

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-01-14
Docket Number / Aktenzeichen:	X ZR 144/17
Name of Decision / Name der Entscheidung:	Rotierendes Menü

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# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 144/17

Pronounced on:  
14 January 2020  
Anderer  
Judicial Secretary  
as Clerk of the  
Court Registry

in the patent nullity proceedings

Rotierendes Menü/Rotating menu

EPC Art. 54(2) lit. d

The instruction to select a display mode for a selection menu on a screen, which serves only the purpose of presenting the displayed menu items and the circumstance that further items may be available in a particularly descriptive manner does not concern a technical solvent and is therefore not to be taken into account in the examination for inventive step.

Federal Court of Justice, judgment of 14 January 2020 – X ZR 144/17 – Federal Patent Court

ECLI:DE:BGH:2020:140120UXZR144.17.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 14 January 2020, attended by the judge Dr. Bacher, the judges Dr. Kober-Dehm, Dr. Marx and Dr. Rombach as well as the judge Dr. Rensen

ruled that:

The appeal against the judgment of the 2<sup>nd</sup> Senate (Nullity Senate) of the Federal Patent Court of 26 July 2017 is dismissed.

Amending the decision of the first instance, the defendant shall bear  $\frac{3}{4}$  of the court costs and the out-of-court costs of the first to third plaintiffs, the fourth plaintiff shall bear  $\frac{1}{4}$  of the court costs.

By operation of law

Facts of the case:

1           The defendant is the owner of European patent 888 687 (patent in suit), which was granted with effect for the Federal Republic of Germany, was filed on 10 November 1997, claiming the priority of a U.S. application dated 20 December 1996, and has since expired due to the passage of time. The patent in suit relates to a user interface for an electronic device having a display screen. Patent claim 1, to which twelve further claims are referred back, reads in the language of the proceedings:

"1.    An electronic device comprising  
-       at least one display;  
-       a controller arranged to cause the display to show a rotating menu comprising a plurality of menu options, which menu is disposed off centre in the display so that at least one option is rotatable off the display at any one time, whereby an arbitrary number of options may be added to the menu without changing its format."

2           The plaintiffs have challenged the patent in suit to varying extents on the grounds of lack of patentability. The defendant defended the patent as granted and, in the alternative, in an amended version.

3           The Patent Court declared the patent in suit to be invalid in its entirety. The defendant contests this with its appeal, in which it continues to pursue its first-instance claims without restriction. In the course of the appeal proceedings, the fourth plaintiff withdrew the action. The other plaintiffs oppose the appeal.

Grounds of the decision:

4           The admissible appeal is unfounded; the Patent Court correctly found the  
subject matter of the patent in suit to be unpatentable.

5           I.       The patent in suit concerns a user interface for an electrical device  
with at least one display.

6           1.       The description of the patent in suit states that the system tested  
by Time Warner Corporation, called FSN (Full Service Network, a system for  
interactive television), has a rotating menu with buttons that moved past the  
cursor.

7           The patent in suit concerns the technical problem of providing an  
improved user interface.

8           2.       To achieve this, claim 1 provides a device with the following  
features (the deviating structure of the Patent Court is added in square  
brackets):

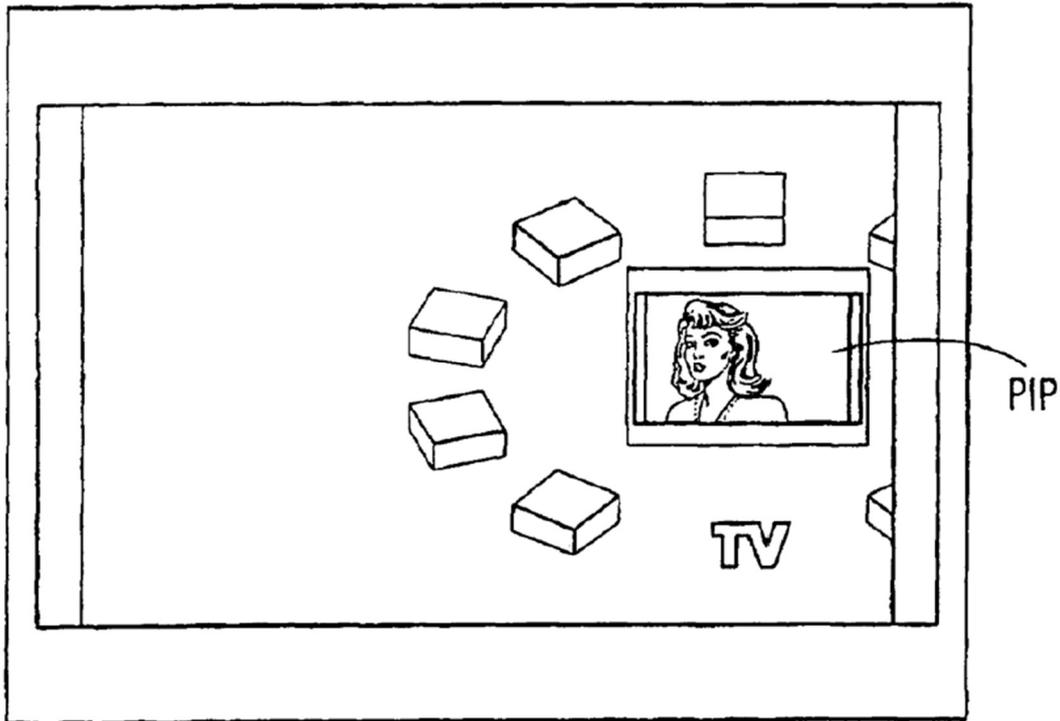
1.       the electronic device comprises
  - 1.1     at least one display and
  - 1.2     a controller.
2.       the controller is intended to ensure that the display  
represents a menu [1.2].
3.       the menu
  - 3.1     is rotating [1.2.1],
  - 3.2     includes a number of menu items [1.2.1] and
  - 3.3     is provided on the display off-center [1.2.2],
    - 3.3.1   such that at least one menu item can be  
rotated away from the display at any time  
[1.2.3],
    - 3.3.2   whereby any number of items can be added  
to the menu without changing the format  
[1.2.4].

9           Of central importance for user-friendliness are the rotating menu provided in features 3.1 and 3.2 [1.2.1] and the decentralized arrangement of the same provided in feature 3.3 [1.2.2]. The latter opens up the possibility, provided for in feature 3.3.1 [1.2.3], of rotating at least one menu item away from the display at any time. This in turn creates the possibility, provided for in feature 3.3.2 [1.2.4], of adding any number of menu items without having to change the format of the displayed items. In particular, this can be achieved by ensuring that the number of menu items shown on the display always remains the same, regardless of how many menu items are available in total.

10           3.       Some features require closer examination.

11           a)       From the point of view of the skilled person, whom the Patent Court characterized unobjected to by the parties as a graduate engineer specializing in data processing or a graduate computer scientist with several years of professional experience in the field of developing human-machine interfaces, in particular user interfaces, a rotating menu within the meaning of feature 3.1 [1.2.1] requires that the individual menu items perform a rotating movement when the list displayed on the screen for selection changes, i.e. move from one position to the next on a curved path. (par. 8 and par. 14).

12           An embodiment of this is shown in Figure 2 of the patent in suit.



- 13 This arrangement is described in the description as a kind of carousel that rotates on the screen. The menu items, represented as cuboids, are arranged along an elliptical path. This creates a spatial perspective that gives the impression that the menu is rotating on a circular path whose plane is different from the plane of the screen (para. 8).
- 14 Contrary to the opinion expressed by individual parties, patent claim 1 does not contain any further specifications as to what shape the curved path must have. From the embodiment example shown in Figure 2 it is clear that the web can be circular, but also elliptical. However, since this is only an example of an embodiment, other shapes are also possible. It is necessary, but also sufficient, that the curve shown on the screen can be interpreted as forming part of a path that continues outside the screen.
- 15 On the other hand, there is no rotating menu within the meaning of the patent in suit if the menu items are displayed in a purely linear sequence.
- 16 b) The arrangement of the menu outside the center of the display provided for in feature 3.3 [1.2.2] requires that the menu is positioned on the screen in such a way that the center of the area enclosed by the orbit of the menu items including the imaginary rotation path is located outside the center

of the display, i.e. the rotation path has an asymmetrical course with respect to the center of the display.

17           Contrary to the opinion of the Patent Court, this does not necessarily exclude that the (virtual) rotation axis of the menu intersects the center of the display plane. In the case of the embodiment example shown in Figure 2, in which the menu items rotate around the center of a virtual circle, this conclusion is indeed compelling. As already explained, however, patent claim 1 does not give any further specifications with respect to the course of the rotation path. In view of this, it is conceivable that the path has a course which does not allow the exact determination of an axis of rotation. In any case, in this constellation the course of the axis of rotation is irrelevant.

18           c)     Features 3.3.1 and 3.3.2 [1.2.3 and 1.2.4] only require the possibility to rotate away individual menu items or to add any number of menu items. They then leave open the possibility that in certain display situations all available menu items are visible on the screen. It is sufficient if individual menu items can be rotated away as soon as the total number of available menu items has exceeded the number of items that can be displayed on the screen.

19           II.     The Patent Court has substantiated its decision essentially as follows:

20           The subject matter of the granted version of the patent in suit was suggested by European patent application 626 635 (E1). The processor (CPU) disclosed in E1 corresponds to a controller within the meaning of the patent in suit. E1 further discloses the display of a rotating menu with a plurality of menu options in a circular arrangement (object wheel) positioned outside the center of the screen. E1 further disclosed that only some menu items were visible and that further items could be added. In this respect, it had been obvious to the skilled person not to change the presentation of the menu items, i.e. their format in the visible part of the display.

21           The subject matter defended by the auxiliary request was not to be assessed differently. The additionally provided features were not to be taken

into account in the examination for inventive step, because they merely concerned the expedient presentation of information.

22           III.     This assessment stands up to review in the appeal proceedings.

23           1.     In the assessment of inventive step, features 2, 3.2, 3.3 and 3.3.2 [1.2, 1.2.1, 1.2.2 and 1.2.4] are to be taken into account, but not feature 3.1 [1.2.1].

24           a)     When examining an invention for inventive step, only those instructions are to be considered which determine or at least influence the solution of the technical problem by technical means (Federal Court of Justice, judgment of 26 October 2010 - X ZR 47/07, GRUR 2011, 125 marginal no. 31 - Wiedergabe topographischer Informationen; Federal Court of Justice, judgment of 25 August 2015 - X ZR 110/13, GRUR 2015, 1184 marginal no. 18 - Entsperrbild).

25           The representation of information is as such not amenable to patent protection (Art. 52(2)(d), (3) EPC). Therefore, when examining patentability, such instructions must be disregarded as non-technical which relate precisely to the communication of certain content and thus aim to act on the human imagination or capacity for understanding (Federal Court of Justice, judgment of 26 February 2015 - X ZR 37/13, GRUR 2015, 660 marginal no. 32 Bildstrom). Furthermore, when examining inventive step, such instructions are not to be taken into account according to which certain contents are emphasized by deviations in color, brightness or the like (Federal Court of Justice, GRUR 2015, 660 marginal no. 33 Bildstrom).

26           Instructions which, although they relate to the (visual) reproduction of information, do not focus on the communication of specific contents or their communication in a special presentation, but rather on the presentation of image contents in a manner which takes into account the physical conditions of human perception and reception of information and is thereby directed towards this, In contrast, the presentation of image content in a manner that takes into account the physical conditions of human perception and reception of information and is aimed at enabling, improving or expediently shaping the perception of the

displayed information by humans in a certain manner serve to solve a technical problem with technical means and are to be taken into account in the examination for inventive step (Federal Court of Justice, GRUR 2015, 660 para. 35 - Bildstrom). A feature relating to the reproduction of information must also be taken into account if and to the extent that it constitutes a means of achieving a specific technical effect (Federal Court of Justice, GRUR 2015, 1184 marginal no. 18 - Unblocking image).

27           b)     The latter requirements are fulfilled for features 2, 3.2, 3.3 and 3.3.2 [1.2, 1.2.1, 1.2.2 and 1.2.4].

28           In the case in dispute, features 2, 3.2, 3.3 and 3.3.2 [1.2, 1.2.1, 1.2.2 and 1.2.4] have the function of using a spatially limited display area for the display of information that cannot be displayed all at once due to its volume and formatting. This technical problem is solved according to the mentioned features by a certain spatial arrangement of the displayed information. This is not only an expedient and easily understandable presentation of the information, but also a technical solvent, namely an expedient utilization of the available screen area.

29           c)     The representation of the menu as rotating provided for in feature 3.1 [1.2.1], on the other hand, is exhausted in the mere reproduction of an information as such.

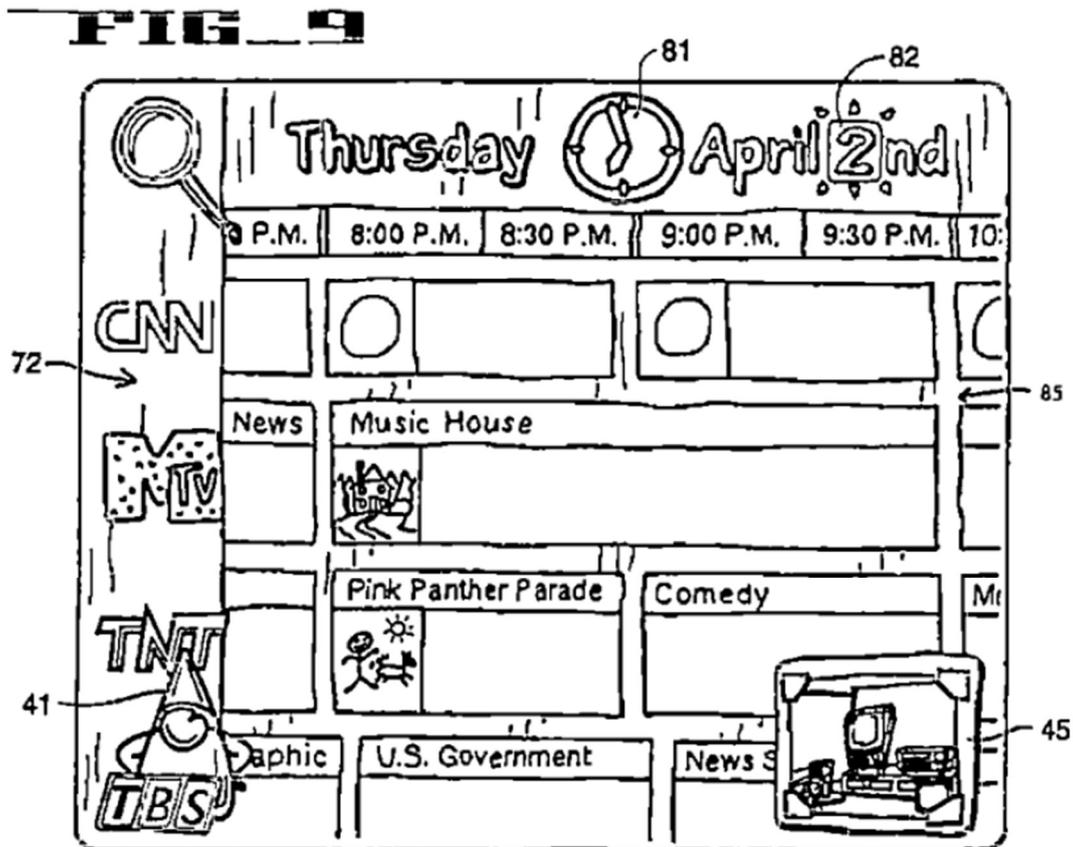
30           This type of display does not make it possible to use the available display area more efficiently. It only serves the purpose of presenting the displayed menu items and the fact that possibly further items are available in a particularly descriptive manner. This is purely to take account of the human imagination. According to the case law of the Senate, this does not constitute a technical solvent (Federal Court of Justice, GRUR 2015, 1184 marginal no. 21 - Entsperrbild; Federal Court of Justice, judgment of 26 February 2015 X ZR 37/13, GRUR 2015, 660 marginal no. 31 et seq. - Bildstrom).

31           2.     The Patent Court rightly considered the subject matter defended by the main request - including feature 3.1 [1.2.1] - as disclosed by E1.

32           a)     E1 discloses a remote control device which enables the control of several different devices.

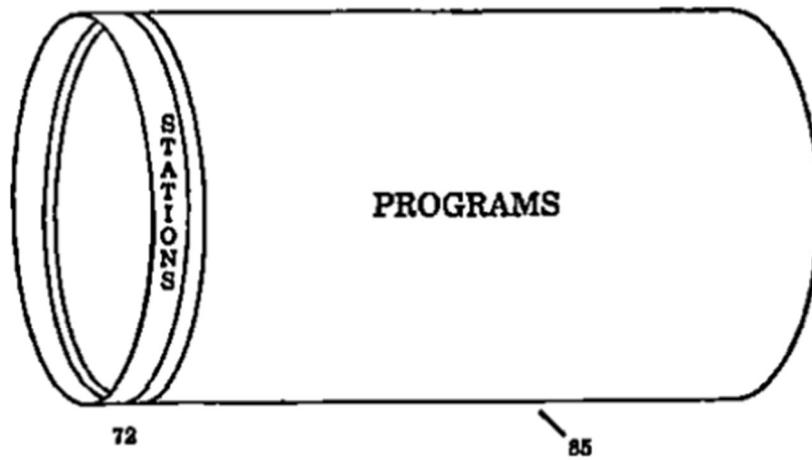
33 The disclosed device comprises, among other things, a processor (CPU) and a display screen, which is preferably designed as a touch screen. Certain information can be displayed by means of so-called object wheels, each of which displays only a part of the total number of points available for selection.

34 aa) Figure 9 shows a list of television stations and their programs as an example.



35 According to the description of E1, object wheels can be used to enable a selection from an arbitrarily large number of TV channels (E1 Sp. 20 Z. 11-15). If 500 channels were available, not all of them could be displayed on the screen at the same time (E1 Sp. 20 Z. 18-24). In order to be able to access all entries nevertheless, the list of the transmitters and the list of the associated programs are arranged on two interconnected object wheels. If the user sets one of these wheels in rotation, the other one is moved in a corresponding sense, so that the lists of TV stations and programs are always aligned (E1 Sp. 31 Z. 3548).

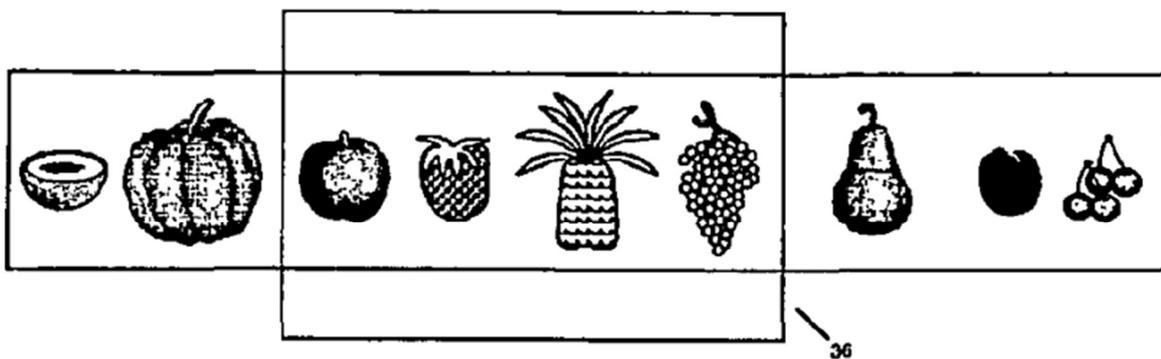
36 The principle of operation of these two wheels is shown in figure 11:



**Figure 11**

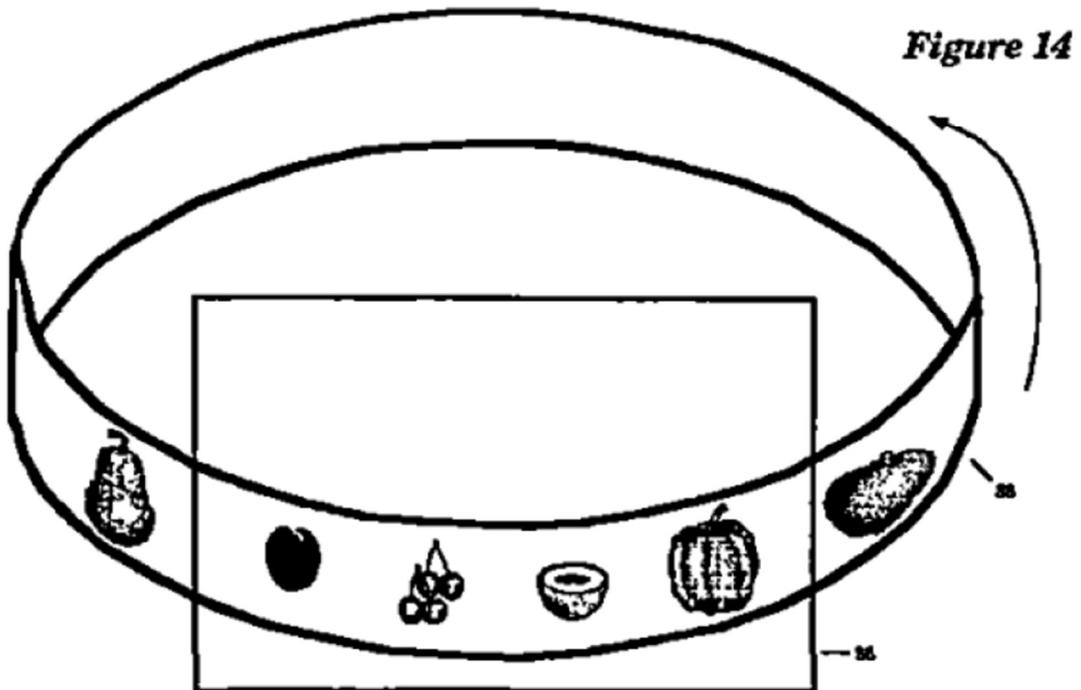
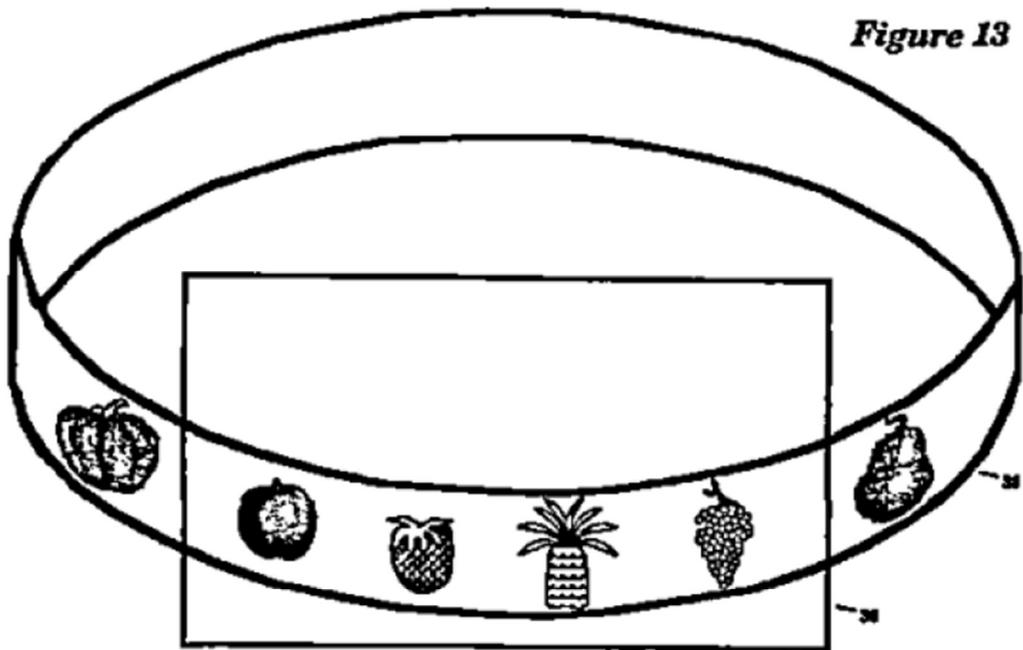
37 bb) Regarding the general functional principle of the object wheels, E1 further states that these enable the selection from a large group of objects by displaying only some immediately accessible objects at a time. To get to the objects that are not displayed, the user spins the wheel (E1 Sp. 20 Z. 26-36). This mode of operation is illustrated by a selection of fruits.

38 The initial situation is sketched by the representation in figure 12, where a total of seven fruits are available for selection, but only four can be displayed together on the screen at a time (E1 Sp. 20 Z. 37-40).



**Figure 12**

39 To give the user access to all the choices, the fruits are arranged on an object wheel as outlined in Figures 13 and 14 (E1 Sp. 20 lines 40-55).



40 In order to give the user as authentic an impression as possible, the object wheels should follow the laws of physics, for example, they should have a mass and the resulting inertia. This should manifest itself in the fact that the wheels rotate faster the more "force" the user applies when pushing them, and then slowly coast to a stop (E1 Sp. 20 Z. 56 to Sp. 21 Z. 5). During the rotating movement, a clicking sound is also to be produced, as produced by detents that would be used in a slot machine to stop the wheel and align it in a unique position. The user should also be able to stop the rotation by touching the wheel (E1 Sp. 21 Z. 6-17).

41 b) Thus, as also the appeal does not doubt, the features 1, 1.1, 3.2, 3.3 and 3.3.1 [1, 1.1, 1.2.1, 1.2.2 and 1.2.3] are disclosed.

42 c) Also disclosed are features 2 and 3.1 [1.2 and 1.2.1].

43 That the processor (CPU) disclosed in E1 is used for displaying menus and thus has the function of a controller within the meaning of feature 2 [1.2] is also not doubted by the appeal. Contrary to its opinion, this controller in E1 also serves to display a rotating menu within the meaning of feature 3.1 [1.2.1].

44 It can be left open whether the representation disclosed in Figure 9, which does not in itself show a curved path on which the entries with transmitters and programs move, can already be regarded as a rotating menu if the user can cause the movement described in connection with Figures 13 and 14 together with the associated sounds. A rotating menu in the sense of feature 3.1 [1.2.1] is in any case disclosed in figures 13 and 14 and the passages of the description referring thereto.

45 Contrary to the opinion of the appeal, this is not contradicted by the fact that a purely linear arrangement is shown in Figure 12. This arrangement merely reflects the initial situation, the problems of which are to be overcome by the means proposed in E1. As a solution, Figures 13 and 14 disclose an arrangement in which the displayed objects are positioned along a curved path. This corresponds to an arrangement as shown in Figure 2 of the patent in suit.

46 Contrary to the view of the appeal, feature 3.1 [1.2.1] is also not lacking in disclosure because only a general functional principle is shown in figures 13

and 14. It is true that the example of a selection of fruits shown in these figures is no longer taken up in the specific embodiments shown in E1 below. However, it is sufficiently clear from the detailed illustration of the functional principle, including individual details such as the reproduction of mass inertia, friction and mechanical locking elements that cause clicking noises, that the general functional principle shown is also intended to be used in concrete embodiment examples. This includes the arrangement of the visible menu items on a curved path as shown in Figures 13 and 14.

47           Additional confirmation of this is provided by the fact that the task of making a list of 500 television stations accessible in a simple manner is already mentioned in E1 in the introductory remarks to the presentation of the general mode of operation (E1 Sp. 20 Z. 11-25). This example is taken up again at another point in E1. The fact that there again object wheels are used as solvent proves, however, that the functional principle is to be used, which has already been described in detail before.

48           It can be left open whether claim 11 formulated in E1, which relates to a method in which the displayed objects are rendered along a long first axis (said graphic objects rendered on said display screen aligned a first axis), covers only a linear sequence of the displayed objects in the sense of the defendant's understanding or whether, against the background of the broader disclosure content of the citation, the arrangement of the visible objects on a curved path is also sufficient to realize this feature. The disclosure content of a citation is not limited to the subject matter of the patent claims formulated therein (see Federal Court of Justice, judgment of 16 December 2008 - X ZR 89/08, BGHZ 179, 168 marginal no. 16 - Olanzapin; judgment of 27 May 2014 - X ZR 2/13, GRUR 2014, 1026 marginal no. 19 - Analog-Digital-Wandler). In the case in dispute, it can be inferred from the description of E1 for the reasons outlined above that the disclosure content of this citation comprises features 2 and 3.1.

49           d)     The Patent Court rightly considered feature 3.3.2 [1.2.4] to be suggested by E1.

50           aa) As a result, the Patent Court correctly assumed that E1 discloses the possibility of extending a menu represented by means of an object wheel by any number of items.

51           This possibility is not explicitly mentioned in E1. However, it follows directly and unambiguously for the skilled person from the already mentioned indication that object wheels make it possible to provide any number of television channels for selection that the number of menu items can be increased as desired and that this can be done depending on the respective purpose, for example depending on the number of television channels available in the individual case.

52           Whether a comparable possibility also exists with regard to the installation and selection of device drivers does not need to be decided against this background.

53           bb) Whether the skilled person reads from these statements, as it were, that the format for displaying the menu items visible on the screen is independent of the total number of items available can be left open.

54           For the skilled person, such a design was in any case obvious, because E1 does not contain any further details on formatting in such situations and because it was obvious in the disclosed example with 500 available and four displayed TV channels that a format change in the case of an increase or decrease of the total number of menu items is neither necessary nor reasonable.

55           This is not contradicted by the fact that a format change, starting from the FSN system disclosed as a starting point in the patent in suit, was in any case unavoidable in certain situations because all available menu items are always displayed there and the available space is limited. The skilled person concerned with the improvement of such systems had reason to also include the system disclosed in E1 in his considerations. From this starting point, it was in any case obvious to refrain from a change of format for the reasons mentioned. Thus, the subject matter of the patent in suit is not based on inventive step. 3.

56           3.     The patent in suit does not prove to be legally valid even in the  
version of the auxiliary request.

57           a)     According to the auxiliary request, patent claim 1 is to receive the  
following additional features:

4. the menu is rendered with a perspective,

4.1     in which it appears as if in a visible plane that does not extend parallel to the  
screen [1.2.5],

4.2     where the perspective is achieved by changing either the shape or the size of  
at least one of the menu items [1.2.6].

58           b)     The Patent Court correctly assumed that these features are not to  
be taken into account when examining inventive step.

59           As already explained above, when examining an invention for inventive  
step, only those instructions are to be taken into account which determine or at  
least influence the solution of the technical problem by technical means.

60           The instruction to display the menu in a certain perspective and to change  
the shape or size of a menu item for this purpose only concerns the graphical  
representation of the information provided. Such a representation makes a more  
user-friendly perception possible. However, it does not make a technical  
contribution to enabling the perception itself, its improvement or its appropriate  
design (see Federal Court of Justice, GRUR 2011, 125 marginal no. 48 -  
Wiedergabe topographischer Informationen). The claimed reproduction of the  
menu contents is not based on any technical considerations. Rather, it serves  
the purpose of making the information easier to understand for the user and  
thus more accessible.

61           c)     Irrespective of this, the design of the menu according to feature  
group 4 was suggested to the skilled person on the basis of E1.

62           aa)    As already explained above, E1 suggests in Figures 13 and 14 to  
arrange the objects available for selection on a curved path so that the  
impression is created that they are positioned on a rotating wheel. The plane of

this wheel is oriented obliquely to the screen plane, as is also disclosed in feature 4.1.

63           bb)    Not expressly disclosed in E1 is the highlighting of individual menu items by changing their shape or size.

64           It can be left open whether the two fruits arranged on the left and right of the screen in Figure 13 show a perspective distortion compared to the fruits visible on the screen. For feature 4.2 to be realized, it would be necessary for such differences to be discernible between the fruits visible on the screen. The latter cannot be directly and unambiguously inferred from E1.

65           cc)    Based on the suggestion disclosed in E1 to display the menu items on an object wheel and to select a perspective representation for this purpose, the skilled person was prompted to resort to design means which are customary for such a representation. This includes displaying objects that are in the foreground larger than objects that are (apparently) further away from the user.

66           IV.    The decision on costs is based on Sec. 121(2) Patent Act and Sec. 97(1), 269(3) sentence 2 Code of Civil Procedure.

67           1.    A decision on the extrajudicial costs of the fourth plaintiff is not required.

68           Pursuant to Sec. 269(4) Code of Civil Procedure, a decision on the obligation to pay costs pursuant to Sec. 269(3) sentence 2 Code of Civil Procedure is only to be made upon request. The defendant has not made such an application - as announced by the fourth plaintiff.

69           2.    With regard to the court costs, on the other hand, a uniform decision was to be made in the judgment in accordance with Sec. 308(2) Code of Civil Procedure even without an application by the defendant because the withdrawal of the action does not affect the entire subject matter of the dispute (see Federal Court of Justice, decision of 28 January 1999 - III ZB 39/98, NJW-RR 1999, 1741). The fourth plaintiff is to be ordered to pay its share of the court costs in accordance with Sec. 269(3) sentence 2 Code of Civil Procedure.

70            There is no evidence of any other provision on costs which would also be relevant in the present context pursuant to the last half-sentence of the said provision. The agreement with the defendant submitted by the fourth plaintiff, according to which applications for costs are not to be made, does not constitute a different reason within the meaning of Section 269(3) sentence 2 Code of Civil Procedure. In the present constellation, it can at most result in the defendant being prevented from filing an application for costs against the fourth plaintiff.

Bacher

Kober-Dehm

Marx

Rombach

Rensen

Previous instance:

Federal Patent Court, judgment of 26 July 2017 – 2 Ni 28/16 –