

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-10-05
Docket Number / Aktenzeichen:	X ZR 21/15
Name of Decision / Name der Entscheidung:	Zungenbett



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



FEDERAL COURT OF JUSTICE
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 21/15

Pronounced on:
October 5, 2016
Hartmann
Judicial Secretary as
Clerk of the court
registry

in the matter

Zungenbett/
Tongue bed

EPC Art. 69(1); Patent Act Sec. 14

In case of doubt, the same terms have the same meaning in the context of a patent claim. A different understanding of a term in the generic term and in the feature of a patent claim or otherwise in different contexts can only be considered if the interpretation of the patent claim in its entirety, taking into account the description and the drawings, results in such an understanding.

Federal Court of Justice, judgment of October 5, 2016 – X ZR 21/15–
Higher Regional Court of Düsseldorf
Regional Court of Düsseldorf

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on October 5, 2016, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Dr. Bacher, Hoffmann and Dr. Deichfuß

ruled that:

On appeal on points of law by the plaintiff, the judgment of the 2nd Civil Senate of the Higher Regional Court of Düsseldorf of January 29, 2015 is reversed.

The defendant's appeal against the judgment of the 4c Civil Chamber of the Regional Court of Düsseldorf of April 30, 2013 is dismissed.

The defendant shall bear the costs of the appeals.

By operation of law

Facts of the case:

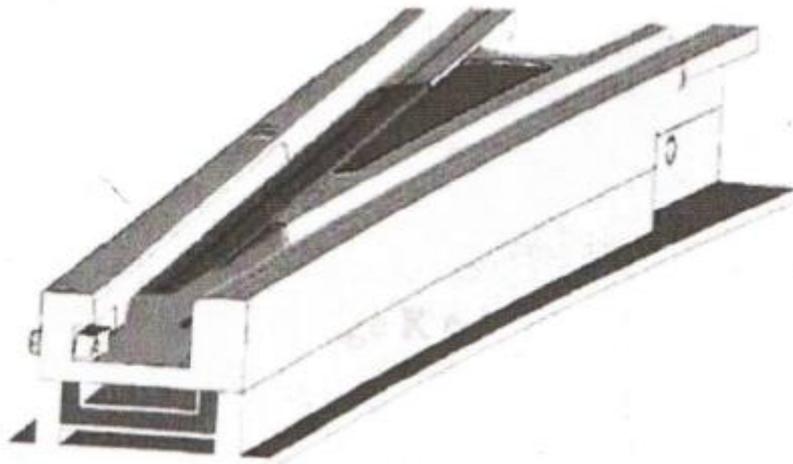
- 1 The plaintiff is the proprietor of German patent 101 24 624, which was filed on May 21, 2001, claiming the priority of a domestic first application dated March 17, 2001 (hereinafter: patent in suit). Patent claim 1 reads as follows:

"A tongue device for a switch, in particular for tramway tracks, made of a mainly trough-shaped tongue bed made of a solid block, characterized in that the upper part (1) of the tongue device with the tongue bed (4) is made of a high-strength steel and the lower part (2) of the tongue device is made of structural steel, the upper part and the lower part being connected to each other."

- 2 Claim 2 puts a centerpiece for a switch under protection. Patent claims 3 to 5 are directly or indirectly related back to patent claims 1 or 2. An action

brought by the defendant, among others, for a declaration of nullity of the patent in suit was unsuccessful in both instances with regard to patent claims 1 to 4 (Federal Patent Court, judgment of May 5, 2014 – 7 Ni 4/14, juris; Federal Court of Justice, judgment of March 24, 2016 – X ZR 47/14, juris).

- 3 The defendant manufactures and sells switch systems in which tongue devices also referred to by the defendant as "monobloc tongue devices" are used (challenged embodiment). In such a "monobloc tongue device", which is shown schematically in the following drawing,



the upper part is made of a solid block of high-strength steel, while the lower part is made of simple structural steel and is composed of three individual parts welded together. The upper and lower parts are also joined by welding.

- 4 The plaintiff sued the defendants for infringement of the patent in suit, seeking injunctive relief, accounting, and a declaration of liability for damages. The Regional Court granted the claim. The appeal filed by the defendant led to the dismissal of the action. In its appeal on points of law, which was allowed by the Senate, the plaintiff seeks to have the judgment of the court of first instance restored.

Grounds of the decision:

5 The plaintiff's appeal on points of law is successful and leads to the restoration of the first-instance judgment.

6 I. The patent in suit relates to a tongue device and a centerpiece for a switch, in particular for tramway tracks. The patent in suit states that tongue devices with a tongue bed on which the switch tongue can slide back and forth are preferably welded together or, as disclosed in German published application 40 11 523, milled out of a solid block (para. 2).

7 In the case of the tongue device, the wear surfaces in the contact area between the wheel and rail and the sliding area of the tongue in the tongue bed would then have to be hardened. However, hardening is very time-consuming and costly. In addition, the heat treatment would cause stresses and distortion. The parts of the tongue device would then have to be manually straightened in a correspondingly time-consuming process (Para. 3).

8 It is also known to manufacture a tongue device or a centerpiece for a switch from a solid block of high-strength steel. This process does not require subsequent hardening. However, the disadvantage is that the high-strength steel is very expensive. In addition, it is difficult to obtain solid blocks of the required grade and thickness on the market (paragraph 4).

9 According to the patent specification, the patent in suit is based on the task of reducing the material costs for a tongue device or centerpiece for a switch, made from a solid block.

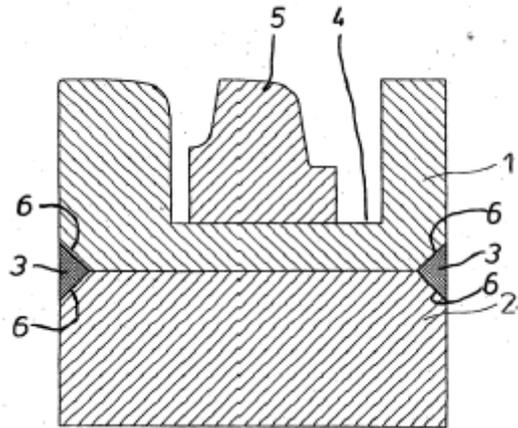
10 According to claim 1, this is to be achieved by a tongue device with the following features:

- 1.a) Tongue device for a switch,
- 1.b) made from a mainly trough-shaped tongue bed manufactured from a solid block;
- 1.c) the upper part (1) of the tongue device with the tongue bed (4) is made of a high-strength steel;

1.d) the lower part (2) of the tongue device is made of mild steel;

1.e) the upper part and the lower part are joined together.

11 The drawing reproduced below (Figure 1) is taken from the patent specification and shows an example of a tongue bed according to the invention:



12 II. The Court of Appeal substantiated its decision essentially as follows:

13 The challenged embodiment does not implement the technical teaching of the patent in suit, because the lower part of the tongue device is not obtained from a solid block as required by the patent, but is produced by welding together individual profile parts. The opinion of the Patent Court in the nullity proceedings that the partial feature "made from a solid block" refers only to the upper part of the tongue device equipped with the tongue bed, but not to the lower part made of structural steel, must be contradicted. If the claim parts merely explaining the intended use and therefore irrelevant for determining the scope of protection were omitted, the patent in suit claimed protection for a "tongue device made of a mainly trough-shaped tongue bed". Despite its grammatical inadequacy, this wording was not incomprehensible to a skilled person. It was to be understood as meaning that the tongue device according to the patent was formed by the (mainly trough-shaped) tongue bed, with which both formulations of the generic term – "tongue device" and "tongue bed" – were synonymous. This is not contradicted by the fact that the word "tongue bed" appears again in the characterizing part of patent claim 1, in that it is provided that "the upper part of the tongue device with the tongue bed" consists of high-strength steel. It is true

that the "tongue bed" is shown there as a mere component of the tongue device according to the patent, whereas the "tongue bed" is synonymous with the entire device in the context of the generic term. However, there was no principle of interpretation according to which identical terms of a patent claim were always to be interpreted in the same sense. Therefore, there was nothing to prevent the consideration that the term "tongue bed" in the context of the generic term described the overall device and in the characterization – more specifically – described the contact surface on which the switch tongue was displaced and the vehicle wheels rolled. Consequently, the two-part tongue device had to meet the requirement of being made from a solid block.

14 The skilled person would find this confirmed in the formulation of the problem in the patent specification and in the advantage details of the solution according to the patent, when they refer to the cost reduction for a tongue device made of a solid block. With the requirement for a tongue device obtained from a solid block, the patent in suit distinguished itself from solutions in which the stock rail was assembled, preferably welded, from individual parts. This is clear from the introductory descriptive text, where it is pointed out that tongue devices are assembled from individual parts or milled out of a solid block. By referring to a tongue device "made from a solid block", claim 1 makes it clear that the patent in suit does not consider the other solution. Accordingly, the description is based on the solution concept known from the German patent specification 40 11 523 of a monobloc way and not on the approach of a profiled body assembled from different components.

15 III. This interpretation does not withstand review by the Court of Appeal on points of law.

16 1. In interpreting claim 1, the Court of Appeal initially considered only the features of the generic term and, on the basis of an analysis based primarily on linguistic criteria such as the conventional understanding of the term "trough", arrived at the "intermediate result" that the phrases "tongue device" and "tongue bed" were synonymous according to the understanding of the patent in suit. It is true that the Court of Appeal then also dealt with the characterizing part of the patent claim, according to which the tongue bed is shown as a mere component of the upper part of the tongue device. However, it contented itself in this respect

with the statement that the same terms of a patent claim are not always to be interpreted in the same sense and that therefore there was nothing to prevent the concept of the tongue bed from being interpreted differently in the context of the generic term describing the overall device than in the label describing the contact surface.

17 This is not free of legal errors. It is not excluded that the same terms may have different meanings in different contexts when interpreting a patent claim. However, this can only be assumed if the interpretation of the patent claim in its entirety, taking into account also the description and the markings, results in such an understanding. In this context, it is irrelevant for the interpretation whether the same terms are used in the generic term or in the characterizing part of the patent claim, since the external structure of the patent claim as such has to remain out of consideration for the determination of the subject matter of the patent (cf. Federal Court of Justice, judgment of January 20, 1994 – X ZR 102/91, 1994, GRUR 1994, 357, 358 Muffelofen; Benkard/Scharen, Patent Act, 11th ed. (2015), Sec. 14 Patent Act marginal no. 13). Rather, the decisive factor is the meaning of the patent claim in its entirety and the contribution that the individual features make to the performance result of the invention (Federal Court of Justice, judgment of July 17, 2012 X ZR 117/11, BGHZ 194, 107 marginal no. 27 – *Polymerschaum*), whereby, in case of doubt, the same meaning is to be attributed to identical terms within the scope of a patent claim.

18 2. In the present case, patent claim 1 provides that the tongue device is composed of an upper and a lower part, the upper part comprising the tongue bed and being made of a high-strength steel, while the lower part is made of structural steel, and the parts are joined together. From the further statement that the tongue device is to "consist of" a substantially trough-shaped tongue bed made of a solid block, it is clear that the upper part of the tongue device, which has the tongue bed and consists of a high-grade steel, is required to be formed of a solid block, but not the lower part thereof, which is required to consist of structural steel, but apparently does not include a tongue bed. Accordingly, as already correctly assumed by the Patent Court in its judgment in the nullity proceedings (*loc.cit.*, *juris para.* 63 et seq.), the term tongue device according to the invention used both in feature 1b and in feature 1c has the

same technical meaning.

19 This is also not contradicted by the fact that, if one takes the patent claim at its word, the tongue device according to feature 1b is said to be "made of" (consist of or be made of) a tongue bed made of a solid block, which, when viewed purely philologically, could rather indicate an overall device created from a solid block. The wording, which the Court of Appeals also described as "grammatically inadequate," is recognizably unfortunate. On the one hand, the tongue device according to features 1c and 1d is in two parts and, by its nature, only the upper part has a tongue bed. Secondly, the upper part is also not worked "from" a tongue bed, but rather the tongue bed is worked "from" the upper part. Finally, it follows from the two-part nature that the entire tongue device cannot be worked out of a solid block, but at most its upper and lower parts can each consist of a solid block. Accordingly, the wording of the patent claim in feature 1b – the linguistic inadequacy of which can be easily eliminated by reading the preposition "made of" as "with" when it first appears – does not provide a sufficient basis for the assumption of the Court of Appeal, which is factually far-fetched anyway, that the tongue device is equated with the tongue bed in the generic term. Rather, the technical meaning of the patent claim is decisive, for the understanding of which in particular the description must also be taken into account.

20 Thereafter, the objective of the invention is to reduce the material costs for a tongue device manufactured from a solid block (para. 5). This objective is based on the realization that, in addition to qualitative advantages (avoidance of stresses and distortion during hardening), tongue devices manufactured from a monobloc of high-quality steel have the time and cost advantage over tongue devices assembled from individual parts that the tongue bed no longer has to be elaborately hardened (par. 3 f.). While retaining these advantages, costs are further reduced if – as envisaged in patent claim 1 – the entire tongue device is no longer formed from a solid block of high-quality steel, but instead the tongue device is composed of an upper and a lower part, with only the upper part with the tongue bed consisting of a solid block of high-quality steel (features 1b and 1c), while the lower part can be made of structural steel (feature 1d) and both parts are joined together (feature 1e). With regard to the lower part, it is

irrelevant in this respect whether this is likewise formed from a solid block of structural steel or is composed of individual parts of this material. In the description, the advantageousness of a tongue device consisting of a solid block compared to one formed of individual parts is discussed exclusively in connection with the manufacture of the tongue bed, which is particularly stressed in use, and which, if the solid block consists of high-quality steel, no longer needs to be hardened, but can be milled out of it to fit precisely (para. 2 ff.; cf. also the previously published German published application 40 11 523 [K3] referred to as state of the art in the description of the patent in suit). On the other hand, there is no indication in the description that the formation of the lower part of the tongue device from a solid block of structural steel is also intended to achieve a cost advantage or other advantage sought according to the invention over a lower part of the tongue device composed of several individual parts. This supports the assumption that feature 1b refers solely to the upper part of the tongue device according to feature 1c with the tongue bed.

21 This understanding is not precluded by the fact that in the embodiment example according to the invention shown in Figures 1 and 2, the lower part of the tongue device is formed from a solid block of structural steel, since an embodiment example regularly does not permit a restrictive interpretation of the patent claim generally characterizing the invention (Federal Court of Justice, judgment of September 7, 2004 – X ZR 255/01, BGHZ 160, 204, 210 – *Bodenseitige Vereinzelungsvorrichtung*).

22 The same applies with regard to patent claim 2, which protects a centerpiece and expressly provides for the overall object to be made of a solid block, whereas patent claim 1 in this respect refers only to the tongue bed forming the upper part of the tongue device. In this respect, it may also be that, as the defendant submitted at the hearing, the applicant for the patent in suit did not account for what conclusions result from the teaching according to the invention for the design of the lower part of the tongue device to be made of a different material than the upper part, and in this respect may have been subjectively attached to the idea of a (second) solid block, which is also apparent from the embodiment example, just as the requirement to be made of a solid block in patent claim 2 relates to the centerpiece and thus to the entire device.

The wording of the task may also speak in favor of this. However, the decisive factor for the interpretation of a patent is not the subjective idea of the applicant, but the objectified view of the skilled person at the time of priority, which, according to the above explanations, leads to the result mentioned (settled case law, e.g.: Federal Court of Justice, judgment of February 13, 2007 – X ZR 74/05, BGHZ 184, 49 marginal no. 18 – *Kettenradanordnung II*).

23 IV. Accordingly, the judgment of the Court of Appeal cannot stand and must be set aside. The Senate can decide the matter itself because additional findings are neither necessary nor to be expected and the matter is therefore ready for decision (Sec. 563(1), first sentence, Code of Civil Procedure).

24 1. According to the unobjectionable findings of the Court of Appeal and the Regional Court, the tongue device for a switch, which is attacked as infringing the patent, consists of an upper part and a lower part. The upper part is made of a solid block of high-strength steel, while the lower part is made of structural steel. The fact that the latter is composed of three individual parts welded together and thus does not consist of a solid block does not, according to the above interpretation of claim 1, prevent feature 1b from being realized. Finally, the upper and lower parts of the tongue device are also joined together by welding. The tongue device of the defendant, which is objected to as patent-infringing, thus realizes the teaching of patent claim 1 of the patent in suit literally.

25 2. The further statements of the Regional Court, which are free of legal errors, also show that the claims of the action are well-founded to the extent awarded at first instance, so that the judgment of the Regional Court must be restored on appeal on points of law.

26 V. The decision on costs is based on Sec. 91(1), 97(1) Code of Civil Procedure.

Meier-Beck

Grabsinki

Bacher

Hoffmann

Deichfuß

Previous instances:

Regional Court of Düsseldorf, judgment of April 30, 2013 – 4c O 6/13 –

Higher Regional Court of Düsseldorf, judgment of January 29, 2015 – I-2 U 28/13 –