

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-02-17
Docket Number / Aktenzeichen:	X ZR 161/12
Name of Decision / Name der Entscheidung:	Wundbehandlungsvorrichtung

---



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



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 161/12

Pronounced on:  
17 February 2015  
Beširović  
Judicial secretary as  
clerk of the Court  
registry

in the patent nullity proceedings

Wundbehandlungsvorrichtung/  
wound treatment device

IntPatÜbkG Art. II Sec. 6(1) sentence 1 no. 3

A European patent granted with effect in the Federal Republic of Germany shall not be declared invalid on the ground that the claim contains a feature which is not disclosed in the documents originally filed as belonging to the invention, provided that this feature leads to a limitation of the subject-matter of protection and not to an aliud. In the examination of patentability, the feature not disclosed as belonging to the invention shall be disregarded to the extent that it may not be used in support of patentability (continuation of BGH, decision of 21 October 2010 - Xa ZB 14/09, GRUR 2011, 40 marginal 18 ff. - angle measuring device; decision of 21 June 2011 - X ZR 43/09, GRUR 2011, 1003 marginal 24 ff. - integration element).

BGH, judgment of 17 February 2015 - X ZR 161/12 - Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 17 February 2015 attended by the presiding judge Prof. Dr. Meier-Beck, the judges Hoffmann and Dr. Deichfuß, the judge Dr. Kober-Dehm and the judge Feddersen

ruled that:

On appeal by the defendant, the judgment of the 4th Senate (Nullity Senate) of the Federal Patent Court of 3 July 2012 is set aside.

European Patent No 1 088 569 is declared null with effect for the Federal Republic of Germany, insofar as its subject-matter extends beyond the following version of the patent claims:

- "1. A device for applying a vacuum to a surface wound in a mammal comprising: a porous pad (102) made of open, one compound creating cellular soft foam, a pump (6), a suction line (101) for connecting the porous cushion with the pump (6), a connector for the Connect the padding to the suction line, a chirurgial cover (701) to form an airtight sealing over the wound area, over the padding and above the connector, the connector having a Spout (602) for connecting the fluid supplied by the pump (6) the far end of the suction line (101) with the wound site, **characterized in that** the connector has a disc-like shell (601) around- the lower surface of which is bonded to the porous pad in contact, and wherein the suction line (101) is used as an in- the inner bore (606) in a multi-lumen line, which also includes channels (607), by means of the a transducer (108) measures the pressure at the wound site measures.
2. the device according to claim 1, wherein the porous pad (102) comprises a polyvinyl alcohol foam.
3. the device according to claim 1 or 2, wherein the surgical cover (701), a hole (702) for the removal cast iron (602) through which it passes extended.
4. the device according to claim 3, wherein the surgical cover (701) comprises a plastic film (701), which are coated with a pressure sensitive adhesive for the strengthen the porous pad (102) and the connecting that is coated on the wound."

The remainder of the action is referred back to the Patent Court for retrial and new judgment, including on the costs of the appeal proceedings.

Facts of the case:

- 1 The defendant is the proprietor of European patent 1 088 569 (patent in

suit), which was granted with effect for the Federal Republic of Germany and arose from a divisional application filed on 8 January 2001. This application is based on an international patent application published as WO 97/18007 on 14 November 1996 (parent application), which is registered at the European Patent Office as European application 865 304. The patent in suit relates to a portable wound treatment device and comprises five claims. Patent claim 1, to which the further claims directly or indirectly refer back to, reads in the language of the proceedings as follows:

"Apparatus for applying negative pressure to a superficial wound in a mammal which comprises a porous pad (102) of open, inter-communicating cellular flexible foam, a pump (6), a suction tube (101) for connecting the porous pad to the pump (6), a connector for connecting the pad to the suction tube, a surgical drape (701) for forming an air-tight seal over the wound site, over the pad and over the connector, said connector having a spout (602) for connecting the end of the suction tube (101) remote from the pump (6) to the wound site, characterized in that the connector comprises a disc-like cup (601) having its lower face in contact with said porous pad."

2 The plaintiff to 1 challenged the patent in suit in its entirety, the plaintiff to 2 to the extent of claims 1 to 4. The plaintiffs claimed that the subject matter of claim 1 was not patentable and was based on an inadmissible extension. The defendant defended the patent in suit as granted and with six auxiliary requests. The Patent Court declared the patent in suit null.

3 The defendant appeals against the judgment of the Patent Court, primarily seeking dismissal of the plaintiff's claims and, in the alternative, defending the patent in suit in limited claim versions. The plaintiffs oppose the appeal.

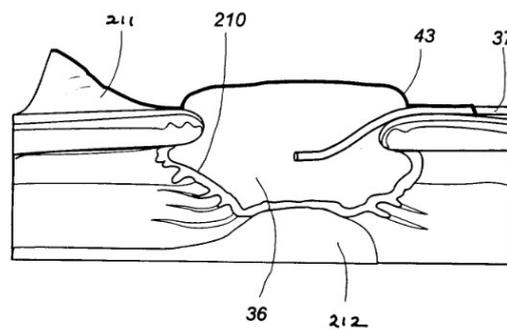
Grounds of the decision:

4 I. The patent in suit concerns a portable device for wound treatment

5 1. According to the patent specification of the patent in suit, devices

for the treatment of wounds were known as state of the art, for example from the international application WO 96/05873, in which the wound healing process was supported by applying negative pressure.. Such a device comprises a porous pad permeable to liquids which can be inserted into the wound, a dressing with which the wound is covered and sealed airtight, a drainage line connecting the pad to a suction pump so that negative pressure can be applied to the wound and liquids can be sucked out of it, and finally a container in which the sucked-out liquid is collected.

- 6 The appearance of such a device known in the state of the art is shown, for example, in Figure 10 of the aforementioned international application,



in which reference sign 210 designates the wound, reference sign 36 a porous, liquid-permeable foam pad, reference sign 37 the tube, and reference sign 43 the airtight wound cover.

- 7 The technical problem, which the patent in suit is intended to solve consists in providing a device which makes such a wound treatment with negative pressure more comfortable and allows its application in particular also with mobile, i.e. not bedridden patients

- 8 2. To solve this problem, the patent specification of the patent in suit proposes a device with the following features (bullet points of the Patent Court in square brackets):

Apparatus for applying a negative pressure to a surface wound in a mammal [1], comprising

1. a porous pad (102) of open, one compound creating cellular soft foam (*a porous pad of open, intercommunicating cellular flexible foam*); [1.1]
2. a pump (6); [1.2].
3. a suction line (101) for connecting the porous pad with the pump; [1.3].
4. a connector to connect the pad to the suction line [1.4], that comprises
  - (a) a *spout* (602) for connecting the end of the suction line (101) remote from the pump to the wound site, [1.6]
  - (b) a *disc-like cup* (601) the *lower face* of which is in contact with the porous pad; [1.7a and 1.7b].
5. a surgical cover (701) for forming an airtight seal over the wound site, over the pad and over the connector. [1.5]

9           3.       Some characteristics require explanation:

10           a)       According to feature 4a, the connector has a spout which serves to connect the end of the suction line that is removed from the pump to the wound site, whereas in the state of the art, as shown for example in Figure 10 reproduced above, the end of the hose was inserted into the soft foam pad. According to the description, either the spout can receive the end of the hose or the end of the hose can be inserted into the spout and additionally pressed into the foam (column 5, lines 37 to 39 and lines 45 to 47). The patent in suit leaves the arrangement and size of the spout to the skilled person, who, as the Patent Court assumed without objection, is a graduate engineer in medical technology who is familiar with the development of negative pressure devices for the treatment of wounds and consults a physician with appropriate knowledge of the medical aspects of wound healing.

11           b)       The connector includes a disc-like shell as defined in feature 4b (*disc-like cup*). It is therefore a device which, on the one hand, has the shape

of a bowl, i.e. is not completely flat, but is bent out of this plane at its edge, but which, on the other hand, is disc-shaped, i.e. flat. By a disc-like shell, the patent in suit therefore means a shell whose height is significantly smaller than its diameter. Such an understanding of the feature is also suggested by the fact that the wound healing device should be able to be worn on the body (see Figures 3A and 3B), which is why it is advantageous to keep it as flat as possible. This is further supported by the fact that Figures 6B and 6C show shells that are virtually flat and have only a minimally curved-up edge.

12            This interpretation is further supported by the fact that in paragraphs 6 and 7 the patent in suit refers to the international application WO 94/20041 (VP4 = D1) as the closest state of the art, the content of which is reflected in the generic term of patent claim 1. The fact that patent claim 1 shows feature 4b as the only characterizing feature suggests that the devices identified in D1 in figures 2 to 5 therein with reference lines 29a, 29b, 29c and 29d are not to be regarded as disk-like. The view of the plaintiff to 1 that paragraphs 6 and 7 of the patent in suit should not be taken into account in the interpretation because they were not included in the parent application is not correct. When determining the teaching given by a patent claim, the description and drawings must be taken into account, which explain and illustrate the technical teaching of the patent claim and therefore, according to the established case law, must be taken into account not only for determining the scope of protection (Art. 69(1) EPC, Sec. 14 Patent Act), but also for interpreting the patent claim. In this context, the patent claim may neither be interpreted according to what proves to be patentable after examination of the state of the art, nor according to the meaning of the original documents. Rather, the sole basis for interpretation is the patent specification (BGH, judgment of 17 February 2012 - X ZR 117/11, BGHZ 194, 107 marginal no. 27 f. - polymer foam).

13            Feature 4b further states that the underside of the disc-like shell is in contact with the porous pad, which is to be understood as meaning that the concave side of the shell is in planar contact with the pad. According to the description of the patent in suit, the shell is pressed onto the porous covering of the wound and secured by a surgical covering (column 5, lines 43 to 45). If one takes into account, on the one hand, that the shell is disk-like, i.e. flat,

and, on the other hand, that the porous padding is made of soft foam, i.e. is pliable, it follows from this for the skilled person that the shell does not necessarily rest on the padding over the entire surface, but also not only punctually or with its edge, i.e. along a line, but rests essentially flat on the padding. From a technical point of view, this means that the interior of the shell is in any case essentially filled with the cushion consisting of soft foam, so that no large free spaces remain. For the skilled person, this understanding of the feature also results from the fact that such a design contributes to the desired flat structure which is advantageous for a portable device.

14 Information about the size of the shell, in particular whether it must be dimensioned so that it covers the entire soft foam padding, is not to be taken from patent claim 1.

15 c) According to feature 5, the device comprises a surgical cover for creating an airtight seal over the wound site, pad and connector. It follows that not only the pad but also the connector must lie under the surgical cover.

16 II. The Patent Court essentially justified its decision as follows:

17 The patent in suit had to be declared null in its entirety because its subject matter, in all defended versions, went beyond the content of the earlier application in the version originally filed. The feature M1.7b, according to which the surface of the disk-like shell enclosed by the connector is in contact with the porous pad, could not be taken from the entirety of the originally filed documents as belonging to the invention. It was not disclosed in the parent application that the connector of the claimed device comprises a disc-like shell, the lower surface of which is in contact with the porous pad. Figures 6A through 6D of the parent application do not disclose such. Nor does it follow from the overall disclosure of the parent application that the shell must be designed in such a way that its lower surface is in contact with the porous pad, likewise it remains open with what proportion or to what extent the underside of the shell is in contact with the pad.

18 The insertion of feature M1.7b could not be understood as a mere limitation of the subject matter of claim 1, but led to a different teaching (aliud).

Whereas the skilled person would take from the originally filed application documents the teaching that the disc-shaped shell was designed in such a way that it was placed on the porous pad with the edge, but in any case not with the lower surface, the inserted feature presupposed precisely this. Since all auxiliary requests had this feature, they were inadmissible. Whether the further ground for invalidity, namely the lack of patentability, is given, could therefore be left open.

19           III.     This assessment does not fully withstand appellate review.

20           1.     In its conclusion, the Patent Court correctly assumed that the subject matter of the granted version of patent claim 1 goes beyond the content of the parent application as originally filed.

21           a)     According to Art. II Sec. 6(1) sent. 1 no. 3 IntPatÜbkG, a European patent shall be declared null with effect for the territory of the Federal Republic of Germany if its subject matter goes beyond the content of the application as originally filed. The relevant content of the application shall be determined on the basis of the entirety of the documents originally filed. It is not limited to the subject matter of the patent claims formulated in the application. Rather, the decisive factor is what the skilled person with average knowledge and skills in the relevant field of technology can infer from the original documents as belonging to the invention (BGHZ 194, 107 marginal no. 45 - Polymer foam).

22           b)     An inadmissible extension is to be seen here in the fact that the device according to the invention for exerting negative pressure on a surface wound is characterized only by a porous pad, a pump, a suction line, a connector with a disc-like shell and spout for connecting the pad to the suction line, and a surgical cover. In this general form, the device is not disclosed as being according to the invention in the original application documents – in this case the parent application.

23           aa)    The description of the parent application, like that of the patent in suit, is based on the international patent application WO 96/05873. The device described there is effective for treating a variety of wounds of different types

and sizes. However, the treatment may take a longer time, which is not a problem for a bedridden patient, but for a patient not confined to bed. It is described as a task of the invention to provide a device which is more comfortable in use, in particular for patients who are to a certain extent mobile, and which has further advantages apparent from the description. For this purpose, first of all, a portable device for stimulating wound healing is proposed, which contains a housing with a suction pump and a container for receiving suctioned wound fluid and comprises means for connection to dressing material in the wound region as well as a carrying strap or belt for supporting the housing, the practical design of the housing, the suction pump and its drive as well as the container being described in more detail..

24           It is then discussed that in a portable device it is more difficult than in the static one, which is described in the state of the art, to determine the pressure prevailing at the wound site to be treated, since it depends in part on the hydrostatic height between the pump and the wound and this varies based on the patient's movements.

25           These general remarks are followed by a description of the embodiments shown in the drawings. Referring to Figure 1, among other things, a tube 101 serving as a suction line and a second tube 106 connecting the wound site to a pressure relief valve 8 and a sensor 108 for measuring or monitoring the pressure are described. The tubes 101 and 106 could be combined into a multi-lumen tube. This is described as preferred and shown in figures 5A through 5F and in modified form in 6E. The description then turns to Figures 6A to 6D, which showed various views of a connector for connecting the multi-lumen tube to the wound site. At this point only, the connector is described as comprising a disc-shaped shell that has a spout, which is sized to receive the end of the multi-lumen tubing (p. 8).

26           In accordance with these embodiments of the description, claim 1 of the application is directed to a portable device comprising a housing, suction pump, container and carrying strap, subordinate claim 3 is directed to a treatment device comprising, inter alia, pressure sensing means, and claim 5, also subordinate, is directed to a treatment device comprising, inter alia, a suction line and an additional line connecting a porous pad to pressure

sensing means enabling monitoring of the pressure at the wound site.

27           The embodiments of the invention disclosed in the parent application are thus characterized, on the one hand, by the means permitting portability (claim 1) and, on the other hand, by means permitting pressure detection (claims 3 and 5). The connector is mentioned only in the context of pressure acquisition and the second line required for this purpose in addition to the suction line. The suction line and the pressure acquisition line can be combined in a multi-partioned tube (parent application p. 5 below), and the spout of the connector can accommodate this multi-lumen tube.

28           bb) It is not immediately and unambiguously clear from this that the invention described as being applied for patent protection also includes a device for exerting a negative pressure on a surface wound which has neither means ensuring its portability nor means enabling the pressure at the wound site to be detected, but consists merely of a porous pad, a surgical cover, a pump, a suction line and a connector connecting the pad and suction line, which comprises a spout receiving the suction line and a disc-like shell.

29           However, a version of the patent claim which contains a generalization compared to the original application documents is not excluded under all circumstances. With regard to the question of whether the priority of a prior application is rightly claimed, the Federal Court of Justice has ruled that this is permissible provided that the instructions described in the prior application on the basis of an embodiment example or in some other way appear to a skilled person as an embodiment of the more general technical teaching described in the subsequent application and this teaching, in the generality disclosed in the subsequent application, is already recognizable from the prior application as belonging to the invention applied for (Federal Court of Justice, judgment of 11 February 2014 – X ZR 107/12, BGHZ 200, 63, margin 25 – Kommunikationskanal). The same requirements apply to the question of whether the granted patent claim contains an inadmissible extension compared to the original application documents.

30           According to this requirement, patent claim 1 is based on an inadmissible extension. The skilled person cannot readily infer from the

original application documents the general technical teaching of connecting the pad and the suction line of a vacuum device leading to the pump by means of a device comprising a spout for receiving the suction line and a disc-like shell for receiving the pad.

31           Rather, the connector is disclosed in the parent application only as an element of a device in which it fulfills the specifically described purpose of ensuring the connection of a multi-lumen tube to the wound site. It is therefore inseparably connected to a wound treatment device which also has a pressure sensing means, whereby the further line required for this purpose is preferably combined with the suction line, which is required anyway, in a multi-lumen hose which is accommodated by the outlet of the connector. Neither the description nor the claims of the parent application offer any indication for the assumption that the skilled person takes from it that with the design of the connector as a flat shell provided with a spout an embodiment of the device for exerting a vacuum is presented to him, for which patent protection is sought independently of the embodiments dealing with the portable design or the means for pressure detection and which is this – considered in itself – disclosed as belonging to the invention applied for.

32           Nothing else follows from the fact that the parent application also mentions a tube with only one bore (single bore tube, p. 7 below) shortly before the above-mentioned passage in the description of the embodiment. The passage in question merely states that the otherwise provided partitioned tube does not have to extend to the wound site, but can have a short piece of single bore tube at its end. It corresponds to this that – somewhat later (p. 8 center) – it is stated that, if desired, the end of the line can also lead through the spout and reach into the soft foam. This does not change the fact that a multi-lumen hose continues to be meant in principle in the above-mentioned passages, and is not capable of calling into question the connection of the disclosure of the design of the connector with a device for exerting and monitoring a vacuum, which results from the overall content of the description.

33           c)       Accordingly, the Patent Court correctly assumed that patent claim 1 in the granted version is based on an inadmissible extension and therefore cannot be maintained. A different assessment is also not justified by

the fact that the patent in suit arose from a divisional application. The requirements for the disclosure of origin are not less stringent in such a case.

34           2.       In contrast, the judgment under appeal does not stand up to review insofar as the Patent Court assumed that the former auxiliary request 6 new, which the defendant now submits as auxiliary request I, is based on an inadmissible extension

35           According to auxiliary request I, a further feature is added to patent claim 1, according to which the suction line (101) is formed as an inner bore (606) in a multi-lumen line which further comprises channels (607) by means of which a transducer (108) measures the pressure at the wound site (feature 6).

36           The limited defense of the defendant with this auxiliary request is – contrary to the opinion of the Patent Court – admissible.

37           a)       Additional feature 6 ensures that the subject matter of patent claim 1 does not go beyond the content of the parent application for the reasons explained. The generalization, which according to the explanations above (under III 1) constituted an inadmissible extension, has been reversed by including in the patent claim the transducer 108 as a pressure sensing means and the second conduit formed by the channels 607 of a multi-lumen conduit for connection between the pad and the pump, and by placing the design of the connector in this context because the suction conduit received by the spout forms the inner bore 606 of the multi-lumen conduit.

38           b)       The subject-matter of claim 1 is based on an inadmissible extension insofar as feature 4b states that the lower surface of the disk-like shell is in contact with the porous pad. However, this does not lead to the inadmissibility of the limited defense of the patent in suit according to auxiliary request I.

39           aa)      According to feature 4b, the lower surface of the disc-like shell is in contact with the porous pad. As explained above, the skilled person understands this feature to mean that the concave side of the shell is in flat contact with the pad.



(BGH, GRUR 2011, 40 marginal no. 19 - angle measuring device). Contrary to the opinion of the Federal Patent Court (judgement of 8 April 2014, Mitt. 2014, 436 - Liposuction device), it must be answered in the affirmative.

43 (2) The aforementioned case-law of the Federal Court of Justice is based on the consideration that the inadmissible modification of the subject-matter of the patent compared to the content of the originally filed documents does not require its revocation or declaration of nullity if the legitimate interests of third parties, in particular the competitors of the patent proprietor, and the public can be taken into account by less severe means.<sup>44</sup>

Accordingly, revocation or a declaration of nullity of the patent is not required if the subject-matter of the patent has been inadmissibly generalized compared to the content of the originally filed application documents. In this case, the inadmissible extension can be remedied by deleting the inadmissible generalization from the patent claim (BGH, GRUR 2011, 40 marginal 14 - angle measuring device; BGH, GRUR 2011, 1003 marginal 19 - integration element; also EPO, decision of the Enlarged Board of Appeal of 2 February 1994 - G 1/93, GRUR Int. 1994, 842 marginal 11 - restrictive feature/advanced semiconductor products).

45 On the other hand, revocation or declaration of invalidity of the patent is inevitable if the addition of a feature not disclosed in the originally filed documents results in the patent claim of the granted patent having a different invention as the subject matter of the original application, i.e. if the patent protects something which represents an "aliud" compared to what was disclosed to the professional community by the original documents (BGH, GRUR 2001, 140, 141 - Zeitlegramm; BGH, GRUR 2011, 40 marginal no. 21 - angle measuring device; BGH, GRUR 2011, 1003 marginal no. 27 - integration element; BGH, GRUR 2013, 1135 marginal no. 16 - inkjet printer). The maintenance of such an amended claim would jeopardize the legal certainty for third parties who may rely on the fact that the patent application does not result in a patent having a further or different subject matter than that disclosed in the application. The maintenance of a patent challenged by opposition or nullity proceedings with the proviso that the feature in question remains in the patent claim, but the patentee cannot derive any rights

therefrom, is ruled out in such a case because it would lead to the patent in the version after the opposition or nullity proceedings having a different subject-matter than the originally disclosed. (BGH, GRUR 2011, 40 marginal no. 23 - angle measuring device).

46           The revocation or the declaration of nullity of a patent is ,however, not necessary if the insertion of a feature which is not disclosed as in the originally filed documents as belonging to the invention leads to a mere limitation of the subject-matter of the application. In such a case, the legitimate interests of the public are taken into account by retaining the restrictive feature in the patent claim and at the same time ensuring that no rights can be derived from the amendment, in particular that the undisclosed feature is to be disregarded in the examination of patentability to the extent that it may not be used to support patentability (BGH, GRUR 2001, 140, 142 et seq. - Time telegram; BGH, GRUR 2011, 40 marginal 16 - angle measuring device; BGH, GRUR 2011, 1003 marginal 24 - integration element; BGH, GRUR 2013, 1135 marginal 16 - inkjet printer).

47           (3)    This case-law of the Federal Court of Justice does not conflict with the provisions of the European Patent Convention.

48           According to the case law of the Boards of Appeal of the European Patent Office, the inclusion in the patent claim of a limiting feature not disclosed in the original application documents as belonging to the invention regularly leads to revocation of the patent under Art. 123(2), 100 c EPC. If such a feature falls under Art. 123(2) EPC, it can neither be retained in the patent nor deleted from the claims without infringing Art. 123(3) EPC. The patent could only be maintained – by way of exception – if the application as originally filed provided a basis for replacing the restrictive features by others without infringing Art. 123(3) EPC (decision of the Enlarged Board of Appeal of 2 February 1994 - G 1/93, GRUR Int. 1994, 842 marginal 12 f. - restrictive feature/Advanced Semiconductor Products).

49           The Federal Patent Court and the Federal Court of Justice do not apply Art. 123(2) and (3) EPC when deciding on the revocation of a European patent granted with effect for the Federal Republic of Germany, but decide on the

basis of Art. II Sec. 6 IntPatÜbkG. By creating this provision, the national legislator has made use of the possibility to list the grounds for revocation of a European patent for the territory of the Federal Republic of Germany in accordance with Art. 138 EPC. According to Art. 138 EPC, a European patent – subject to Art. 139 EPC – may only be declared invalid on the grounds exhaustively listed therein. The standard thus precludes a decision by the national court declaring a European patent invalid even if none of the grounds listed in Art. 138 EPC apply. However, it opens the possibility for the national court to refrain from declaring the patent invalid even if such a ground exists, without thereby contradicting Art. 123 EPC as understood by the Enlarged Board of Appeal.

50           (4)    Such a waiver of the declaration of nullity is also appropriate for a European patent 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.

51           The Enlarged Board of Appeal has acknowledged that its view leads to harsh consequences for the patent proprietor (EPO, GRUR Int. 1994, 842 margin 13 limiting feature/advanced semiconductor products), because he runs the risk of being caught in an “inescapable trap” after an amendment of his application and losing everything even if the amendment limits the scope of protection of the patent. In contrast, the above-mentioned case law of the Federal Court of Justice makes it possible to dispense with a complete declaration of nullity of the patent without having to compromise the protection of the legitimate interests of third parties and the public. At the same time, it takes into account the constitutional protection of property (Art. 14 GG), which also includes the right to the patent and protects the patent proprietor from sovereign intervention unless this is necessary. This justifies applying this case law to European patents as well.

52           (5)    Insofar as claim 1 contains the feature that the lower surface of the disc-like shell is in contact with the porous pad, this is a mere concretization of an instruction for technical action which is disclosed in the originally filed documents as belonging to the invention.

53 (a) Whether the insertion of a feature not disclosed in the original documents is a mere limitation of the subject matter of the application or an aliud is determined by whether it merely substantiates an instruction to act technically which is disclosed in these documents as belonging to the invention, or whether it addresses a technical aspect which cannot be inferred therefrom either in its concrete form or even in abstract form as belonging to the invention (BGH, GRUR 2011, 40 marginal no. 22 - angle measuring device; BGH, GRUR 2011, 1003 marginal 29 - integration element; BGH, GRUR 2013, 1135 marginal 26 f. - inkjet printer).

54 (b) Accordingly, feature 4b – contrary to the opinion of the Patent Court – is not to be classified as an aliud. Insofar as this feature provides that the lower surface of the disk-like shell is in contact with the porous pad, no new technical aspect is introduced. Rather, it is a mere restriction in the sense set out above, by which the skilled person is taught to design the disk-like shell so flat that a substantially flat contact between its lower surface and the porous pad is established when the disk is pressed onto the pad and secured by means of the surgical cover.

55 (6) The admissibility of the limited defense is also not precluded by the fact that it is not admissible to limit the patent claim by a non-origin-disclosed feature. Feature 4b is already contained in the granted patent claim 1. The fact that it is part of auxiliary claim I, which is otherwise unobjectionable, cannot therefore call its admissibility into question.

56 3. The assessment of the Patent Court that claim 1 cannot be permissibly defended in the version of auxiliary request I (former auxiliary request 6 new) therefore does not stand up to legal review in the appeal proceedings.

57 This leads to the annulment of the contested judgment and to the remittal of the case to the Patent Court for a new hearing and decision (Sec. 119(2), (3) Patent Act). A own decision of the Senate in the case is not necessary (Sec. 119(5) sent. 1 Patent Act). The Patent Court has not yet examined the patentability of the subject-matter of claim 1 as amended by this auxiliary request. In this examination, which is now required, the Patent Court

will have to disregard the non-origin-disclosed feature.

Meier-Beck

Hoffmann

Deichfuß

Kober-Dehm

Feddersen

Previous instances:

Federal Patent Court, decision of 03 07 2012 - 4 Ni 15/10 (EU) combined with  
4 Ni 20/10 (EU) -