

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2020-12-15
Docket Number / Aktenzeichen:	X ZR 180/18
Name of Decision / Name der Entscheidung:	Scheibenbremse



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 180/18

Pronounced on:
15 December 2020
Anderer
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Scheibenbremse/
Disc brake

Patent Act Sec. 117 sentence 1; Code of Civil Procedure Sec. 531(2) sentence 1 No. 3

Pursuant to Sec. 117 sentence 1 Patent Act and Sec. 531(1) sentence 1 No. 3 Code of Civil Procedure, a citation to which the nullity plaintiff only became aware in the second instance may only be taken into account if the plaintiff explains and, if necessary, substantiates why a search which would have brought the document to light was not (yet) occasioned in the first instance. To this end, the plaintiff must specifically demonstrate how it created the search profile of its first-instance search and why it chose such a profile and not the one that led to the identification of the new citation (confirmation of Federal Court of Justice, judgment of 27 August 2013 - X ZR 19/12, BGHZ 198, 187 Rn. 30 f. - Tretkurbeleinheit).

Federal Court of Justice, judgment of 15 December 2020 - X ZR 180/18 –
Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 15 December 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:

The appeal against the judgment of the 7th Senate (Nullity Senate) of the Federal Patent Court of 25 October 2018 is dismissed at the expense of the plaintiff.

By operation of law

Facts of the case:

1 The defendant is the owner of European patent 1 974 150 (patent in suit), which was granted with effect for the Federal Republic of Germany, was filed on 18 January 2007, claiming priority from 18 January 2006, and relates to a disc brake. Patent claim 1, to which 19 further claims are referred back, reads in the language of the proceeding:

A disc brake comprising a brake carrier (3) fixedly arranged with respect to an axle beam (1) and having receiving elements (21) arranged thereon for mounting and floatingly supporting a brake caliper,
the brake carrier (3) having a lining shaft (10) for receiving a brake pad resting against a brake disc of the disc brake, and each further brake pad being arranged in a receptacle of the brake caliper, wherein guide surfaces (11, 12) are arranged on the pad shaft (10) for radial and tangential guidance of the brake pad and wherein the brake carrier (3) is arranged directly on the axle body (1) and extends substantially transversely thereto, characterized in that
the brake carrier (3) is designed as a flat plate, preferably a flat steel plate, and in that, for the interchangeability of the guide surfaces (11, 12) arranged on the lining shaft (10), at least one wear plate (40, 40a) is provided, which is arranged on the inside of the lining shaft (10) and on which a radial (11) and a tangential (12) guide surface for the brake pad are formed.

2 The plaintiff has argued that the subject matter of the patent in suit is not patentable, that the invention is not disclosed in such a way that the skilled person can carry it out, and that the subject matter of the property right goes beyond the content of the original application.

3 The defendant defended the patent in suit in three amended versions. The Patent Court declared the patent in suit null to the extent that it was no longer defended and dismissed the remainder of the action. The plaintiff's appeal is directed against this and it continues to pursue its first-instance claims. The defendant opposes the appeal and defends the patent in suit in the alternative in a further amended version.

Grounds of the decision:

4 The admissible appeal is unsuccessful.

5 I. The patent in suit concerns a disc brake intended primarily for
motor vehicles with a brake carrier which is firmly attached to an axle beam.

6 1. According to the statements in the patent in suit, disc brakes with
partly similar features were known from several prior publications.

7 The German public application 40 36 272 (P3) disclosed a disc brake
with a brake carrier which was composed of two separate parts arranged on
either side of the brake disc, which were detachably connected to each other
and of which only one was welded to the axle beam. The assembly of this brake
is relatively complex.

8 German public application 198 57 074 (D19) discloses a disc brake with
a brake carrier which holds only the inner brake lining, while the outer brake
lining is held and guided by the brake caliper. The brake caliper of this brake is
designed as a sliding caliper with sliding guide elements which are supported
on corresponding elements of the brake carrier. For this purpose, the brake
carrier has support arms which extend outwards beyond the brake disc. The
support arms are a component of the brake carrier and increase its weight.

9 2. Against this background, the patent in suit concerns the technical
problem of providing a disc brake which is as simple as possible in design, as
light as possible and as easy as possible to assemble.

10 3. To solve this problem, claim 1, as amended by the judgment under
appeal, proposes a disc brake, the features of which can be divided as follows
(amendment to the granted version highlighted):

Disc brake

1 with a brake carrier (3) arranged fixed relative to an axle
beam (1)

1.1 with receiving elements (21) arranged thereon for the
fastening and floating mounting of a brake caliper.

1.2 The brake carrier (3) has a lining shaft (10) for receiving a
brake pad resting against a brake disc of the disc brake,

and each further brake pad is arranged in a receptacle of the brake caliper.

1.2.1 Guide surfaces (11, 12) for radial and tangential guidance of the brake pad are arranged on the lining shaft (10).

1.3 The brake carrier (3) is arranged directly on the axle beam (1) and extends essentially transverse thereto.

2. The brake carrier (3) is designed as a flat plate, preferably a flat steel plate. 3.

3. for the interchangeability of the guide surfaces (11, 12) arranged on the lining shaft (10), at least one wear plate (40, 40a) arranged on the inside of the lining shaft (10) is provided,

3.1 on which a radial (11) and

3.2 a tangential (12) guide surface for the brake pad is formed.

11 4. According to the statements of the Patent Court not objected to by the parties, a qualified engineer (FH) specializing in mechanical engineering or automotive engineering with several years of experience in the development and design of brakes is to be regarded as a skilled person.

12 5. Some features require further consideration.

13 a) A brake carrier within the meaning of features 1, 1.2, 1.3 and 2 is the component of the disc brake which is firmly connected to an axle beam of the vehicle. It acts together with the brake caliper movably mounted thereon.

14 b) A flat, level steel plate within the meaning of feature 2 is, as the Patent Court has essentially correctly pointed out, a steel plate whose surface has no appreciable projections and whose thickness is small in comparison with its length and width.

15 aa) The Patent Court rightly chose as starting point of the interpretation not the granted version of the patent claim, but the version in which the defendant primarily defends the patent in suit.

16 This version is decisive for the determination of the subject matter and scope of protection of the patent according to Art. 69(1) EPC, provided that the contested decision is upheld. The fact that it came into being by amending the originally granted version may have to be taken into account in the interpretation. Contrary to the view of the appeal, however, this does not mean

that the granted version continues to be the starting point of the interpretation. Rather, the history of amendments can at most be considered as a factor in the interpretation of the version that is now decisive.

17 bb) The Patent Court was also correct in referring to the other contents of the patent specification when interpreting the term "planar" used in feature 2, although this term is not used in the description of the patent in suit.

18 According to Art. 69(1) sentence 2 EPC, the description and the drawings are to be used for the interpretation of the patent claims. Contrary to the view of the appeal, this applies in principle irrespective of whether a term used in the patent claim is also used in the description. Even if this condition is not met, the description or the drawings may provide clues as to how this term is to be understood in the context of the patent. This understanding also takes precedence over the general understanding in the constellation mentioned.

19 cc) In the case of dispute, it can be left open whether the explanations in Wikipedia referred to by the Patent Court, the definitions in DIN EN 10243-1 (Corrigendum 1, July 2005, P2 Chap. 5.2.3.1 and Table 5) submitted by the appellant or other definitions are to be used for the general understanding of the term "planar". As the Patent Court correctly stated in the result, the essential aspects for the decision of the legal dispute result independently from the patent specification itself.

20 Irrespective of the starting point, a plate is in principle to be regarded as flat within the meaning of feature 2 if it has no significant elevations or depressions. The extent to which such deviations are harmless depends on the respective function. This is specified here neither by a general lexicon nor by DIN regulations, but by the patent specification.

21 (1) Against this background, the Patent Court correctly inferred from the statements in the description of the patent in suit, according to which the plate may have weight-reducing recesses (para. 14) or openings (para. 19) as well as bores and countersunk holes for fastening or receiving other elements (para. 22 f.), and from the representation in Figures 4, 5 and 8, which is consistent therewith, that a plate designed in this way is also "flat" within the

meaning of feature 2.

22 This understanding is consistent with the prior art explanations contained in the description, according to which the disc brake disclosed in D19 has the features of the generic term, but the brake carrier of this brake is provided with support arms which extend outward to beyond the brake disc (para. 3). Both the attribute "flat" and the attribute "planar" serve to distinguish the brake from this embodiment known from the prior art. Consequently, they are to be interpreted as meaning that the plate must not have any integral components which protrude to any appreciable extent from its surface. This excludes in particular fastening arms, such as those used in D19, or comparable elements which form an integral part of the plate and serve to support the caliper or similar purposes essential to the function of the invention. In contrast, as the Patent Court correctly pointed out, parts detachably connected to the brake carrier and projecting from its surface are not harmful, in particular in the form of the receiving elements provided in feature 1.1 for fastening and supporting the brake caliper, which according to the description (para. 21) can be screwed into the brake carrier.

23 (2) Whether and to what extent the plate must furthermore comply with the requirement formulated by the Patent Court that the straight edge of a ruler can rest everywhere against the flat sides of the plate is not relevant for the decision of the dispute.

24 The wording used by the Patent Court could be misleading insofar as a ruler does not lie against the flat sides of the plate everywhere even if the plate has the recesses permitted by the patent in suit. Irrespective of this, it does not appear impossible that a plate can still be regarded as flat within the meaning of feature 2 even if it has minor protrusions in individual small areas which, however, serve neither the purpose of supporting the brake caliper nor similar purposes essential to the function of the invention.

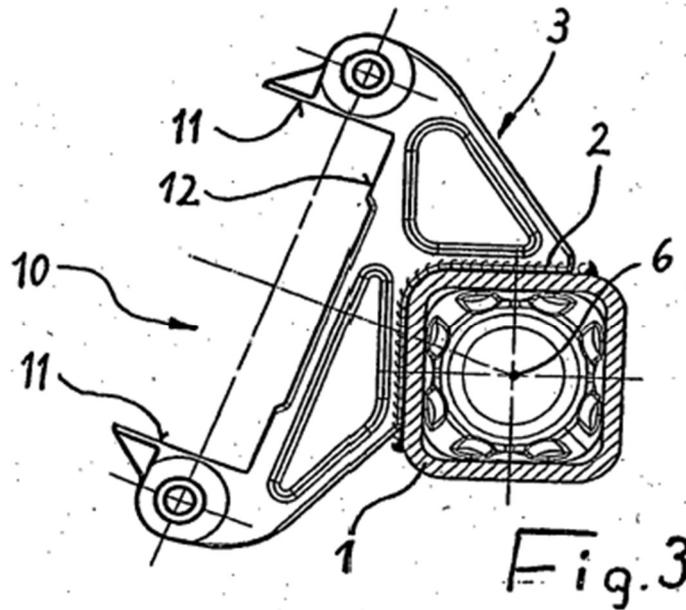
25 However, these questions do not require a final assessment because such design details are not apparent from the prior art.

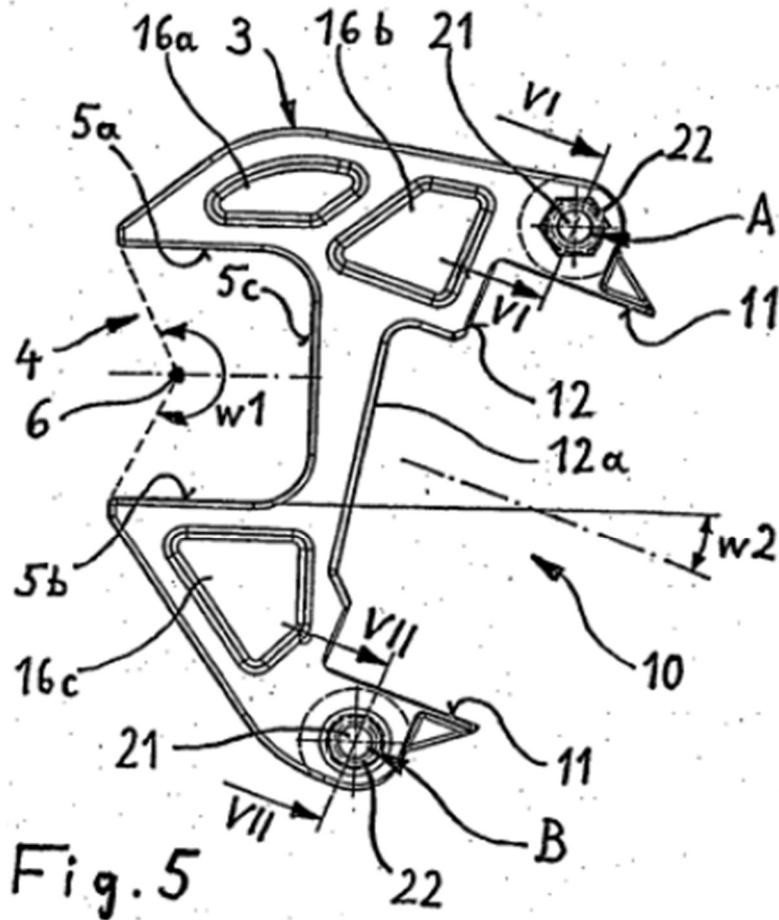
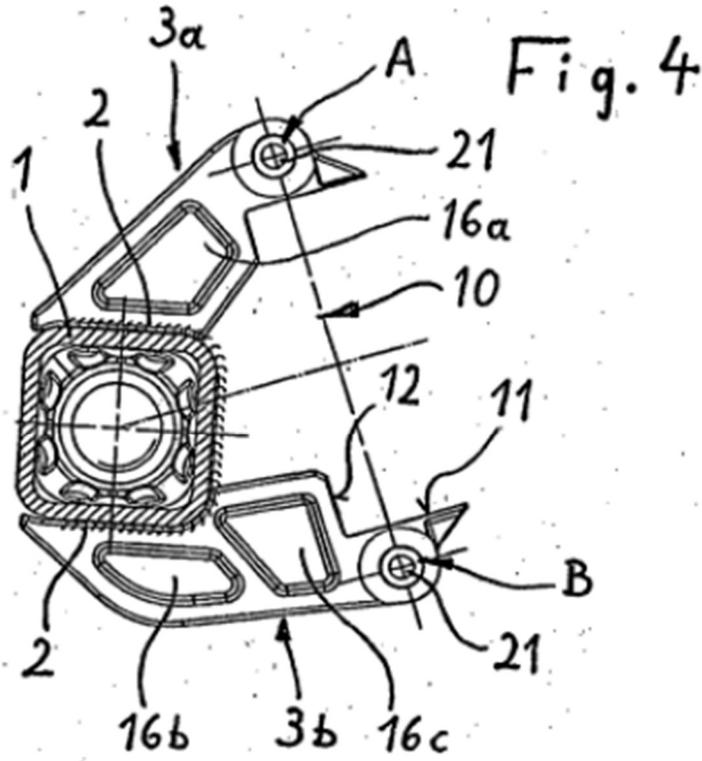
26 dd) The Patent Court correctly considered a plate to be flat within the

meaning of feature 2 if its thickness is small compared to its length and width.

27 This follows from the explanations in the description of the patent in suit, which cite as an example of a flat plate the steel plate shown in figures 3, 4 and 5, the thickness of which is given as 3 cm by way of example (para. 19).

28 All these figures, which are reproduced below, show a one-piece (Figs. 3 and 5) or two-piece (Fig. 4) plate whose length and width are significantly greater than its thickness.





29 ee) Contrary to the opinion of the appeal, the terms "flat plate" and "flat steel plate" in the granted version of patent claim 1 do not describe mutually exclusive alternatives.

30 The terms "flat" and "planar" are also to be interpreted on the basis of the granted version of patent claim 1 using the criteria outlined above. The wording contained therein, according to which the brake carrier is to be designed as a flat plate and preferably as a flat steel plate, expresses that the design as a flat plate is mandatory and the design as a flat steel plate is a preferred but not mandatory variant to realize this feature.

31 ff) It is not necessary to obtain an expert opinion as requested by the appeal.

32 The interpretation of a patent claim is a question of law to be answered by the court. A taking of evidence can only be considered with regard to technical principles relevant for the interpretation and with regard to the relevant knowledge of an average skilled person (Federal Court of Justice, judgment of 12 February 2008 - X ZR 153/05, GRUR 2008, 779 marginal no. 30 et seq. - Mehrgangnabe).

33 In the case in dispute, the objections raised by the appeal do not relate to technical principles or the knowledge of the average skilled person, but merely to the conclusions to be drawn therefrom. Thus, they concern questions of law, the answer to which is reserved for the Senate.

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

35 The amendment of patent claim 1 neither leads to a hitherto non-existent ambiguity nor to an inadmissible extension. Despite this amendment, the invention was also disclosed in an executable manner. This also applied to the subject matter of claim 7.

36 The subject matter of patent claim 1 was new. The US patent specification 6 223 866 (D3) discloses various embodiments of a sliding caliper brake. The European patent application 1 375 952 (D1), the German published application 37 29 154 (D2), the US patent specification 4 629 037 (D18) and the

German published application 198 57 074 (D19) in any case did not disclose feature 2.

37 The subject matter of the patent in suit was also not obvious to the skilled person. Regardless of which of the cited citations was chosen as the starting point, there was no suggestion that the brake carrier be designed as a flat steel plate within the meaning of feature 2.

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

39 1. The limited defense of patent claim 1 according to the main request of the defendant is admissible.

40 a) The admissibility of this limitation is not precluded by the requirement of clarity standardized in Art. 84 sentence 1 EPC.

41 As the appeal does not fail to recognize in its approach, an examination for clarity is not admissible in opposition or nullity proceedings, at least to the extent that the presumed ambiguity was already contained in the claims granted (cf. Federal Court of Justice, Judgment of 27 October 2015 - X ZR 11/13, GRUR 2016, 361 marginal no. 31 - Fugenband; Judgment of 19 January 2016 - X ZR 141/13, GRUR 2016, 475 marginal no. 39 - Rezeptortyrosine kinase I; EPO, Dec. of 24 March 2015 - G 3/14, OJ 2015, A102 marginal no. 73 et seq.).

42 Contrary to the view of the appeal, the limited defense in the dispute does not lead to additional difficulties that could establish ambiguity.

43 As already explained above, the terms "flat" and "level" are already provided for in the granted version. The only consequence of the amendment made is that the design of the flat plate as a flat steel plate, which was previously only optional, is now mandatory. The criteria to be used to assess whether a steel plate is to be considered flat and level have not changed as a result.

44 b) The subject matter defended by the defendant in the first instance is disclosed in an executable manner and does not go beyond the content of the originally filed version.

45 The divergent argumentation of the appeal with regard to both aspects is

based on the premise that according to the granted version of patent claim 1 and claim 10 of the application, which is identical in content, the terms "flat plate" and "flat steel plate" define mutually exclusive alternatives. This premise is incorrect for the reasons already stated above.

46 2. Contrary to the view of the appeal, the originally filed documents also disclosed the suitability of the receiving elements for a floating mounting of the brake caliper, as provided for in feature 1.1, as belonging to the invention.

47 Already in the original application (published as WO 2007/082520) it is stated that the receiving elements 21 serve for floating mounting of the brake caliper (p. 6 lines 14-16).

48 The fact that this is mentioned only in connection with one of several embodiments is irrelevant, if only because the other embodiments essentially deal with other possibilities for fastening the receiving elements, but not with a fundamentally different mounting of the brake caliper.

49 3. The Patent Court rightly decided that the embodiment protected in patent claim 7 is also disclosed in such a way that the skilled person can carry it out.

50 Patent claim 7 provides that the mouth-shaped opening (4) provided in patent claim 3, which serves to fasten the brake carrier to the axle beam, is U-shaped.

51 Contrary to the opinion of the appeal, this design is not precluded by the fact that patent claim 6, to which patent claim 7 refers, provides for a rectangular cross-section with two opposing surfaces.

52 In the description of the patent in suit, the opening (4) shown in Figure 5 is described as being mouth- or U-shaped (para. 15). Against this background, the patent in suit is to be interpreted to the effect that a rectangular configuration within the meaning of claim 6 is also to be regarded as a configuration in which the profile is rounded at the corners as in Figure 5, and that this configuration constitutes a U-shaped opening within the meaning of claim 7. 4.

53 4. The Patent Court was also correct in considering the subject

130) extends internally and externally. The arms also have guide rails (124A, 126A) on which the brake shoes (132, 134) are supported via lining springs (102, 104) (Sp. 5 lines 8-25).

58 In a modified embodiment, the brake carrier has only one of the two connecting beams (128, 130); furthermore, the guide rails (124A, 126C [sic]) can have a different profile if required (Sp. 5 lines 25-29).

59 In another embodiment, the inner brake pad (132) is held on a brake piston of the disc brake assembly (110), and the outer brake pad (134) is held on the outer leg section (116) of the brake caliper (112) (Sp. 5 lines 40-43).

60 bb) Thus, as the Patent Court correctly pointed out, feature 2 is not fulfilled in all three embodiments.

61 The brake carrier (122) is not flat, because it has components with the two arms (124, 126) and, in the first and the third embodiment, additionally with the outer connecting beam (130), which clearly protrude from the surface of the inner connecting beam (128).

62 From the fact that the second embodiment has only one connecting beam, it cannot be concluded that the two arms (124, 126) are also missing. Rather, it can be inferred from the explanations according to which in this embodiment the guide rails (124A, 126C) can have a different profile that this embodiment also comprises not only guide rails but at the same time the arms (124, 126) on which these rails are arranged.

63 cc) The Patent Court also rightly decided that feature 1.2 is not disclosed.

64 (1) As already explained above, in the first two embodiments both brake linings are arranged in the brake carrier (122).

65 Contrary to the view of the appeal, it is not sufficient for an arrangement within the meaning of feature 1.2 that a brake lining is located in the same spatial area as the brake carrier or the brake caliper. Rather, one lining must be arranged in a receptacle of the brake carrier provided for this purpose and at least one further lining must be arranged in a receptacle of the brake caliper.

The brake caliper (112) does not have such a receptacle in the first two embodiments disclosed in D3.

66 (2) In the third embodiment, feature 1.2 is not realized because both
brake linings are arranged in the brake caliper (112).

67 According to the findings of the Patent Court, which are not challenged
in this respect, the piston, which receives the inner brake lining belongs to the
brake caliper. Thus, there is no brake lining arranged on the brake carrier and
no receptacle suitable for this purpose.

68 b) In the further citations assessed by the Patent Court, there is in any
case no combination of features 1.2 and 2.

69 c) Against this background, the design of a disc brake with the
combination of features 1.2 and 2 was not suggested to the skilled person.

70 aa) D1 shows a brake carrier which embraces the brake disc from both
sides, as shown in Figure 4 reproduced below.

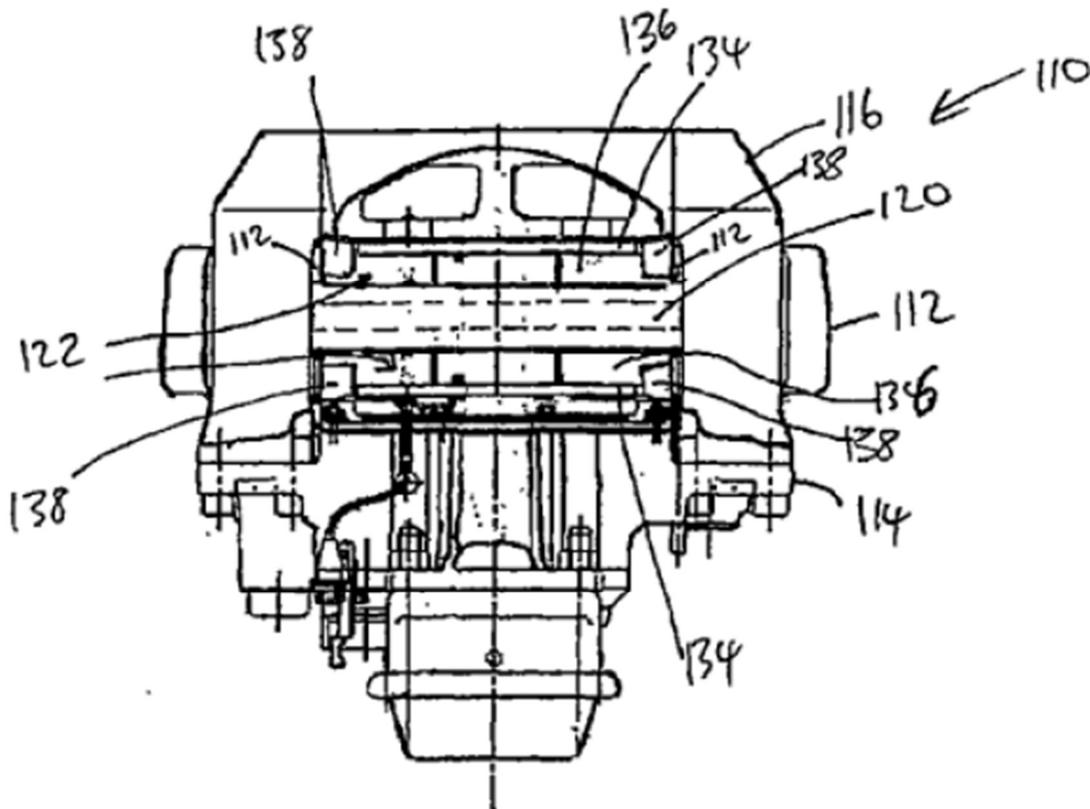


FIG. 4

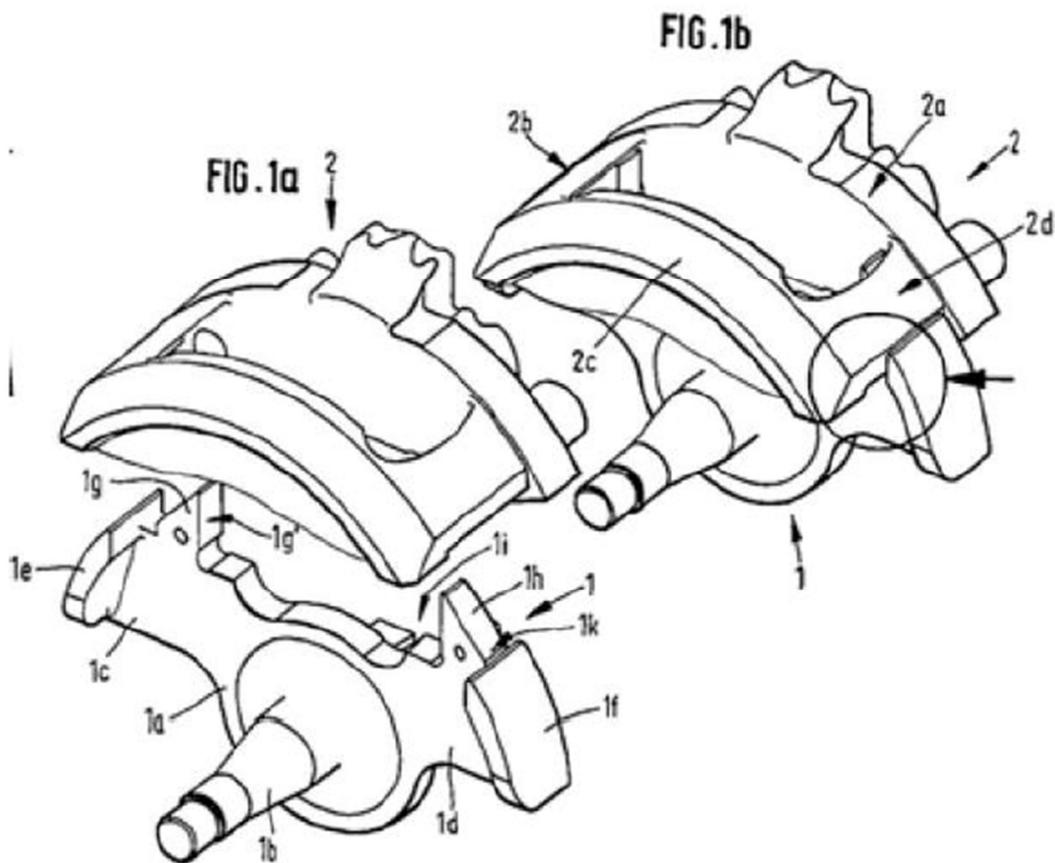
71 Thus, there is no disclosure of feature 2.

72 bb) D2 also discloses a brake carrier which embraces the brake disc, namely with an inner and an outer bridge part (10, 11) (Sp. 3 lines 56-63).

73 cc) The brake carrier (12) disclosed in D18 embraces the brake disc (10) with two boundary surfaces (24, 26) (Sp. 44 lines 12-19).

74 dd) D19 discloses two embodiments of a disc brake.

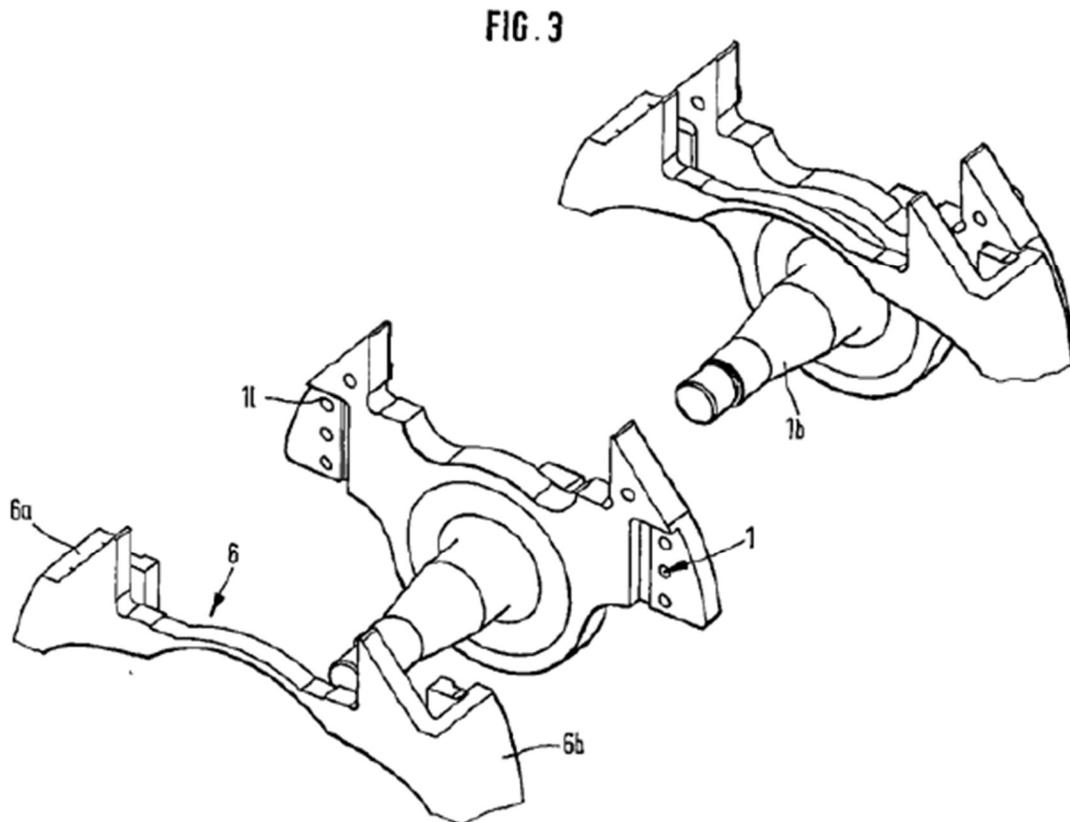
75 (1) In the first embodiment, which is dealt with in the description of the patent in suit and is shown in Figures 1a and 1b reproduced below, the brake carrier (1) has two support arms (1e, 1f) which serve to receive the brake caliper (2) (Sp. 4 lines 6-11).



76 Thus, a disclosure of feature 2 is also lacking in this citation.

77 (2) In an alternative embodiment shown in Figure 3 reproduced below, the guide arms (6a, 6b) are formed on a guide element (6) which is screwed to

the brake carrier (1). In the screwed-together state, this forms a brake carrier that forms a closed frame around the brake disc (Sp. 4 lines 52-63).



78 (a) Contrary to the opinion of the Patent Court, feature 2 is disclosed in this embodiment, because the brake carrier (1) is flat and flat.

79 The fact that the screw-on guide element (6) is described in the description of D19 as a component of the brake carrier establishes only a nominal difference.

80 The patent in suit also provides in feature 1.1 that mounting elements are arranged on the brake carrier for fastening and mounting the brake caliper. In the embodiments described in the patent in suit, these elements are not connected to one another by an additional component along the lines of the guide element (6) disclosed in D19. However, claim 1 leaves the more detailed design of the receiving elements to the skilled person and is limited to the specification that these are arranged on the brake carrier, i.e. do not form an integral part thereof. The design disclosed in Figure 3 of D19 also satisfies these requirements.

81 (b) The Patent Court rightly decided that the second embodiment disclosed in D19 does not realize feature 1.2 and that D19 therefore does not suggest combining a flat and level embodiment of the brake carrier with the arrangement of a brake pad in the brake caliper.

82 In the first embodiment in D19, feature 1.2 is realized because one brake pad is arranged in a pad well (1i) formed on the brake carrier (1) (Sp. 4 lines 12-21) and the other brake pad is arranged in a pad well (2e) formed in the brake caliper (2) (Sp. 4 lines 32-34). In the second embodiment with a flat and level brake carrier (1), on the other hand, both brake linings are arranged on the brake carrier according to the findings of the Patent Court, which are not challenged in this respect.

83 In order to arrive at the solution of the patent in suit, the skilled person should have adopted only half of the proposal disclosed in D19 for modifying the first embodiment, as it were, in such a way that he leaves the basic structure of the first embodiment and merely replaces the two support arms (1e, 1f) by components formed in the same way but attached separately. There was no suggestion for this from D19. The proposed modification is presented there as a self-contained concept. There are no indications in D19 that individual elements of this concept can be realized separately.

84 5. The patent application 2 413 162 (D20) submitted by the plaintiff for the first time in the appeal proceedings, the priority of which is claimed by the German utility model 20 2005 005 798 (D20de), which is essentially identical in content, is not to be taken into account pursuant to Sec. 117 Patent Act in conjunction with Sec. 529(1) No. 2 and Sec. 531(2) Code of Civil Procedure.

85 a) The new citation does not concern any aspect which the Patent Court recognizably overlooked or considered irrelevant (Sec. 531(2) sentence 1 No. 1 Code of Civil Procedure). Its submission was not omitted at first instance due to a procedural defect (Sec. 531(2) sentence 1 No. 2 Code of Civil Procedure), but because the plaintiff only became aware of it at second instance, namely from an examination communication issued in January 2020 concerning the German patent application whose priority the patent in suit claims.

86 b) The citation may also not be taken into account under Sec. 531(2) sentence 1 No. 3 Code of Civil Procedure, because it is due to negligence on the part of the plaintiff or its counsel, for whose fault it is responsible under Sec. 85(2) Code of Civil Procedure, that it did not already discover the citation at first instance and make it the subject of its submission.

87 According to the case law of the Senate, a citation which only came to the attention of the plaintiff in the second instance may only be taken into account pursuant to Sec. 117(1) Patent Act and Sec. 531(1) sentence 1 No. 3 Code of Civil Procedure if the plaintiff explains and, if necessary, substantiates why a search which would have brought the document to light was not (yet) occasioned in the first instance. To this end, the plaintiff must specifically demonstrate how it created the search profile of its first-instance search and why it chose such a profile and not the one that led to the determination of the prior art newly cited in the second instance (Federal Court of Justice, judgment of 27 August 2013 - X ZR 19/12, BGHZ 198, 187 Rn. 30 f. - Tretkurbeinheit).

88 It cannot be inferred from the plaintiff's submission that the research it initiated meets these requirements.

89 aa) The submissions regarding the first search carried out in response to the warning notice do not indicate which criteria were used for the search and why criteria were not used which would have led to D20 being found.

90 bb) It can be inferred from the submissions concerning the second search carried out after the statement of defense in the nullity proceedings that the plaintiff did indeed search for citations of classes F16D 55/*, to which both the patent in suit (F16D 55/00) and D20 (F16D 55/2265, 55/226 55, 55/227) are assigned, but combined this search with the name of individual plaintiffs or with other search terms which are not contained in D20.

91 In any case, this is to be considered negligent because the plaintiff itself found the European patent application 1 610 025 in connection with the second search, which originates from the same plaintiff as D20 and D20de, is assigned to classes F16D 55/00 and 55/226, among others, and relates to a device of largely identical construction. At any rate, the finding of this citation - which the

plaintiff had good reason to classify as possibly relevant vis-à-vis its trial counsel
- gave reason to extend the search for classes F16D 55/* to the plaintiff of this
citation.

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

Bacher

Grabinski

Hoffmann

Kober-Dehm

Rensen

Previous instance:

Federal Patent Court, judgment of 25 October 2018 – 7 Ni 12/17 (EP) –