260 - installation device II (Installierungseinrichtung II)).

26 Therefore, the assumption that the skilled person had reason to proceed in accordance with characteristic 3 when designing a plant for the serial coating of workpieces does not necessarily oppose to the fact that the plaintiff has not been able to show a model for this in the field of coating plants. If a mechanical engineering solution as a general means to be considered for a multitude of applications is part of the general technical knowledge of the engineer addressed, there may rather already be reason to use it if the use of its functionality in the context to be assessed is objectively expedient and no special circumstances can be identified which make its use appear impossible, difficult or otherwise infeasible from a technical point of view (cf. on standard medical measures Federal Court of Justice, GRUR 2014, 461 para. 38 - Collagenase I).

27 This is the situation here. According to the statements made by the court expert in his written expert opinion (p. 28) and at his hearing, it is established to the conviction of the Senate that the parallel feeding of two containers to the paint supply device as well as the feeding of a filled container to the transport device in one process together with the feeding of an empty container to the paint supply device concerns a process which was known to the skilled person by the basic idea as a means of making a handling process or system more efficient and thus objectively more expedient and optimizing it by this way. The parallel handling of two objects instead of one is thus part of the general technical knowledge of the engineer appointed here in the sense of a "standard repertoire", which he can regularly draw on and has cause to draw on in the further development of existing systems, in particular when he needs to carry out processes that are as effective, efficient and time-saving as possible.

28 This statement is supported by the citations of the plaintiff, which, in particular in the US patent specification 3 242 568 (Annex E6) - there especially in Figures 7 to 21 - but also in the German publication 1 652 699 (Annex E 5) - there Figures 12 to 12F - and the international patent application 91/18135 (Annex E4)- there Figures 6 and 14 - prove a parallel handling of the simultaneous removal and feeding of objects. At the same time, they show that such a design of an automated process was generally known to the skilled person as an objectively expedient time optimization of handling processes in mechanical engineering, without being relevant whether the skilled person would use the relevant objects, which lie outside the technical field of the patent in dispute, for concrete considerations on a further development of a paint coating system, in particular for vehicle bodies.

29 Since circumstances which made it impossible, difficult or otherwise infeasible to hold two containers in parallel when feeding them to the paint supply system were neither evident nor presented by the defendant, and since the patent at issue does not contain any indications to overcome such problems, it is not objectionable that the Patent Court has affirmed a reason for the skilled person to design the otherwise obvious process according to claim 1 and the system according to claim 11 according to feature 3. This enabled the skilled person in

particular, as discussed with the parties and the court expert during the oral hearing, to optimise the timing of the transport and the filling of the containers in such a way that two painting robots can be supplied with filled containers by the same transport device.

30 b) It was also obvious that, to couple the containers at the filling point with a paint supply device by means of a linear movement device along a straight path in accordance with feature 4.

31 According to the correct statements of the Patent Court, linear movement devices were generally known to the skilled person, especially through his studies and from the technical literature, as standard tools for carrying out defined linear movements. In order to reduce action movements as far as possible to a minimum and thus save time, it was objectively expedient to provide a straight-line path and to use linear movement devices for this purpose. Since no difficulties or obstacles were apparent for this purpose when using a transport device together with containers and paint supply devices corresponding to the subject matter of the patent in dispute, it was therefore appropriate for the skilled person to design this subject matter according to feature 4.

32 c) Since both features 3 and 4, each in itself, objectively complement the subject-matter of the patent in suit in an expedient manner by standard means and since also no impediments result from their combination, a respective procedure also in the combination of both features was obvious for the skilled person.

33 d) Therefore, the process according to claim 1 and the device according to claim 11 are not based on an inventive step even in the version of auxiliary request II.

34 3. Finally, the subject-matter of sub-claims 2 to 10 and 12 to 41 are not patentable either in the granted version or in the version of the two auxiliary requests.

35 By way of justification in this respect, reference can be made first of all to the correct and careful reasoning of the appealed judgment and, with regard to claims 15 and 27, in addition to the above comments on features 3 and 4.

36 With regard to sub-claim 25, according to which in a coating plant according to the preceding claims the containers at the transition point can optionally be fed to at least two separate spraying devices, i.e. painting robots, it must be added with regard to the discussions in the oral hearing that such a parallel procedure corresponded to the general process and system technical optimization efforts of the skilled person. It was part of his general technical knowledge and ability to link process steps and process components, where possible, in such a way and in such a number as to ensure that no component would have unnecessary downtimes. If a component can interact with more than one other component in the process steps it has to carry out because of the performance capacity that is relevant to it, the skilled person - at least in a time-critical process such as the painting of vehicle bodies - has reason in principle to provide for such parallel interaction in order to increase the efficiency of the system (cf. expert opinion p. 28 et seq.). In this respect, the hearing of the expert confirmed that the transport device and the filling of the containers in the case of an equipping system in accordance with the subject of the patent in dispute made it possible to supply at least two painting robots with filled containers at only one transition point of the transport device. The description of the patent in dispute and the defendant's submission do not indicate any difficulties, which would have had to be overcome for this purpose. For the skilled person, such parallel interaction at the transition point of the transport device was therefore obvious and did not require any inventive step.

37 IV. The decision on costs is based on Sec. 121(2) Patent Act, Sec. 97(1)
Code of Civil Procedure.

Meier-Beck

Hoffmann

Schuster

Deichfuß

Kober-Dehm

Previous instance:

Federal Patent Court, decision of 8 November 2010 – 4 Ni 101/18 (EU)