

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2013-08-27
Docket Number / Aktenzeichen:	X ZR 19/12
Name of Decision / Name der Entscheidung:	Tretkurbeleinheit





FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 19/12

Pronounced on:
27 August 2013
Wermes
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Tretkurbeinheit/
Bicycle crank arm apparatus

Patent Act Sec. 117; Code of Civil Procedure Sec. 529(1) No. 2, Sec. 531(2) sentence 1 No. 1 to 3

- a) A new means of attack which is to be derived from technical information of a citation newly introduced in the second instance and which is to support the plea in law is to be admitted in patent nullity appeal proceedings irrespective of whether prior publication and technical content of the citation are undisputed or not only under the conditions of Sec. 531(2) sentence 1 No. 1 to 3 Code of Civil Procedure. The same applies to documents which could prove a technical development leading away from the invention and could therefore be considered as a means of defense of the defendant.
- b) If the plaintiff refers to the fact that a citation was not found until a search was carried out after the judgment at first instance, the means of attack based thereon shall only be admissible under Sec. 531(2) sentence 1 No. 3 Code of Civil Procedure, if the plaintiff demonstrates that the citation could not have been found with a properly selected search profile during the search carried out to substantiate the action for declaration of nullity of the patent.

Federal Court of Justice, judgment of 27 August 2013- X ZR 19/12 –

Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 27 August 2013, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Hoffmann as well as the judge Schuster

ruled that:

The Appeal against the judgment of the 5. Senate (Nullity Senate) of the Federal Patent Court, pronounced on 9 November 2011 is dismissed at the expense of the plaintiff.

By operation of law

Facts of the case:

1 The defendant is the proprietor of European patent 1 342 656, which was filed on 7 March 2003, claiming the priority of a prior U.S. application of 8 March 2002, and which was also granted with effect in the Federal Republic of Germany, and which relates to a bicycle crank unit and an assembly tool. It comprises 40 claims, the first of which reads in the language of the proceeding:

1. A bicycle crank arm apparatus comprising:
 - an axle (59) being adapted to be rotatably supported within a bottom bracket (33) of a bicycle frame, said axle having an axle body (348) with a first end portion (350) and a second end portion (354), wherein the second end portion has an outer peripheral surface and a threaded inner peripheral surface;
 - an axle bolt (380) having a threaded outer peripheral surface screwed into the threaded inner peripheral surface of the second end portion of the axle (59); a crank arm (60B) having an axle mounting boss (332) defining an opening for receiving the second end portion (354) of the axle therein, wherein the axle mounting boss (332) includes a first fastener for tightening the crank arm mounting boss around

the second end portion of the axle (59); and wherein the axle mounting boss (332) is positioned axially inwardly of the axle bolt (380),

characterized in that said axle (59) further comprises a projection extending radially outwardly from one of the first and second end portions (350, 354) of the axle body (348), wherein the projection is dimensioned and positioned to be located externally of the bottom bracket (33) so as to abut against a laterally outer side surface of a bicycle crank arm (60A) to prevent the crank arm (60A) from moving axially outwardly.

2 The plaintiff challenged the patent in suit to the extent of claims 1 to 25. It claimed that claim 1 went beyond the content of the original application documents and that the subject matter of claims 1 to 25 was not patentable because it was in any case not based on an inventive step. In support of this, the plaintiff relied at first instance on the German published application 100 32 778 (D1) and 23 59 437 (D2) and on the U.S. patent specification 4 201 120 (D3).

3 The defendant has only defended the patent in suit to a limited extent in the contested scope. In this context, the Patent Court declared it null insofar as it goes beyond the version of claims 1 to 22 that is apparent from the operative part of its judgment of 9 November 2011, and dismissed the action in all other respects. The plaintiff's appeal is directed against this, in which it continues to pursue its first-instance claim. The defendant opposes the appeal.

Grounds of the decision:

4 I. 1. The patent in suit relates to a bicycle crank assembly intended for mounting in the bottom bracket receptacle of the frame. Such assemblies typically include a shaft (hereinafter referred to as an axle, based on the translation of the patent in suit) extending through the bottom bracket receptacle on bearings, and two crank arms for pedals attached to the axle for driving the bicycle via one or more front sprockets (chain sprockets) attached mostly to the right crank arm and sprockets attached to the rear wheel axle, as well as a drive chain.

5 2. In the description of the patent in suit it is mentioned that sprockets and pinions usually have to be aligned correctly for the unimpaired use of the bicycle. For the lateral alignment of the axle required for this purpose, a known method provides for supporting the axle rotatably and centered within a tubular member while being held in lateral alignment by bearing assemblies installed at opposite ends of the tubular member. The axle and tubular member would then be inserted into the bottom bracket receptacle, and the required lateral position of the axle would be adjusted by screwing adapters, whose outer circumferential surfaces were threaded, into the bottom bracket receptacle to different extents on either side. The patent in suit criticizes the fact that the adapter elements would have to be long enough to cover the many different lateral positions that could be considered for the axle. As a result, it says, a portion of the threaded outer circumferential surface of each adapter element is regularly exposed, and the threads therefore frequently become fouled or rusted. Also, the axle, tubular element, and bearing assemblies usually had to be replaced as a unit.

6 The Patent Court saw the problem, the solution of which the patent in suit aims at in an unspoken manner - a task is not formulated in its description - in the fact that a pedal crank mechanism for a bicycle is to be provided, the components of which, despite the adjustability of the axle to different transverse positions, can be positioned protected against the build-up of rust and dirt and which are to a large extent individually replaceable. To this end, patent claim 1 in the version of the judgment under appeal (hereinafter only: patent claim 1) provides protection for a bicycle crank arm device which comprises (in square brackets the subdivision numerals used by the Patent Court):

1. an axle (59) [2],
 - 1.1 which is designed to be rotatably mounted in a bottom bracket mount of a bicycle frame (33) [2.1], and
 - 1.2 whose axle body (348) has a first end portion (350) and a second end portion (354) [2.2],
2. a flange (366) [6], which
 - 2.1 extending radially outwardly from the first end portion (350) of the axle body (348) [6.1],
 - 2.2 is dimensioned and positioned so that it is outside the bottom bracket support (33) [6.2],
 - 2.3 so as to abut against an outer side surface of a (first) bicycle crank arm (60A) to prevent the crank arm (60A) from moving outward in an axial direction, [6.3, 6.4]
3. an axle pin (380) [3] which has
 - 3.1 has a threaded outer circumferential surface [3.1] and
 - 3.2 is screwed into the inner circumferential surface (368) of the second end portion (354) of the axle [3.2], which has an outer circumferential surface and is provided with a (mating) thread on its inner circumferential surface (368) [2.3, 2.4],
4. a (second) crank arm (60B) [4] having an axle mounting boss (331) [4.1] which has
 - 4.1 delimits an opening (332) for receiving the second end portion (354) of the axle, [4.2]
 - 4.2 comprises a first fastening means for tightening the fastening eye around the second end portion (354) of the axle [4.3, 4.4], and
 - 4.3 is positioned axially inwardly of the axle bolt (380) [5].

7 4. a) In the relevant terminology of the patent in suit, the feature element "axle mounting boss" (features 4, 4.2), translated as "axle mounting eye", does not designate the openings in the pedal cranks through which these are

attached to the axle. Rather, these are assigned their own reference signs (308, 332). Nor does this term refer to the annular groove-like radial recess at the outer edge of the opening into which the flange is inserted in a shown embodiment. Rather, the term "axle mounting boss" is used in the original application documents and in the granted version of the patent in suit to describe the body of the cranks enclosing the openings 308 and 332 without radial area delimitation.

8 b) The technical meaning of the device protected by patent claim 1 can be understood in the light of the explanation of its assembly in the description (marginal no. 23 = marginal no. 32 of the translation). The axle bolt 380 is provided for adjusting the axial position of the pedal crank arm 60B after the axle has first been inserted from the outside through the opening 308 in the axle fastening eye 304 of the crank arm 60A on the sprocket side, so that the latter is held axially on the outside by the axle flange. Then, the axle is slid through the bottom bracket mount and the crank arm 60B is placed on the second end portion 354 of the axle with the opening 332 in the axle mounting eye 331. The axle bolt abutting the crank arm 60B is then screwed into the threaded inner circumferential surface 368 of the axle until the desired lateral axle position of the crank arm is achieved, in order to now tighten it with the first fastening device (feature 4.2). In the embodiment presented in marginal 23 of the description, adapter assemblies 124A and 124B are still described in connection with the installation of the device according to the claim, which include spacers 154A and 154B that serve to define the desired clearance between the pedal crank arms 60A and 60B and the bottom bracket support (cf. Figure 2).

9 II. The Patent Court, in rejecting the claim, held that the subject matter of claim 1 was not impermissibly broadened by providing an axle bolt 380 and a first fastening device without including spacers 154A and 154B. The original application documents showed not only the joint use of these components, but also the construction of the pedal assembly without such spacer elements, in the patent claim 1 formulated there. The further limitation of the granted patent claim 1 by claiming a flange instead of the originally provided projection was also permissible, because a flange was an embodiment of a

projection.

10 The Patent Court based its assumption that the subject matter of patent claim 1 was based on an inventive step essentially as follows. The bicycle crank arm device disclosed in D3 does not show a flange in the sense of feature group 2 and does not show a fastening device in the sense of feature 4.2. Thereby, D3 offers a complete solution for the tasks posed by the patent in suit (above 1 3). On this basis, there was no need to amend the arrangement proposed there.

11 D2 also did not provide a sufficiently concrete suggestion for finding the subject matter of patent claim 1. The end section of the axle on the sprocket wheel side could be interpreted as an axle fastening eye integrally formed on the axle and in this respect as a flange; however, this was in any case not designed to prevent outward movement of the crank arm in the axial direction. D2 also did not show an axle bolt and the associated features. From a technical point of view, the one-piece design of axle and crank arm may be recognized as disadvantageous; however, in this respect, the writing at most suggests that the crank arm on the sprocket side should also be fastened to the axle by means of splines and a fastening device (Figure 3 of D2, reference numeral 15). As far as the aspect of protection against rust and dirt is concerned, D2 suggests at most the adoption of the dust cap (Figure 1, reference numeral 8), but not the use of an axle pin.

12 D1 also does not lead to the subject matter of patent claim 1. The device disclosed there does not have a fastening device according to feature 4.2 and does not have an axle bolt with feature group 3. If one were to assume that the exchange of the lock nut shown in D1 for an axle bolt for screwing into an internal thread of the axle is an obvious measure for the skilled person in view of the problem of the exposed threaded sections exposed to dirt and corrosion, this would nevertheless not result in a fastening device for tightening the axle fastening eye around an end section of the axle, a fortiori not around that end section which is provided with an internal thread and receives the axle bolt, in accordance with the patent in suit. Such a fastening device does not protect against contamination. Combinations of the three mentioned citations also did not lead to the subject matter of patent claim 1.

13 III. The attacks of the appeal directed against this assessment are
unsuccessful.

14 1. The Patent Court rightly did not see an inadmissible extension in
the fact that the device protected by patent claim 1 does not include spacers
154A and 154B, although such elements are described in the original
application documents. According to the case law of the Federal Court of
Justice, the disclosure content of the patent application depends on the entirety
of the original application documents, as the appeal correctly points out.
However, this is aimed at the frequently raised objection that the granted patent
claims go beyond the subject matter of the claims formulated in the original
application documents and clarifies in this context that for the disclosure
content, the entirety of the original application documents and what emerges
from them directly and unambiguously as belonging to the invention from the
point of view of a skilled person is decisive (cf. Federal Court of Justice,
judgment of 22 December 2009 - X ZR 28/06, GRUR 2010, 513 marginal no.
29 mwN - Hubdertglieor II). A certain embodiment is also disclosed as belonging
to the invention if it is only described in the claims filed with the application
documents, but not in addition also in the description or there - as claimed here
- with certain additional elements, such as the spacers at issue here (see for
example Federal Court of Justice, judgment of 8 July 2010 - Xa ZR 124/07,
GRUR 2010, 910 marginal no. 46 - Fälschungssicheres Dokument).

15 2. The plaintiff also wrongly questions the admissibility of the limited
defense by insertions in feature group 2. It can be left open whether the
objection of the defendant that the plaintiff accepted the limitation of the patent
in suit in this respect before the Patent Court and is therefore excluded in the
appeal proceedings with attacks against its conformity with the disclosure of
origin is procedurally valid. In any case, the subject matter of patent claim 1 is
not inadmissibly extended by features of feature group 2.

16 a) The appeal is wrong in its assumption that the skilled person does
not regard the flange mentioned in the description and to be taken from the
drawings as a component essential to the invention, which he already
generalizes accordingly when reading the description. The original application
documents directly describe the function of the flange to hold the pedal crank

60A in its position axially outwardly on the axle (European patent application 1 342 656 A2 para. 20 et seq.: "... A radially outwardly extending flange 366 is disposed at the extreme end portion 350 for abutting against the laterally outer surface of axle mounting boss 308 of crank arm 60A ..."). Nothing else is expressed by feature group 2. Insofar as it is additionally described in feature 2.3 that the contact of the flange against an outer lateral surface of a bicycle crank arm is intended to prevent the crank arm from moving outward in the axial direction, this is merely an additional description of the effect of what is already expressed by feature group 2 as a whole.

17 b) That the flange "extends radially outwardly" is directly consistent with the original application documents ("a radially outwardly extending flange", loc.cit. para. 20). As far as in the limited defended version of patent claim 1 - superfluously - it is furthermore formulated that the flange extends "radially outwardly from the first end portion 350", with this adoption from the unsuccessful German translation of the patent specification of patent claim 1 nothing additional is added. In any case, the wording in the language of the proceedings remains decisive, in which the patent in suit would have been better defended in a limited manner.

18 c) The arrangement of the flange "outside the bottom bracket mount" (feature 2. 2) may not have been expressed literally in the original application documents, but it results from Figure 3 and, from a technical point of view, for which, according to the unchallenged findings of the Patent Court, a technical school engineer specializing in mechanical engineering who is involved in the design of pedal crank mechanisms at a bicycle manufacturer or supplier and has several years of professional experience in this field is to be taken as a basis, is in any case a technical matter of course in the type of device claimed in patent claim 1.

19 d) Insofar as the flange, according to the wording of the restricted version of patent claim 1, comes to rest against an "outer lateral surface of a bicycle crank arm", this does not constitute an inadmissible extension, because the "outer lateral surface of a bicycle crank arm" in the diction of the patent in suit corresponds to that of the axle fastening eye and, contrary to the view of the plaintiff, no delimitable restriction of the radial extension of the flange can be

derived from the latter (I 4 a above).

20 3. The assessment of the inventive step by the Patent Court is not undermined by the appeal and is also not legally objectionable in other respects.

21 The state of the art held against the patent in suit in the first instance does not make the subject matter of claim 1 appear obvious, if only because neither one of the three documents D1 to D3 in itself nor conceivable combinations of the documents offered a sufficiently concrete suggestion for the apparatus according to the invention, the technical meaning of which, as explained, is to be seen in particular in the fact that the axial relative position of the pedal crank arm 60B can be fixed with the aid of the bolt 380 to be screwed into an internal thread of the axle, in order to subsequently tighten the arm in this position (I 4 b above).

22 With regard to the assessment of documents D1 to D3 for the evaluation of novelty and inventive step in detail, the Senate refers to the explanations in the judgment under appeal and makes the following additional remark with regard to the arguments in the written appeal and the discussions at the oral proceedings: The Patent Court correctly determined the task by interpreting the claim with reference to the description. If, as in the present case, no task is formulated, the problems mentioned in the description and associated with the known solutions come into consideration as indications for the correct interpretation of the patent claim, from the performance result of which, in turn, the task in the sense of the technical problem actually solved can be derived (Federal Court of Justice, judgment of 4 February 2010 Xa ZR 36/08, GRUR 2010, 602 marginal no. 27 joint arrangement). This does not preclude that, when examining the inventive step, other technical problems must also be taken into account, for the solution of which the skilled person may be prompted to propose or at least consider the technical teaching of the invention (judgment of 11 March 2011 - X ZR 72/08, GRUR 2011, 607 nos. 12, 14 - kosmetisches Sonnenschutzmittel III).

23 In order to move from the subject-matter of D1 to the subject-matter of patent claim 1, it would not be sufficient to replace the locking nut in the pedal crank device shown in D1 with an axle bolt, such as that provided for locking the

pedal cranks in D3. This is because neither in D1 nor in D3 is the axial adjustment function applied to the bolt within the solution of the patent in suit. Therefore, it is not apparent what, without retrospective consideration, should have given technical cause for modifying D1 in this respect. Furthermore, from a technical point of view, there would be no reason to replace the attachment of the crank arm 14 corresponding to the pedal crank arm 60B of the patent in suit in D1 without further ado by the one shown in D2, which the patent in suit only seems to take up when feature 4.2 is considered in isolation. This is because the chain drive system to the rear wheel, which forms the actual subject matter of D1, entails, as can be seen from the figures, that chain wheels are mounted on both sides of the frame tubes, so that there is technically and structurally no room for tightening a pedal crank corresponding to the crank arm 60B by closing a gap between two fastening lugs 337 and 338 (cf. Figures 6 and 7 of the patent in suit), even on the assumption that this document is referred to in technical terms for the assembly of bicycle crank units at all. Therefore, the suggestion content of D1 in any case does not go beyond the mounting and holding of the crank arm 60A used by the patent in suit.

24 4. It is not necessary to decide to what extent the appellant's submissions constitute new submissions within the meaning of Sec. 117 Patent Act in conjunction with Sec. 531(2) sentence 1 Code of Civil Procedure, insofar as the plaintiff, for the combination of a pedal crank device according to D1 with an attachment of the crank arm corresponding to the pedal crank arm 60B of the patent in suit, as shown in D2, which in its opinion is obvious, also refers for the first time in the grounds of appeal to the British patent specification 549 498 (D8) as an alternative to D2, US patent 4 406 504 (D4), Japanese patent specification Hei 8-258779 (D5), European patent specification 887 207 (translation = D6) as well as - in general - further specifications (D9 - D14) in which clamping mechanisms for bicycle cranks with tangential screw are described. The plaintiff does not derive anything from this that goes beyond D2.

25 5. Insofar as the plaintiff refers for the first time in the statement of grounds of appeal to the Japanese published application Sho 63-133488 (D7) and in the brief of 28 August 2012 filed after expiry of the time limit for filing the statement of grounds of appeal supports an independent attack on this

document which, in combination with citation D1, suggests the subject matter of the patent in suit, the scope of examination of the Court of Appeal under Sec. 117 Patent Act in conjunction with the provisions of Sec. 529(1) No. 2, Sec. 531(2) sentence 1 No. 1 to 3 Code of Civil Procedure, which apply mutatis mutandis, does not extend to this.

26 a) Despite the indication given to it immediately after receipt of the statement of grounds of appeal, the plaintiff did not present any point of view during the oral proceedings before the Senate under which the new means of attack could be admitted under these provisions.

27 It neither concerns a point of view which the Patent Court would have recognizably overlooked or considered irrelevant (Sec. 531(2) sentence 1 No. 1 Code of Civil Procedure), nor does the appeal allege a procedural violation, in particular in the form of an insufficient reference under Sec. 83(1) Patent Act (Sec. 531(2) sentence 1 No. 2 Code of Civil Procedure). Admission would therefore only be possible if the failure to assert the claim at first instance was not due to negligence on the part of the plaintiff or its counsel (Sec. 531(2) sentence 1 No. 3 Code of Civil Procedure).

28 In this regard, the plaintiff stated that several court disputes were pending between the parties, which included several patent infringement suits filed by the defendant and several European opposition proceedings pending against the plaintiff's patent rights. Most recently, the defendant had filed a new infringement action based on European patent 2 202 141. An opposition had been filed against this patent on 31 May 2012, and a comprehensive state of the art search had been carried out in preparation for it, which had brought to light the state of the art introduced in the appeal proceedings.

29 b) This reasoning is already unsuitable to exclude a negligent conduct of the proceedings because of the citations mentioned for the first time in the grounds of appeal no less than five, namely the British patent specification 549 498 (D8), the German patent specification 61 009 (D11) and the US patent specifications 4 728 218, 4 704 919 and 5 010 785 (D12 to D14) are already listed as citations on the cover sheet of the patent specification in suit and D8 is furthermore dealt with in the description of the patent in suit. Therefore, the

assertion that only a renewed search enabled the plaintiff to introduce further state of the art into the patent nullity proceedings cannot be true in the sweeping manner asserted.

30 c) Moreover, lack of negligence cannot be justified by the fact that the search which brought the newly introduced state of the art to light was only carried out in the appeal instance. Rather, it must be explained why this research was not (yet) necessary even if the case had been carefully conducted in the first instance. Such a statement is missing here; it also does not result from the further statements of the plaintiff in the oral hearing.

31 On the one hand, it has additionally argued that the subsequently introduced documents could only have been identified in a broader search than the one carried out for the first-instance proceedings, which would have been correspondingly more extensive. With respect to D7, which occupies a prominent position in the plaintiff's second-instance submissions and whose admission alone requires examination according to the above, this is not valid without further explanation - not provided by the plaintiff - if only because the document belongs to the same group of the same subclass of the international patent classification as the patent in suit (B62M 3/00). Moreover, the demonstration of a lack of negligence in the determination of the state of the art relevant for the substantiation of the attack in suit requires that the plaintiff concretely demonstrates how he created the search profile of his first instance search, why he chose such a profile and not the one that led to the determination of the state of the art newly cited in the second instance, and that with the chosen search profile the attack against the patentability of the subject matter of the patent in suit, which was presented in the second instance, could not be made in the first instance. Only such a statement - which is missing in the case in dispute - enables the defendant to comment on the question whether the search in the first instance complied with diligent conduct of the case and enables the Federal Court of Justice to examine whether the requirements of Sec. 531(2) sentence 1 No. 3 Code of Civil Procedure for the admission of the new argument are met. According to Sec. 112(3) No. 2 lit. c Patent Act, the facts on the basis of which new means of attack and defense are to be admitted under Sec. 117 Patent Act are therefore also among the grounds of appeal which the

statement of grounds of appeal must already contain if they are to support the admissibility of the appeal. It was the declared regulatory objective of the reform legislator to transform the nullity appeal proceedings into an instrument for error control and correction (Explanatory Memorandum to the Draft for Simplification and Modernization of Patent Law, BIPMZ 2009, 307, 316). The reformed Patent Act is based on the legislative commitment to patent nullity proceedings in which the subject matter of the dispute is in principle conclusively determined in the first instance and which can be extended later only under the conditions of a corresponding application of Sec. 529 to 531 Code of Civil Procedure. It would be incompatible with this objective to allow a patent search effort which is subject to subjective expediency and which in principle distinguishes between the two instances of the nullity proceedings.

32 As far as the plaintiff, with regard to the Japanese origin of D7, on the other hand, has referred to the fact that Japanese documents were only entered into relevant databases as of 2006, and not retroactively either, the defendant convincingly points out that the plaintiff had increased reason to extend its search to Japanese documents in view of the market position of the defendant in the manufacture of bicycle components. Moreover, also from this point of view, the plaintiff has not explained the reason why it was able to submit citation D7, which was published before 2006 (1988), in the appeal proceedings but not at first instance.

33 d) Contrary to what the plaintiff seems to think, it is in principle also not sufficient to show lack of negligence that the Patent Court in its notice under Sec. 83(1) Patent Act, as here, did not set a time limit for supplementing its submissions. The order of the presiding judge, in which the Patent Court pointed out to the plaintiff that the attacks based on citations D1 to D3, which the plaintiff had made, were not likely to establish an obviousness of the subject matter of the patent in suit, gave the plaintiff cause to examine whether a supplementation of the pleading was possible and required. The Patent Court's decision not to set a time limit as provided for in Sec. 83(2) Patent Act favored the plaintiff to the extent that it allowed it to introduce counter-arguments in response to the reference made, which were factually related to the reference, into the first instance proceedings until the end of the oral proceedings without being bound

to a set time limit and without having to fear a rejection under Sec. 83(4) sentence 1 Patent Act. However, the failure of the Patent Court to set a time limit does not provide a basis for making up in the appeal instance what was completely omitted in the first instance outside the framework set in accordance with Sec. 531(2) sentence 1 Nos. 1 to 3 Code of Civil Procedure.

34 e) Contrary to the plaintiff's view, the new means of attack based on D7 is also not admissible because the public accessibility of the document prior to the priority date and the technical information content to be inferred from it would be undisputed.

35 aa) According to the case law of the Federal Court of Justice, the concept of new means of attack and defense in civil proceedings only covers contentious and therefore evidentiary submissions (Federal Court of Justice, judgment of 18 November 2004 IX ZR 229/03, BGHZ 161, 138, 142; order of 23 June 2008 GSZ 1/08, BGHZ 177, 212, para. 10). In justifying its decision, the Federal Court of Justice pointed out in particular that it would be contrary to the purpose of civil proceedings to interpret the provision in such a way that the court would have to decide with its eyes open on an incorrect factual basis not presented by either party (BGHZ 161, 138, 143). These considerations may be based on the introduction of new state of the art in patent nullity proceedings, the particularities of which the legislator of the Patent Law Modernization Act has taken into account in Sec. 117 Patent Act by ordering a merely corresponding application of Sec. 531(2) (cf. the explanatory memorandum of the Federal Government's draft bill, BT-Drucks. 16/11339, p. 24; Gröning, GRUR 2012, 996, 998 et seq.), but cannot be transferred.

36 bb) The patentability of the subject matter of the patent in suit is determined by whether the state of the art anticipates the protected technical teaching or provides the skilled person with sufficient suggestions to modify or further develop known technical solutions to this technical teaching. The state of the art consists of the regularly unmanageable multitude of printed matter and other citations, from which building blocks for the explanation incumbent upon the plaintiff in the patent nullity proceedings can arise, that and to what extent the subject matter of the patent in suit was taken in a manner detrimental to novelty or suggested to the skilled person. Apart from the rather rare cases in

which relevant components of the state of the art consist of an obvious prior use alleged by the plaintiff or the point in time at which a certain technical teaching was made available to the public is disputed, the state of the art discussed in the litigation essentially consists of officially published patent documents or other publications of fixed date and is therefore as a rule undisputed as such. However, the state of the art, which is typically as unlimited as it is unmanageable, only becomes a means of attack by the plaintiff's presentation of which concrete contribution which components of which citation are to make to the asserted lack of patentability (Federal Court of Justice, judgment of 28 August 2012 - X ZR 99/11, BGHZ 194, 290 marginal no. 36 - Fahrzeugwechselstromgenerator). Although patentability is ultimately decided by the legal conclusions to be drawn from the (potentially) relevant contributions to the assessment of novelty or inventive step, the Patent Court is neither obliged nor even entitled to determine on its own initiative what these relevant contributions might be. Otherwise, the plaintiff could limit himself to submitting or even listing a multitude of citations and leave it to the Patent Court to evaluate their content and to examine whether and to what extent indications for a lack of patentability result therefrom. In doing so, however, the Patent Court would fail in its task of impartially weighing whether the pleading justifies the claim, and would place itself in the role of a plaintiff's aide; however, the principle of official investigation does not provide a basis for this either. This shows that in patent nullity proceedings the undisputed affiliation of a certain citation to the state of the art cannot be a suitable standard for the qualification as (new) means of attack. Rather, the means of attack is the plaintiff's presentation of which specific technical information that the skilled person can take from a specific citation or specific citations is supposed to justify the claim. The same applies to citations which could prove a technical development leading away from the invention and which could therefore be considered as a means of defense of the defendant.

- 37 cc) Accordingly, it is no longer relevant that the plaintiff has not yet submitted a translation of the descriptive part of citation D7 from Japanese into German at the hearing, which could have substantiated an undisputed content of the technical information provided by the citation and would have enabled the Senate to assess the disclosure content of the document on the merits.

38 IV. The decision on costs is based on Sec. 121(2) sentence 2 Patent Act in conjunction with Sec. 97(1) Code of Civil Procedure.

Meier-Beck

Gröning

Judge at the
Federal Court of
Justice Dr.
Grabsinki is unable
to sign due to
vacation.

Meier-Beck

Hoffmann

Schuster

Previous instance:

Federal Patent Court, judgment of 9 November 2011 – 5 Ni 36/10 (EP) –