

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-10-20
Docket Number / Aktenzeichen:	X ZR 158/18
Name of Decision / Name der Entscheidung:	Zigarettenpackung

---



**Arbeitskreis**  
**Patentgerichtswesen**  
in Deutschland e.V.



**FEDERAL COURT OF JUSTICE**  
**IN THE NAME OF THE PEOPLE**  
**JUDGMENT**

X ZR 158/18

Pronounced on:  
20 October 2020  
Zöller  
Judicial Secretary as  
Clerk of the court  
registry

in the patent nullity proceedings

Zigarettenpackung/  
Cigarette pack

EPC Art. 87(1), Art. 138(1) lit. c; Act on International Patent Conventions Art. II Sec. 6(2)

A patent shall not be declared null if the insertion of a feature not disclosed in the originally filed documents or not disclosed as belonging to the invention leads to a mere limitation of the subject matter of the application. No mere limitation in this sense, but an aliud is present if the added feature concerns a technical aspect, which cannot be inferred from the originally filed documents either in its concrete form or at least in abstract form as belonging to the invention (confirmation of Federal Court of Justice, judgment of 21 June 2011 - X ZR 43/09, GRUR 2011, 1003 - Integrationselement; order of 6 August 2013 - X ZB 2/12, GRUR 2013, 1135 - Tintenstrahldrucker; judgment of 17 February 2015 - X ZR 161/12, BGHZ 204, 199 = GRUR 2015, 573 Wundbehandlungsvorrichtung).

Federal Court of Justice, judgment of 20 October 2020 - X ZR 148/17 –  
Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 20 October 2020, attended by the presiding judge Dr. Bacher, the judges Dr. Grabinski and Hoffmann, the judge Dr. Kober-Dehm and the judge Dr. Rensen

ruled that:

On appeal by the plaintiff, the judgment of the 4th Senate (Nullity Senate) of the Federal Patent Court of 22 August 2018 is amended.

European patent 942 880 is declared null with effect for the territory of the Federal Republic of Germany.

The appeal of the defendant is dismissed.

The costs of the dispute shall be borne by the defendant.

By operation of law

Facts of the case:

1           The defendant is the owner of European patent 942 880 (patent in suit), granted with effect for the Federal Republic of Germany, which was applied for on 19 November 1997, claiming British priorities of 21 November 1996, 6 August 1997, and 3 October 1997, and relates to packaging for smoking products. Claim 1, to which sixteen further claims refer back, reads in the language of the proceeding:

A pack of smoking articles having a frame (10, 10', 101) with a major panel (11, 11', 102), two side wings (12, 104) and at least a partial end flap (21/22, 21'/22', 108, 112) placed adjacent a face, sides and at least part of at least one end, respectively, of a charge (15) of smoking articles, and a flexible barrier sheet (24, 200, 229, 258, 259) wrapping the charge and frame and forming a sealed enclosure around them by virtue of sealed seams characterized in that all of the sealed seams overlie at least partly a part (12, 21/22, 21'/22', 104, 112) of the frame.

2           Patent claim 18, to which a further claim refers, protects, mutatis mutandis, a process for the manufacture of such a product.

3           The plaintiff, who is being sued for infringement of the patent in suit, has challenged the patent in suit on the grounds of impermissible extension and lack of patentability. The defendant has defended the patent as granted and, in the alternative, in twenty amended versions (auxiliary claims 1 to 5C).

4           The Patent Court declared the patent in suit null insofar as its subject matter extended beyond the version defended by auxiliary request 3, and dismissed the further action with the proviso that no rights could be derived from the feature "that all of the sealed seams overlie at least partly a part of the frame". This is the subject of the appeals of both parties, which continue to pursue their first-instance claims.

Grounds of the decision:

5 Both appeals are admissible and also admissible in other respects. Only  
the plaintiff's appeal is well-founded.

6 I. The patent in suit concerns packaging for smoking products.

7 1. In the description of the patent in suit it is stated that in the state  
of the art both packagings made of soft, sheet-like materials and rigid  
packagings with an outer casing of cardboard or paperboard are known. Rigid  
packages protect the smoking products and other sealing wrappings well.  
However, they are difficult and expensive to manufacture. In contrast, soft  
packaging is simple and inexpensive to manufacture, but does not protect the  
contents of the packaging as well.

8 2. Against this background, the patent in suit relates to the technical  
problem of providing packaging for smoking products which offers the best  
possible protection and at the same time is as simple and inexpensive to  
manufacture as possible.

9 3. To solve this problem, the patent in suit proposes in claim 1 a  
device whose features can be divided as follows:

1.A	A pack of smoking articles	Ein Rauchwarenpackchen,
1.B	having a frame (10, 10', 101)	welches eine Zarge (10, 10', 101) hat,
1.B.i	with a major panel (11, 11', 102),	mit einer Hauptfläche (11, 11', 102),
1.B.ii	two side wings (12, 104)	zwei Seitenflügeln (12, 104)
1.B.iii	and at least a partial end flap (21/22, 21'/22', 108, 112)	und wenigstens einer teilweisen Endlasche (21/22, 21'/22', 108, 112),

1.B.iv	placed adjacent a face, sides and at least part of at least one end, respectively, of a charge (15) of smoking articles,	angeordnet jeweils angrenzend an eine Fläche, Seiten und wenigstens einen Teil wenigstens eines Endes einer Rauchwarenfüllung (15),
1.C	and a flexible barrier sheet (24, 200, 229, 258, 259) wrapping the charge and frame	und ein flexibles Sperrblatt (24, 200, 229, 258, 259), das die Füllung und die Zarge umwickelt
1.D	and forming a sealed enclosure around them by virtue of sealed seams	und mittels versiegelter Nähte eine abgedichtete Umhüllung um sie bildet,
1.E	characterized in that all of the sealed seams overlie at least partly a part (12, 21/22, 21'22', 104, 112) of the frame.	dadurch gekennzeichnet, dass alle versiegelten Nähte wenigstens teilweise einen Teil (12, 21/22, 21'22', 104, 112) der Zarge überliegen.

10           4.       Some of these features require explanation.

11           a)       The Patent Court correctly assumed that the frame provided for in  
feature 1.B must have a certain strength, but patent claim 1 does not specify a  
certain material.

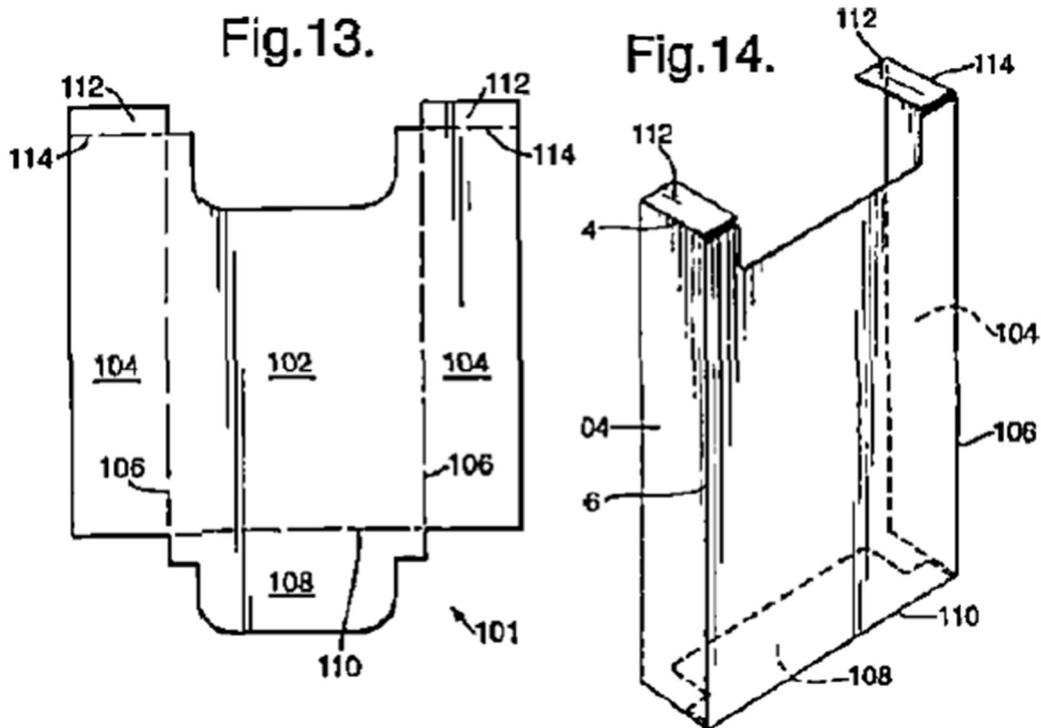
12           That the frame must have a certain strength is clear from the term "frame"  
used in the language of the method and from the juxtaposition of this component  
with the flexible blocking sheet provided for in feature 1.C. The Patent Court  
was right to assume that the frame must have a certain strength. This is  
confirmed, as the Patent Court rightly pointed out, by the fact that the frame is  
subject to at least part of the sealed seams according to feature 1.E and that  
this feature has the function of allowing a distribution of the pressure occurring  
during sealing.

13           b)       It does not follow from characteristic 1.B.iv, according to which the  
individual parts of the frame must be adjacent to a surface, to sides and to at  
least part of an (upper or lower) end of the smoking goods, that the respective  
sides of the package contents must be completely covered by the frame.

14           aa)      For the end flap, feature 1.B.iii expressly provides that it is (only)

at least partially formed.

- 15           bb)    For the main surface, the description states that it is preferable not to design it as a complete rectangle, but to provide a recess at the top (para. 27). Such a recess is shown, among other things, in Figures 13 and 14 reproduced below.



- 16           cc)    With regard to the side wings, nothing else applies against this background.

17           In the figures of the patent in suit, the side wings cover the side surfaces completely in each case. However, feature 1.B.iv does not provide for any differentiation between the individual parts of the frame. Thus, the skilled person is free to provide the side wings with recesses as well.

18           Nothing different results from the function of the side wings as the preferred support surface for the sealing seams. According to feature 1.E, it is sufficient if the seams partially overlap a part of the frame. This leaves open the possibility that the side wings also have recesses and that the seams in this area do not rest on the frame.

- 19           c)     With regard to the flexible locking leaf provided in feature 1.C,

patent claim 1 also does not specify a particular material.

20           According to the description, the barrier sheet may consist of a metal foil, a plastic laminate or a metallized plastic film. This list is not exhaustive. In principle, any material that is flexible and has the suitability to seal the frame and the package contents in a way that is sufficient for practical needs can be considered (para. 13).

21           d)       Furthermore, the Patent Court correctly assumed that it is not sufficient for the realization of feature 1.E if individual of the sealed seams of the barrier leaf overlie the frame, but that each seam must overlie at least a part of the frame over a part of its course.

22           Feature 1.E allows only partial overlying to be sufficient, but imposes this requirement for all sealed seams. This is consistent with the description, which distinguishes the invention from an embodiment known in the state of the art by requiring that all seams at least partially overlie the frame (para. 11), and with the embodiment examples shown in Figures 13 and 14 and 27 to 29, the reference signs of which patent claim 1 uses.

23           The fact that the embodiment examples shown in Figures 6 and 7 or 8 and 9 are thus not according to the invention does not lead to a different assessment. In this respect, these embodiments are based on a different construction principle, which feature 1.E does not take up. Significantly, the reference signs used in these figures are not found in the patent claim.

24           The Patent Court rightly decided that this contradiction cannot be resolved by not considering the seams on the upper side to be sealed seams within the meaning of feature 1.E. The Patent Court also ruled that the seams on the upper side are not sealed seams. As has been pointed out above, the description emphasizes that all seams overlie at least part of the frame. It does not distinguish between seams on different sides.

25           II.       The Patent Court has substantiated its decision, as far as relevant for the appeal proceedings, essentially as follows:

26           Feature 1.E was not disclosed in the originally filed documents as

belonging to the invention. However, this did not lead to a declaration of nullity, but only to the fact that no rights could be derived from this feature. The subject matter of the patent in suit does not constitute an aliud compared to the originally disclosed teaching, but only a concretization.

27           III.     These considerations do not stand up to review in the appeal proceedings. 1.

28           1.     In the result, the Patent Court correctly decided that feature 1.E cannot be directly and unambiguously inferred as belonging to the invention from the originally filed documents, the content of which corresponds to the disclosure document (NK2).

29           a)     The content of the application must be determined on the basis of the entirety of the documents originally filed. What is decisive is what the skilled person can infer from these documents as belonging to the invention (Federal Court of Justice, judgment of 15 September 2015 - X ZR 112/13, GRUR 2016, 50 marginal no. 24 - Teilreflektierende Folie; judgment of 17 February 2015 - X ZR 161/12, GRUR 2015, 573 marginal no. 21 - Wundbehandlungsvorrichtung). However, only that which is directly and unambiguously apparent to the skilled person from the application itself is to be taken into account, not, however, further findings which the skilled person can arrive at on the basis of his general technical knowledge or by modifying the disclosed teaching (Federal Court of Justice, judgment of 8 July 2010 - Xa ZR 124/07, GRUR 2010, 910 marginal no. 62 - Fälschungssicheres Dokument).

30           b)     In the case in dispute, a direct and unambiguous disclosure of feature 1.E is accordingly lacking.

31           aa)    aa) In the description of NK2 it is stated (to this extent in agreement with paragraph 13 of the description of the patent in suit) that the design of sealed seams in a wrapper or barrier layer, in particular on the sides of a package, is supported by the presence of the lateral surfaces of the inner frame, which lie against the cigarettes of the filling and distribute or spread out the pressure exerted on them by the sealing device. This was particularly useful when the filling had different quantities of cigarettes in different rows, such as in

a 7-6-7 arrangement, where a channel might otherwise be formed in the sides (p. 2 line 27 to p. 3 line 5).

32           bb)    It follows directly and unambiguously from this that the side walls of the frame can support the application of sealed seams in the manner described, but not that the same applies to other components of the frame.

33           The indication that the supporting effect can be achieved by pressure distribution indicates that it is advantageous to apply the seams so that they are located above the side walls. Whether it can also be inferred from this statement, without consulting specialist knowledge, that pressure distribution can also be achieved in other ways, for example by the seams resting on the end face of the side walls, does not require a final decision in this context. In any case, only the side walls are mentioned as a means of achieving the desired effect, but not other parts of the frame.

34           It may also be inferred from the comments on pressure distribution that a comparable effect can also be beneficial at other points. However, the direct and unambiguous conclusion to be drawn from this is at most that a comparable design can be considered at points where such pressure distribution is required. That the top and bottom of the packaging could be among these places is not clearly evident against the background of the embodiments disclosed in NK2. On these sides, unlike on the sides, the smoking products form an essentially flat surface which is interrupted only by small gaps. The fact that an additional distribution of pressure with the aid of parts of the frame can also be advantageous at these points is therefore at most apparent on the basis of further considerations based on skilled person knowledge. This is not sufficient for a direct and unambiguous disclosure.

35           cc)    It is likewise not directly and unambiguously disclosed that it is sufficient for the said supporting effect if the sealed seams are applied over only a small part of the frame.

36           The embodiments and associated figures of NK2 show only side walls that completely cover the sides of the interior smoking arrangement.

37           No further disclosure is apparent from the description of the embodiment

in NK2 shown in Figures 13 and 14. It is true that this embodiment can be subsumed under feature 1.E in that the seam at the top of the packet extends over the end flaps 112 formed in the edge regions and thus partially over a portion of the frame. However, it is not apparent from the application that this embodiment has the same function as the arrangement of the seams over the side walls also shown. As a function of the end flaps 112, it is stated that these form a counter-surface for a barrier layer cover provided with adhesive, in order to ensure a good seal when the opened package is reclosed (NK2 p. 14 lines 26-30). The fact that here, too, it makes sense to protect the smoked products inside and that this can also be achieved by only partially underlying flaps is apparent to the skilled person at best by drawing on his specialist knowledge. The explanations given above regarding the effect of the side walls do not in themselves allow such a conclusion, especially since the end flaps 112 can at best have a small distribution effect due to their rather small length compared to the overall width of the pack.

38           2.       Contrary to the opinion of the Patent Court, the insufficient original disclosure results in the nullity of the patent in suit.

39           a)       According to the case law of the Senate, the insertion of a feature which is not disclosed in the originally filed documents as belonging to the invention does not necessarily lead to a complete declaration of nullity of the patent.

40           Insofar as the undisclosed feature leads to a mere restriction of the subject matter applied for, but not to an aliud, the legitimate interests of the public are already satisfied if the feature remains in the patent claim and at the same time care is taken to ensure that no rights can be derived from the amendment in other respects, i.e. with regard to the accrual of patent rights (Federal Court of Justice, order of 6 August 2013 - X ZB 2/12, GRUR 2013, 1135 marginal no. 16 - Tintenstrahldrucker). This also applies to European patents, because the requirements for a declaration of nullity are governed by national law, the relevant provision in Art. II Sec. 6(2) Act on International Patent Conventions is consistent with the provisions applicable to German patents (Sec. 22(2) and Sec. 21(2) sentence 1 Patent Act) and does not conflict with the requirements of the European Patent Convention (Federal Court of Justice,

judgment of 17 February 2015 - X ZR 161/12, BGHZ 204, 199 = GRUR 2015, 573 marginal no. 47 et seq. - Wundbehandlungsvorrichtung).

41           b)     An aliud, which necessarily leads to a declaration of nullity, is not only present if the subject matter of the patent in suit is in an exclusive relationship to the originally disclosed subject matter, but also if the added feature relates to a technical aspect which cannot be inferred from the originally filed documents either in its concrete form or at least in abstract form as belonging to the invention (Federal Court of Justice, judgment of 21 June 2011 - X ZR 43/09, GRUR 2011 100 et seq. June 2011 - X ZR 43/09, GRUR 2011, 1003 marginal no. 28 f. - Integration element; order of 6 August 2013 - X ZB 2/12, GRUR 2013, 1135 marginal no. 27 - Inkjet printer; judgment of February 17, 2015 - X ZR 161/12, BGHZ 204, 199 = GRUR 2015, 573 marginal no. 53 - Wound treatment device).

42           c)     The addition of feature 1.E does not merely lead to a concretization in the aforementioned sense, but to an aliud.

43           Contrary to the opinion of the Patent Court, the general teaching that the frame as a whole supports the formation of the sealing seams cannot be inferred from the application. Rather, such a supporting effect is disclosed only for the side walls. It is true that the expression "especially" already mentioned above indicates that this supporting effect can also be advantageous at other points of the package. In this respect, too, only the side walls are cited as a means of achieving this effect, but not other parts of the frame.

44           Feature 1.E, which provides for a supporting effect also through other parts of the frame, therefore not only leads to a concretization to the effect that the frame protects the contents of the package from external influences also during the manufacturing process. Rather, it also leads to a generalization to the effect that the pressure distribution can be effected not only by the side walls, but by any part of the frame. This is not a concretization, but an extension by a new technical aspect, which is not disclosed in an abstract form in the originally filed documents either.

45           3.     The lack of disclosure concerns the patent in suit not only in the

granted version, but also in all versions claimed by the auxiliary requests.

46 IV. The decision on costs is based on Sec. 121(2) Patent Act as well as Sec. 97(1) and Sec. 91(1) Code of Civil Procedure.

Bacher

Grabinski

Hoffmann

Kober-Dehm

Rensen

Previous instance:

Federal Patent Court, judgment of 22 August 2018 – 4 Ni 10/17 (EP) –