

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2021-05-18
Docket Number / Aktenzeichen:	X ZR 23/19
Name of Decision / Name der Entscheidung:	Funkzellenzuteilung

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



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

X ZR 23/19

Pronounced on:  
18 May 2021  
Zöller  
Judicial Secretary as  
Clerk of the court  
registry

in the patent nullity proceedings

Funkzellenzuteilung/  
Radio cell allocation

Patent Act Sec. 110; Code of Civil Procedure Sec. 62, Sec. 516

a) In patent nullity proceedings, the defendant may only appeal against a judgment rendered unfavorably to him uniformly against all plaintiffs; an appeal declared only against individual plaintiffs is inadmissible (confirmation of Federal Court of Justice, judgment of 9 January 1957 - IV ZR 259/56, BGHZ 23, 73 = NJW 1957, 537, juris, marginal no. 17; Federal Court of Justice, judgment of 11 November 2011 - V ZR 45/11, NJW 2012, 1224, marginal no. 9).

b) In case of doubt, the declaration that an appeal validly filed against several necessary intervening parties is withdrawn against individual intervening parties and continued with regard to the others is to be interpreted as meaning that the appeal is to be continued against all intervening parties.

Federal Court of Justice, judgment of 18 May 2021 - X ZR 23/19 –

Federal Patent Court

ECLI:DE:BGH:2021:180521UXZR23.19.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 18 May 2021, attended by the presiding judge Dr. Bacher, the judge Dr. Deichfuß, the judges Dr. Kober-Dehm and Dr. Marx as well as the judge Dr. Rensen

ruled that:

On appeal by the first and second plaintiffs, the judgment of the Sixth Senate (Nullity Senate) of the Federal Patent Court of 25 September 2018, is amended, the appeal of the defendant being dismissed.

European patent 1 327 374 is declared null with effect for the Federal Republic of Germany.

The defendant shall bear the costs of the proceedings at first instance.

The costs of the appeal proceedings shall be allocated as follows: The third and fourth plaintiffs shall each bear one fifth of their out-of-court costs and one twentieth of the court costs and the defendant's out-of-court costs. The remaining costs shall be borne by the defendant.

By operation of law

Facts of the case:

1           The defendant is the proprietor of European patent 1 327 374 (patent in suit), granted with effect for the Federal Republic of Germany, which was filed on 9 October 2001, claiming the priorities of four British patent applications dated 9 October and 10 November 2000, and 19 and 20 June 2001, and concerns service priorities in a multicell network. The patent in suit comprises 24 claims. Claim 1 reads in the language of the proceeding:

A method of determining cell allocation for a user in a wireless network, the network having a plurality of cell types and users having at least one of a plurality of service types, including defining a priority table comprising, for each service type, a priority for each cell type.

2           The plaintiffs re 2 to 4 have attacked the patent in suit in its entirety, the plaintiff re 1 to the extent of claims 1 and 15. They have argued that the subject matter attacked is not patentable. Plaintiffs 2 and 3 have further argued that the invention is not disclosed in such a way that a skilled person can carry it out. The defendant defended the patent in suit as granted and with four auxiliary requests.

3           The Patent Court declared the patent in suit null insofar as its subject matter extended beyond the version defended by the third auxiliary request, and dismissed the further claim.

4           The first and second plaintiffs and the defendant continue to pursue their first-instance claims. The defendant also defends the patent in suit with an additional request preceding its first-instance auxiliary requests. The third and fourth plaintiffs also filed an appeal, but withdrew their appeal before the oral proceedings. The defendant then stated that it was withdrawing the appeal against the third and fourth plaintiffs and was continuing the appeal with regard to the first and second plaintiffs.

Grounds of the decision:

5 Both appeals are admissible. The appeal of the defendant is unfounded;  
that of the plaintiffs leads to the complete declaration of nullity of the patent in  
suit.

6 I. The Senate continues to be called upon to decide on the entire  
subject matter of the dispute which has reached the appellate instance. The  
withdrawal of the appeal declared by the defendant against the third and fourth  
plaintiffs is ineffective and therefore, contrary to the opinion of the first and  
second plaintiffs, does not result in the partial declaration of nullity of the patent  
in suit by the Patent Court becoming final.

7 1. The decision on the declaration of nullity of a patent is rendered  
by way of a judgment, which must be rendered uniformly against several  
plaintiffs.

8 Therefore, several plaintiffs in actions for nullity are necessary joint  
litigants pursuant to Sec. 62 Code of Civil Procedure, irrespective of whether  
they filed the action together or whether several action proceedings concerning  
the same patent have been joined for the purpose of simultaneous hearing and  
decision (Federal Court of Justice, judgment of 27 October 2015 - X ZR 11/13,  
GRUR 2016, 361 marginal no. 48 et seq. - Fugenband).

9 As a consequence, a nullity plaintiff remains a party to the proceedings  
in the appellate instance even if a judgment rendered to the disadvantage of the  
plaintiff's side has been challenged only by other parties to the dispute (Federal  
Court of Justice, judgment of 27 October, 2015 - X ZR 11/13, GRUR 2016, 361  
marginal no. 49 - Fugenband). The defendant may only appeal against a  
judgment rendered unfavorably to him uniformly against all necessary co-  
disputants; an appeal declared only against individual plaintiffs is inadmissible  
(Federal Court of Justice, judgment of 9 January 1957 - IV ZR 259/56, BGHZ  
23, 73 = NJW 1957, 537, juris, marginal no. 17; Federal Court of Justice,  
judgment of 11 November 2011 - V ZR 45/11, NJW 2012, 1224, marginal no.  
9).

10 2. Whether the defendant is prevented according to these principles

from declaring the withdrawal of an appeal validly filed against all necessary litigants only against individual plaintiffs (so MüKoZPO/Rimmelspacher, 6th ed. 2020, Sec. 516 no. 19) or whether such a declaration - with the consequence that the appeal as a whole becomes inadmissible - is possible does not require a final decision. In the case in dispute, the defendant's declaration cannot in any case be interpreted as a partial withdrawal of the appeal in this sense.

11           The withdrawal of a remedy does not have to be declared expressly, but it does have to be declared unambiguously. In terms of content, the appellant must clearly and unambiguously express that he no longer wishes to continue the proceedings and to terminate them without a decision by the Court of Appeal. In the event of doubt, the declaration is to be given the significance that entails the lesser procedural consequences (Federal Court of Justice, order of 21 November 2018 - XII ZB 243/18, MDR 2019, 439 marginal no. 8).

12           In the case in dispute, the defendant has indeed expressed that it wants to withdraw its appeal against the plaintiffs re 3 and 4. At the same time, however, it has indicated that it wishes to continue to attack the judgment of the Patent Court also to the extent that it was given to its disadvantage. In view of this, its statement cannot be regarded as unambiguous. Rather, it must be interpreted in such a way that the defendant can achieve its expressed legal protection objective. The latter is only possible if the defendant, contrary to the wording of its declaration, continues to pursue its appeal against all plaintiffs.

13           3.       In view of the foregoing, the application filed by the defendant for a writ of certiorari on the procedural issues raised at the hearing is unfounded.

14           As stated above, there are no negative procedural consequences for the defendant arising from the withdrawal declarations made by it. In view of this, a right to file a brief could at most serve the purpose of withdrawing the appeal after all, if necessary. Granting such a right does not appear appropriate in the given situation.

15           II.       The patent in suit concerns the allocation of radio cells to user terminals in a multi-cell network.

16           1.       The patent in suit deals with the addition or replacement of second

generation (2G) mobile networks by third generation (3G) networks expected on the priority date.

17 In this situation, cells of different mobile standards would be available more frequently side by side. The number of cells available at the same time will also increase due to the existence of different cell sizes within the individual standards, such as pico and micro cells at the level of buildings and streets and macro cells covering larger areas. For network operators, this presents the task of distributing the required traffic using the different network technologies and the cell types available within them to maximize the number of users served with services and provide a predefined coverage probability in the service area.

18 In the known systems, network operators would have to rely on cell selection or handover algorithms provided by the manufacturer. These might not lead to a satisfactory distribution in the new situation shown.

19 2. Against this background, the patent in suit concerns the technical problem of improving the selection of a destination cell in a wireless communication system with more than one communication standard.

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

21

1	A method of determining cell allocation for a user in a wireless network,	Verfahren zum Bestimmen der Zuweisung einer Zelle für einen Nutzer in einem drahtlosen Netzwerk;
1.1	the network having a plurality of cell types	das Netzwerk weist eine Vielzahl von Zellenarten auf;
1.2	and users having at least one of a plurality of service types,	den Nutzern steht zumindest eine aus einer Vielzahl von Dienstarten zur Verfügung;
1.3	including defining a priority table comprising, for each service type, a priority for each cell type.	das Verfahren umfasst das Definieren einer Prioritätstabelle, die für jede Dienstart eine Priorität für jede Zellenart enthält.

22           4.       These features require further consideration.

23           a)       Cell allocation within the meaning of feature 1 requires a network  
in which terminals can communicate with an access point via radio.

24           The patent in suit names mobile radio networks of the standards 2G  
(GSM, EDGE) and 3G (3GPP) as examples. However, its subject matter is not  
limited to these standards.

25           Such mobile networks have different cells covering different spatial  
areas. In order for a user to use the network, his terminal must be assigned to  
such a cell. Such assignment takes place both in the idle state and when a radio  
connection is established for the first time, as well as when switching between  
two radio cells (handover).

26           b)       Cell types within the meaning of characteristic 1.1 are categories  
which serve to classify cells on the basis of characteristic criteria.

27           Not only the communication standards available in the respective cell are  
considered as classification criteria, but also individual design features. Thus, in  
the embodiment example described in the description of the patent in suit, the  
networks are divided into a total of six traffic classes, which are defined by the  
available standards (GSM, EDGE, 3GPP) and the size of the cell (micro, macro)  
(paragraph 56 and Table I).

28           Contrary to the view of the defendant, it can neither be inferred from the  
wording of patent claim 1 nor from the description of the embodiments that the  
standard available in the cell must necessarily be used as a classification  
criterion. It is true that consideration of this criterion will make sense in many  
constellations. However, this does not result in a mandatory determination.  
Rather, it is left to the skilled person to decide on the basis of which  
characteristics he or she classifies the individual cell types.

29           c)       Service types within the meaning of feature 1.2 are categories  
which serve to classify services on the basis of characteristic criteria.

30           aa)      Services are connections whose technical parameters are  
adapted to specific purposes.

31           The introduction of the patent in suit names, as examples, voice and data transmission as possible applications and, as parameters relevant for compliance with the relevant quality of service (QOS) requirements, the available bit rate, the maximum delay and the permissible bit error rate (BET) (paras. 4, 7).

32           In line with this, a total of eight types of service are distinguished in the embodiment described in the patent in suit on the basis of four usage scenarios (conversational speech, streaming, interactive, background) and two different bit rates in each case (para. 56 and Table I).

33           Patent claim 1 leaves open which criteria are used in individual cases to classify the individual service types.

34           bb) Beyond these specifications, patent claim 1 does not necessarily specify which service type is to be decisive for the allocation in a specific situation.

35           The description of the patent in suit distinguishes between situations in which an active connection already exists or such a connection is to be established (connected mode) and situations in which the terminal device is merely in an idle mode. In the embodiment described in the description, the classification in the first situation is based on the service that is currently being used or is to be used (par. 56, Table I). In the second situation, a list of connections established in the past can be used to estimate which service type is likely to be requested next; alternatively, the classification can be based on the capabilities of the respective terminal device (par. 57). For the latter variant, the decisive factor for assignment is which of the three mobile communications standards (GSM, EDGE, 3GPP) the terminal supports (par. 57, Table II).

36           In this context, too, neither the wording of the patent claim nor the description mandatorily specifies any of the criteria used in the embodiment example. Therefore, even in the case of a classification based on the capabilities of the terminal equipment, additional or other classification criteria may be used, such as the ability of the terminal equipment to support certain types of service that a standard only optionally provides.

37 d) A priority table within the meaning of Feature 1.3 is a data structure that results in a ranking of the cell types used for each service type used for the allocation decision.

38 aa) Such a table makes it possible to assign, from several available cells, the one to which the highest priority is assigned for the relevant service type.

39 In the example described in the patent in suit, two different tables are used for terminals in connection mode and for terminals in idle mode, which are reproduced below.

Table I

Traffic class/m axbitrate [kbit/s]	Conversational speech 12.2	Conversational 384	Stream ing 32	Stream ing 384	Inter 32	Inter active 1024	Back ground 32	Back ground 1024
GSM micro	1	-	5	-	5	-	5	-
GSM macro	2	-	6	-	6	-	6	-
EDGE micro	3	1	1	1	1	3	1	3
EDGE macro	4	2	2	2	2	4	2	4
3GPP micro	5	3	3	3	3	1	3	1
3GPPmac ro	6	4	4	4	4	2	4	2

Table II

classmark	Only GSM capable UE	GSM, EDGE capable UE	GSM, EDGE, 3GPP capable UE
GSM micro	2	4	6
GSM macro	1	3	5
EDGE micro	-	2	4
EDGE macro	-	1	3
3GPP micro	-	-	2
3GPPmacro	-	-	1

40 In Table I, each of the six cell types listed in the first column is assigned a value between 1 and 6 for each of the eight service types listed in the first row, provided that the respective cell type supports the respective service type (par. 56). Among several available networks, the one with the highest value is selected (par. 57).

41 In Table II, the assignment is based on the standards supported by the terminal; here, too, a value is assigned only if the cell type is suitable for the combination in question.

42 bb) Contrary to the view of the defendant, the term "priority table" only results in requirements regarding the structure of the information contained therein, but not in requirements regarding the way in which this information is arranged or presented on a data carrier or in any other storage device.

43 It can be left open whether, according to common usage, only a structure consisting of rows and columns is referred to as a table. In any case, it follows from the function assigned to the priority table according to the patent in suit, as the Patent Court correctly assumed, that it is sufficient for feature 1.3 if a data structure is present from which a priority value can be obtained on the basis of the cell type and the service type without additional calculation steps being necessary. The way in which this is realized programmatically and the way in which the priority values are stored are not important.

44 cc) Patent claim 1 does not necessarily require that the table is used for the assignment decision. However, it is mandatory that such a table is defined, i.e. that the individual priority values are provided in such a way that they can be determined on the basis of cell and service type without requiring additional calculation steps.

45 dd) The requirement in feature 1.3 that each service type must be assigned a priority for each cell type is also fulfilled if it is specified for individual combinations that an assignment is not to be made.

46 As has already been shown above, both tables used in the embodiment example of the patent in suit contain individual fields in which no numerical value is entered. This is also a priority indication, namely to the effect that an assignment of the cell type concerned to the service concerned should be omitted even if no other cell type is available.

47 Patent claim 1 does not contain any further specifications regarding the conditions under which such a determination may be made. As the defendant rightly claims, Tables I and II of the patent in suit contain such a specification

only for combinations which cannot be realized because the cell type is not suitable for the service in question. However, this restriction is not reflected in claim 1. Nor can it be inferred from the function of the priority table, because the determination of the criteria according to which the prioritization is carried out is left to the discretion of the skilled person according to the patent claim.

48           5.     Patent claims 15 and 24 protect a wireless communication network and a network element with corresponding features, respectively. These claims are not subject to a different evaluation than patent claim 1.

49           6.     Patent claim 13 protects a method having the features of claim 1, in which an allocation is made only to those cells whose measured signal strength exceeds a threshold value.

50           This subject matter is also not subject to a different assessment. As is also stated in the description of the patent in suit (para. 8), the determination of available cells on the basis of signal strength was known in the state of the art.

51           III.    The Patent Court substantiated its decision essentially as follows:

52           The subject matter of the patent claims, as granted, was in any event suggested by U.S. Patent Specification 6,094,581 (NK1). NK1 shows a method for a cell allocation in a wireless communication network. This network could have different cell types, for example, macrocells, microcells, and picocells. It further described several wireless technologies that the terminal could support. This corresponds to the service types provided by the patent in suit in Table II. For each of these service types, a sequence of the individual network types was defined. This was a priority table within the meaning of the patent in suit.

53           The version according to auxiliary request 1 was also suggested by NK1. While NK1 does not show 3G technologies, it is not limited to a single technology. The consideration of GSM-capable and GPRS-capable user devices already represents a distinction between two different mobile radio technologies, as is also the case in the patent in suit with the distinction between GSM and EDGE. Especially the distinction between technologies for voice transmission (GSM) and data transmission (GRPS) suggests to continue or extend the priority tables for new technologies known from NK1.

54           The additional features provided for under auxiliary request 2 were disclosed in NK1.

55           The subject matter defended by auxiliary request 3 did not contain an inadmissible extension, but a permissible specification. Moreover, it was based on an inventive step.

56           NK1 did show a use of priority tables in the connection state. However, it lacked a priority table defining a priority for each cell type for each connection type supported by the network. To implement this feature, it was not sufficient for the terminal to be able to select the preferred cell for different connection types, as disclosed in NK1.

57           The European patent application 941 006 (NK6a) also did not prevent patentability. NK6a deals with cell selection in a cellular mobile network comprising different cell types and in which different second and third generation service types are available. The assignment of a cell is based on information about the service type. Since there are predefined rules as to which of the available cells are to be preferred for the respective service, the skilled person reads that a priority table for the connection status is also described. However, there was no prioritization for cell selection in the idle state. NK6a also did not suggest that this constellation should be treated separately.

58           Also a synopsis of submitted citations did not suggest the subject matter defended by auxiliary request 3. None of these publications contained the suggestion to use the priority table disclosed in NK1 for the idle state and the priority table disclosed in NK6a for the connection state. International application 00/27158 (NK8) also contained no reference to a different approach for these two states. The mention of both modes was not sufficient for this purpose.

59           IV.    This assessment withstands the attacks of the defendant, but not the attacks of the plaintiffs.

60           1.    The Patent Court has correctly judged the subject matter of the granted version of claim 1 as not patentable. This subject matter is completely anticipated by NK1.

61           a)     NK1, which is designated as state of the art in the patent in suit (para. 9), deals with the selection of radio cells for a terminal in a cellular communication system when several cells with different service areas are present.

62           NK1 states that in cellular networks with advanced technology, there is an increasing need to differentiate between different types of users. New services, such as packet-switched data transmission (GRPS in GSM, packet data service in PDC) and half-rate voice coders (in GSM), as well as additional frequency bands (e.g., DCS 1800 and the E-band in GSM), are usually introduced inhomogeneously, so that not every cell provides every service (Column 1 lines 10-28). In addition, the terminals would have different capabilities. Therefore, it is necessary to consider both the capabilities and characteristics of the terminal and the functionality of the cell when assigning a cell (Column 1 lines 29-36). With this in mind, NK1 proposes a selection process that takes both aspects into account.

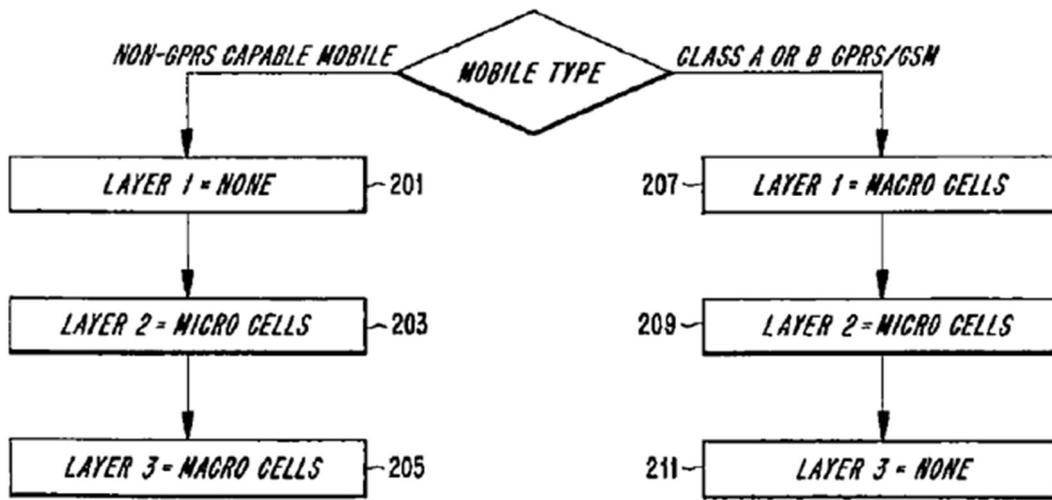
63           To achieve this goal, each cell is assigned a priority level called layer depending on its category for different types of terminals. The size of the cell (macro, micro, pico) is used as an example for categorization. The assignment is made to the available cell with the highest priority level. The availability of the cells is judged by signal strength and signal quality, among other factors (Column 4 lines 29-41).

64           The assignment to a priority level can be made independently of which cell currently supplies a mobile unit in question (Column 4 lines 42-67). Alternatively, a relative assignment may be made depending on which cell is currently supplying the mobile unit (Column 5 lines 1-29). Fixed assignments are described as examples of execution; however, these are described as not essential (Column 6 lines 5-12).

65           Different scenarios in GSM networks are considered. In addition, it is pointed out that the invention can be applied to any mobile radio standard. The standards GSM, GPRS, AMPS, D-AMPS, NMT, PDC and IS-661 are explicitly mentioned (Column 6 lines 49-51).

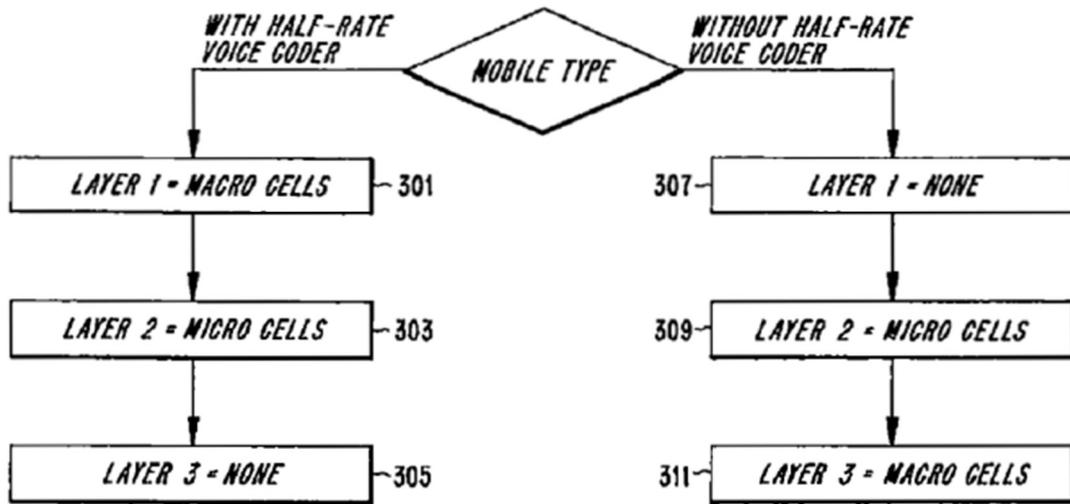
66 In one of the embodiments, it is exemplarily assumed that GPRS is only available in macrocells, but not in microcells. As a consequence, GPRS-capable terminals are preferentially assigned to a macrocell in the idle state (Column 6 lines 59 to Column 7 lines 10). The resulting priority levels are shown in figure 2a below.

*FIG. 2a*



67 In another embodiment, it is assumed that the possibility of using a half-rate speech encoder is only available in macrocells. As a consequence, terminals containing such an encoder are preferably assigned to a macrocell (Column 7 line 46 to Column 8 line 21). The resulting priority levels are shown in Figure 3 below.

**FIG. 3**



68 In other embodiment examples, comparable assignments are made depending on whether the terminal device supports a certain test function that is only available in macro cells (Column 8 lines 22-53) or whether the terminal device is authorized to use certain pico cells (Column 8 line 54 to Column 10 line 22).

69 In the latter example, once a terminal device is powered on, it is first assigned to a cell using an algorithm known from the state of the art. This is often a macrocell, even if a picocell with special functions is available (Column 10 line 23-38). When a dedicated connection is established for voice, data, short messages, subscriber services, or the like, it can be redirected to a more appropriate cell. For this purpose, a picocell is assigned a higher priority than a macrocell for terminals authorized to use the services available in it; for other terminals, the priority order is just reversed. The same can happen in the case of a handover (Column 10 line 55-67).

70 b) Features 1 and 1.1 are thus disclosed.

71 Contrary to the Respondent's view, NK1 distinguishes between different cell types within the meaning of feature 1.1.

72 As already explained above, feature 1.1 does not contain any mandatory specifications regarding the criteria according to which the individual cell types are classified. Therefore, the distinction according to cell size is sufficient to

disclose this feature.

73 c) Feature 1.2 is also disclosed.

74 Contrary to the view of the defendant, not only mobile radio technologies such as GSM, EDGE or 3GPP are to be regarded as service types within the meaning of this feature. Rather, as explained above, the decisive factor is whether the classification is made on the basis of criteria that are relevant for specific purposes of use.

75 Such different purposes of use are used as a classification criterion in NK1 by distinguishing on the basis of GPRS capabilities, the presence of a half-rate encoder and the approval for certain location-based services.

76 d) The Patent Court was also correct in considering feature 1.3 as disclosed.

77 As already explained above, a fixed assignment of priority values for each combination of cell and service type in question is sufficient for the realization of this feature. Such an assignment is also made in the procedure illustrated in Figures 2a and 3. The representation in these figures is already reminiscent of a table with rows and columns in terms of its external form. The fact that the rows are not divided on the basis of the cell type but on the basis of the priority value is harmless because feature 1.3 does not contain any specifications in this respect. Regardless of these questions of presentation, feature 1.3 is already realized because a priority level is also defined in this way for each combination of cell type and service type.

78 It is also harmless that no priority level is assigned to individual combinations, although this would be technically possible. As already explained above, Feature 1.3 does not specify in more detail the conditions under which the assignment of a certain cell type for a certain service may be prevented.

79 e) Against this background, the considerations made by the defendant regarding the question of which possibilities for further development were suggested for the parallel use of several mobile radio standards starting from NK1 are not relevant to the decision.

80           2.       The subject matter defended with auxiliary request 0 is suggested  
by NK1. Therefore, it can remain undecided whether this motion, filed for the  
first time in the appellate instance, is admissible.

81           a)       According to auxiliary request 0, the granted version of patent  
claim 1 is to be supplemented by the following features:

82

1.1.1	wherein the plurality of cell types comprises cells for different communication standards with different size,	die Vielzahl von Zellenarten umfasst Zellen für unterschiedliche Kommunikationsstandards mit unterschiedlicher Größe,
1.1.2	wherein the plurality of cell types comprises, for each communication standard, cells of different size, and	und zwar mit Zellen unterschiedlicher Größen für jeden einzelnen Kommunikationsstandard;

83           b)       This design is obvious on the basis of NK1.

84           aa)       However, as the defendant rightly asserts in its approach, the  
additional features in NK1 are not directly and unambiguously disclosed.

85           As already explained above, the cell types in all embodiments are  
classified only on the basis of the size of the cell. In contrast, a classification  
which additionally takes into account the communication standards available in  
the respective cell is not disclosed.

86           bb)       However, such a classification was suggested on the basis of NK1.

87           (1)       Contrary to the view of the defendant, the teaching disclosed in  
NK1 is not necessarily limited to a two-stage selection procedure that only  
allows selection between cells of different sizes depending on the mobile  
communications standard supported by the terminal.

88           It is true that the embodiments disclosed in NK1 only link to the size of a  
cell. However, this is based on the premise that the size allows conclusions to  
be drawn about the functionalities available in the cell due to the particular  
design of the network. Consequently, the allocation disclosed in NK1 is also

based on the functionalities of the respective cell type.

89           The statements in NK1 point in the same direction, according to which the invention disclosed there aims at enabling an assignment to different cell types with different functionalities (Column 2 lines 36-39). From this, too, it becomes clear that the cell size used as a classification criterion in the embodiment examples is indeed the means by which this goal can be achieved under the stated conditions, but that in substance it is not necessarily the size of a cell that matters, but rather the functionality available therein.

90           (2)    From all this, there is reason to use the availability of these functions as a classification criterion instead of or in addition to cell size, if there is no clear connection between size and functionality.

91           A consistent continuation of this approach does not lead to a decision tree as shown by the defendant in Annex NB7, but to a differentiation of a larger number of cell types based on the functionalities available therein and thus to a content structure as shown in Table II of the patent in suit.

92           (3)    As already explained in connection with the main request, NK1 contains the indication that the approach disclosed there can also be used for any other mobile radio standard and that the functionalities available in a cell represent a decisive classification criterion.

93           On this basis, it was obvious to use the support of these standards or other characteristic functional features as a classification criterion in addition to or instead of size when cells with different communications standards are available. This also suggested designs in which at least two different sizes are provided for each communication standard.

94           3.    The Patent Court correctly decided that the subject matter defended by auxiliary request 1 is not based on inventive step.

95           a)    According to auxiliary request 1, the granted version of patent claim 1 is to be amended as follows:

96

1.2	and users having at least one of a plurality of <u>service types mobile network technologies comprising 2G and 3G</u> ,	den Nutzern steht zumindest eine aus einer Vielzahl von <u>Dienstarten Mobilfunktechnologien einschließlich 2G und 3G</u> zur Verfügung;
1.3	including defining a priority table comprising, for each <u>service type of the plurality of mobile network technologies</u> , a priority for each cell type,	das Verfahren umfasst das Definieren einer <u>Prioritätstabelle</u> , die für jede <u>Dienstart Mobilfunktechnologie</u> eine <u>Priorität</u> für jede Zellenart enthält;
1.3.1	<u>wherein the priority table is defined by the network operator</u> ,	die <u>Prioritätstabelle</u> wird durch den <u>Netzbetreiber</u> definiert;
1.4	<u>wherein each mobile network technology in the priority table corresponds to at least one mobile network technology supported by a user equipment (40)</u> ,	<u>jede Mobilfunktechnologie in der Prioritätstabelle steht in Beziehung zu mindestens einer durch ein Nutzergerät (40) unterstützten Mobilfunktechnologie</u> ;
1.5	<u>wherein the priority table is used to determine cell allocation for a user equipment (40) which is idle, wherein in idle mode the connection type which the user equipment will next request is not known</u> .	die <u>Prioritätstabelle</u> wird verwendet, um eine <u>Zellenzuweisung</u> für ein <u>Nutzergerät (40)</u> zu bestimmen, das in einem <u>Ruhezustand</u> ist, in dem nicht bekannt ist, welchen <u>Verbindungstyp</u> das <u>Nutzergerät</u> als <u>nächstes anfordern</u> wird.

97           b)       Contrary to the plaintiff's view, this subject matter does not go beyond the content of the documents originally filed.

98           aa)       The replacement of the term "service types" by "mobile radio technologies including 2G and 3G" in feature 1.2 constitutes, as the Patent Court correctly pointed out in connection with auxiliary request 3, a permissible restriction compared to the application and the granted version.

99           As shown above, the embodiment example for terminals in the idle state described in the patent specification in dispute provides for a classification of the service types on the basis of the mobile radio technology supported by the terminal. The specification of this classification criterion leads to a limitation, because according to the application and the granted version it is left to the

skilled person which criteria he uses to classify the different types of service.

100           bb)    Contrary to the plaintiffs' view, the modified feature 1.3 is not to be understood as meaning that each mobile technology may only be assigned one cell that supports this technology.

101           Just like the granted version, the modified version of feature 1.3 is also linked to the embodiment example described in the patent specification in dispute, limited to a classification as shown schematically in Table II. It can be seen from this table that a terminal that supports several mobile radio technologies can be assigned to all cells that support at least one of these technologies.

102           c)     The possibility provided in Feature 1.3.1 for the network operator to define the priority table enables flexible operation of the network, adapted to the particularities of each case.

103           However, the advantage highlighted by the defendant at the hearing, that it is possible to change the prioritization without changing the allocation algorithm used by the base stations, already results from the granted version of feature 1.3. It is based on the fact that the allocation is based on predefined values that can be accessed based on the cell type and the service type without the need for additional calculation steps.

104           Feature 1.3.1 concretizes this requirement to the extent that the network operator must be able to predefine the priority values and change the defaults if necessary. In contrast, feature 1.3.1 does not contain any further specifications regarding the manner in which this must be possible. Nor is it possible to infer any specifications in this respect from the description.

105           d) The subject matter defended by auxiliary request 1 is also not based on an inventive step on the basis of NK1.

106           aa)    However, the amended and added features are not fully disclosed in NK1.

107           (1)    The Patent Court rightly considered the modified feature 1.2 as disclosed.

108 For the realization of this feature, it is sufficient that at least one of the mobile technologies mentioned therein is available to a user. This also includes the 2G technology with which NK1 is concerned.

109 (2) As the plaintiffs also do not dispute, the modified feature 1.3 is not disclosed in NK1.

110 To implement this feature, the priority table would also have to contain entries for 3G technology. This standard is not disclosed in NK1.

111 (3) Feature 1.3.1 is disclosed, as the Patent Court rightly assumed, by the explanations according to which the definition of the priorities can optionally take place in the terrestrial components of the network (public land mobile network, PLMN) or by the terminal after information about the fixed priority values of the cells in question has been transmitted to it, for example on a control channel (Column 4 lines 62-67).

112 It can be inferred from these explanations that the priority values are fixed in advance, but that these fixed values can be adapted to the particularities of the respective network. Otherwise, it would not be necessary for the terminal to request the values on a control channel in each individual case.

113 The fact that such adjustments can be made by the network operator itself is not explicitly mentioned in NK1. However, the very fact that adjustments are possible implies that the network operator also has the option of initiating them if necessary. The manner in which this is done is irrelevant because feature 1.3.1 does not prescribe a specific manner of implementation.

114 (4) Feature 1.4 is disclosed in any case to the extent that NK1 makes the assignment dependent on which functionalities the terminal device has.

115 Whether there is a lack of complete disclosure of this feature because the transmission mode GPRS - unlike the mode EDGE listed in Table II of the patent in suit - is not to be regarded as an independent mobile radio technology in relation to the underlying standard GSM can be left open for the reasons explained below.

116 (5) Also disclosed in NK1 is the fact that the assignment takes place

in idle mode (GPRS idle mode), as provided by feature 1.5.

117           bb) As the Patent Court correctly assumed, the inclusion of further  
mobile radio technologies, such as 3G in particular, and the application of the  
method disclosed in NK1 in an environment in which networks of different  
mobile radio technologies are available is suggested starting from NK1.

118           As shown above, NK1 contains the explicit indication that the procedure  
disclosed therein can also be used with any other mobile radio standard. This  
gave reason to use it also in connection with new technologies.

119           cc) NK1 takes into account the constellation that individual networks  
already provide GPRS, which is a newer technology than the first version of  
GSM. This gave reason to apply the procedure disclosed in NK1 also in  
environments where further radio cells with additional functionalities are  
available - also such functionalities which had not yet been developed or  
standardized on the filing date of NK1.

120           Such further development was also supported in particular by the  
information contained in NK1, according to which new functionalities are often  
introduced only gradually for cost reasons, so that not all available cells provide  
all functionalities, at least during a transitional period. Such a transitional period  
was a fortiori to be expected when a new generation of mobile communications  
was introduced.

121           4. The Patent Court also rightly decided that the subject matter  
defended by auxiliary request 2 is not patentable.

122           a) According to auxiliary request 2, patent claim 1 in the version of  
auxiliary request 1 is to be supplemented as follows:

123

1.3.2	wherein a priority table is defined for each cell in the network,	eine Prioritätstabelle ist für jede Zelle in dem Netzwerk definiert;
1.3.3	wherein the priority tables are specific or unique to a cell,	die Prioritätstabellen sind für jede Zelle spezifisch oder einzigartig.

124           b)     The Patent Court rightly considered the terms "specific" and "unique" used in feature 1.3.3 not as alternatives but as synonyms.

125           The additional features refer to statements in the description of the patent in suit which indicate a priority table for each base station as preferable (para. 47), but alternatively also provide for specific priority tables for groups of cells or for individual terminals or SIM cards and the like (para. 68). Feature 1.3.2 limits the subject matter of the patent in suit to the first mentioned embodiment.

126           A priority table, which specifically for one cell compares all available services to all available cell types, defines the description of the patent in suit as "unique" (para. 48). Following this definition, it is stated in connection with possible alternatives that in all described embodiments the priority tables are "specific, or unique, to a cell" (para. 68). Feature 1.3.3 is to be understood in the same sense in the light of these explanations, even if the two commas before and after the words "or unique" are not provided therein.

127           c)     As a result, the Patent Court correctly assumed that the two additional features in NK1 are also disclosed.

128           However, it cannot be readily inferred from the statements cited by the Patent Court regarding a fixed assignment (Column 4 lines 42-67) that the priority levels of the individual cell and service types are defined individually in each cell.

129           As already explained above, however, NK1 contains the explicit indication that the allocation can also be made depending on which cell the terminal is currently serving (Column 5 lines 1-7). As the plaintiffs rightly point out, it is sufficiently clear from this that the priority levels of the individual cell

and service types also depend on the individual cell.

130 Contrary to the Defendants' view, this also applies to an embodiment in which a separate definition is made for each cell. In the embodiment example for a relative assignment described in NK1, the definition of the priority levels depends not only on the type of the currently assigned cell, but also on its defined relationships to neighboring cells (preferred neighbor, non-preferred neighbor) (Column 5 lines 8-29). From this it can be inferred that the definition is made on the basis of the individual circumstances of the respective cell and thus separately for each cell.

131 5. Contrary to the opinion of the Patent Court, the patent in suit does not have any validity in the version defended by auxiliary request 3.

132 a) According to auxiliary request 3, patent claim 1 shall be amended in the version of auxiliary request 1 as follows:

133

1.3	including defining a <u>second type of priority table</u> comprising, for each of the plurality of mobile network technologies, a priority for each cell type,	das Verfahren umfasst das Definieren einer Prioritätstabelle <u>eines zweiten Typs</u> , die für jede Mobilfunktechnologie eine Priorität für jede Zellenart enthält;
1.3.1	wherein the <u>second type of priority table</u> is defined by the network operator,	die Prioritätstabelle <u>des zweiten Typs</u> wird durch den Netzbetreiber definiert;

1.4	wherein each mobile network technology in the <u>second type of priority table</u> corresponds to at least one mobile network technology supported by a user equipment (40),	jede Mobilfunktechnologie in der <u>Prioritätstabelle des zweiten Typs</u> steht in Beziehung zu mindestens einer durch ein Nutzergerät (40) unterstützten Mobilfunktechnologie;
1.5	wherein the <u>second type of priority table</u> is used to determine cell allocation for a user equipment (40) which is idle, wherein in idle mode the connection type which the user equipment will next request is not known.	die <u>Prioritätstabelle des zweiten Typs</u> wird verwendet, um eine Zellenzuweisung für ein Nutzergerät (40) zu bestimmen, das in einem Ruhezustand ist, in dem nicht bekannt ist, welchen Verbindungstyp das Nutzergerät als nächstes anfordern wird;
1.6	including defining a <u>first type of priority table</u> comprising, for each of a plurality of traffic types, a priority for each cell type,	das Verfahren umfasst ferner das <u>Definieren einer Prioritätstabelle ersten Typs</u> , die für jede Verbindungsart eine <u>Priorität für jede Zellenart</u> enthält;
1.6.1	wherein each traffic type in the <u>first type of priority table</u> corresponds to the plurality of traffic types supported by the network,	jede Verbindungsart in der <u>Prioritätstabelle ersten Typs</u> steht in Beziehung zu der vom Netzwerk unterstützten <u>Vielzahl von Verbindungsarten</u> ;
1.6.2	wherein the <u>first type of priority table</u> is defined by the network operator,	die <u>Prioritätstabelle ersten Typs</u> wird ebenfalls durch den <u>Netzbetreiber</u> definiert;
1.7	wherein the <u>first type of priority table</u> is used to determine cell allocation for a user equipment (40) connected in the network.	die <u>Prioritätstabelle ersten Typs</u> wird verwendet, um eine <u>Zellenzuweisung für ein Nutzergerät (40)</u> zu bestimmen, das in dem Netzwerk verbunden ist.

134            b)        With these amendments and additional features, the subject matter of patent claim 1 is made more specific to the effect that two different types of priority tables must be defined, one of which is used in connection mode and the other in idle mode.

135           aa) This approach, which corresponds to the embodiment example described in the description of the patent in suit, takes into account the already mentioned circumstance that in the idle state it cannot be assessed with certainty which functionality the terminal device requires in the event of a connection being established.

136           Therefore, according to features 1.3 to 1.5 in the priority table of the second type provided for this purpose - as already according to auxiliary request 1 - the mobile radio technology supported by the device is used as a classification criterion. A mobile radio technology in this sense can be a standard such as 2G or 3G, but also a technology that is only optionally available within a standard, such as EDGE considered in the embodiment example.

137           bb) For devices in connection mode, on the other hand, the connection types supported by the network are used according to features 1.6 to 1.7 - also as in the embodiment example.

138           (1) Connection types in this sense are typically defined by quality parameters such as available bit rate, maximum delay and the permissible bit error rate.

139           This classification allows a more precise allocation because the allocation of a cell can be based on the connection type that the end device is currently using or requesting. For example, a terminal that supports 3GPP can also be assigned a cell that only supports EDGE if the transmission speed available there is sufficient for the service currently being requested (par. 56).

140           The criteria according to which the individual connection types are classified and how the priority values are determined in detail are not specified in patent claim 1, even in this version.

141           (2) It can be seen from the context of features 1.6 to 1.7 that the allocation provided for in feature 1.7 is not made on the basis of the connection types supported by the terminal device, but on the basis of the type of connections currently maintained or requested by the terminal device.

142           It is true that the wording of feature 1.7 only provides that the user

equipment is connected and leaves open which entry from the priority table of the first type is used for the allocation. However, from the distinction between the two types of priority table and the different categorization underlying these tables, it can be concluded that the difference between currently existing or requested connection types and technologies available on the terminal equipment must also be included in the allocation under features 1.5 and 1.7, respectively.

143           c)     The subject matter defended by auxiliary request 3 does not go beyond the content of the originally submitted documents.

144           aa)    That the amendments in characteristic 1.2 are admissible has already been shown in connection with auxiliary request 1.

145           bb)    Contrary to the opinion of the plaintiffs, the two solution approaches presented in Tables I and II can be combined.

146           The fact that in Table I the available technology is listed only in the table rows, whereas in Table II it is listed in the rows and the columns, does not establish an irreconcilable contradiction. Both approaches are concerned with aligning the allocation of the cell with the current or expected requirements of the user. The fact that Table I uses the current or requested service type for this purpose, while Table II uses the technologies available on the terminal device, does not constitute a contradiction. As already explained above, the latter criterion in Table II is a means of estimating which service type is expected to be available after a change from idle mode to connection mode. The description of the patent in suit (para. 61) and the application (N3 p. 14 lines 7-9) explicitly emphasize that the standards supported by the terminal device in the latter constellation are to be understood as service type within the meaning of the patent in suit.

147           Against this background, the terms "type of service" and "mobile technology" do not form a contradiction. The application and the description of the patent in suit rather use "type of service" as a generic term, for the filling of which, according to the application and according to the granted version, optionally mobile radio technologies according to the model of Table II,

connection types according to the model of Table I or other suitable criteria can be used. In comparison, the specification of mobile radio technologies for the idle state and connection types for the connection mode leads to a concretization which is covered by the content of the originally filed documents.

148           cc)    There is also no inadmissible extension because the terms "mobile technology" and "connection mode" are not used in the application.

149           According to the case law of the Senate, the subject matter of a granted property right does not necessarily go beyond the content of the application if it is described by terms which were not used as such in the application documents. This applies in particular if longer descriptions in the application documents are summarized or described by keywords. The decisive factor is that the elements treated as belonging to the invention in the application documents are clearly and completely assigned to these general terms or keywords in such a way that there are no omissions or additions (Federal Court of Justice, judgment of 21 April 2009 - X ZR 153/04, GRUR 2009, 933 marginal no. 18 - Druckmaschinen-Temperierungssystem II).

150           These requirements are met in the case in dispute.

151           It is sufficiently clear from the link to the idle state or the connection mode that the terms "mobile technology" and "connection mode" represent a concretization of the generic term "service mode" along the lines of Tables II and I, respectively.

152           d)    As the Patent Court also correctly pointed out, the subject matter defended by auxiliary request 3 is disclosed in such a way that a skilled person can carry out the invention.

153           e)    Contrary to the opinion of the Patent Court, the subject matter defended by auxiliary request 3 is not patentable.

154           aa)   However, this subject matter is not fully disclosed in NK1.

155           (1)   The embodiment example described in NK1, in which the GPRS functionality is used as a criterion, deals with the allocation of a radio cell to terminal devices in the idle state. This corresponds to a priority table of the

second type within the meaning of the patent in suit.

156           Although NK1 also addresses the connection state in this context, it does not disclose an allocation based on a priority table for this. Rather, it is stated that in conventional systems, a GPRS-capable terminal that is in a circuit-switched connection is assigned to a microcell. As long as it is connected to this microcell, it has no possibility to switch to a cell with GPRS functionality (Column 8 lines 11-20). To solve this problem, it is proposed to assign GPRS-capable terminals preferentially to a cell that supports this functionality, as shown in Figure 2a (Column 8 lines 21-31). This assignment is already done in the idle state. The change of an already connected terminal to another cell is not described.

157           (2)    In the embodiment example in which the assignment depends on whether the terminal device can encode speech at half the bit rate, a connection type in the sense of feature 1.6 is indeed used. However, in this example, too, the assignment depends only on whether the relevant connection type is available on the terminal, not on whether a connection of this type currently exists or is requested.

158           Accordingly, as the Patent Court rightly assumed, this example also does not give rise to an assignment within the meaning of feature 1.7.

159           (3)    For the embodiment example in which exclusive functions are offered in picocells for the employees of a certain company, NK1 does indeed also disclose the reassignment of a cell when a dedicated connection is established or in case of a handover during an already existing connection. However, this allocation is also not based on the currently existing or requested connection type, but on the membership of the terminal device in a specific user group (Column 10 lines 23-67).

160           bb)   The defended subject matter is also not preempted by NK6a.

161           (1)    NK6a addresses cell selection in a cellular mobile network with different cell types and connection types.

162           NK6a states that in the state of the art, it is known that mobile stations

select radio cells based on a predetermined algorithm. For this purpose, the network transmits the required information about neighboring cells on a special channel called a beacon. Based on this information, the mobile station can query which of the neighboring cells has the most favorable received signal level and determine the cell with which a connection should be established. If no cell is selected at the time of commissioning, all beacon channels are queried; the determination is then made on the basis of the same criteria (Par. 4).

163           When a new system, for example UMTS, is introduced into an existing infrastructure, for example GSM, there are cells which cannot serve all these standards. Under these conditions, the conventional selection algorithm could lead to a situation where a desired UMTS service could not be carried out because the mobile station was in a GSM cell, or where a UMTS-capable cell was used even though only a GSM service was desired. Similarly, if additional radio access devices are used in an existing system, these are intended for specific user groups (par. 7-9).

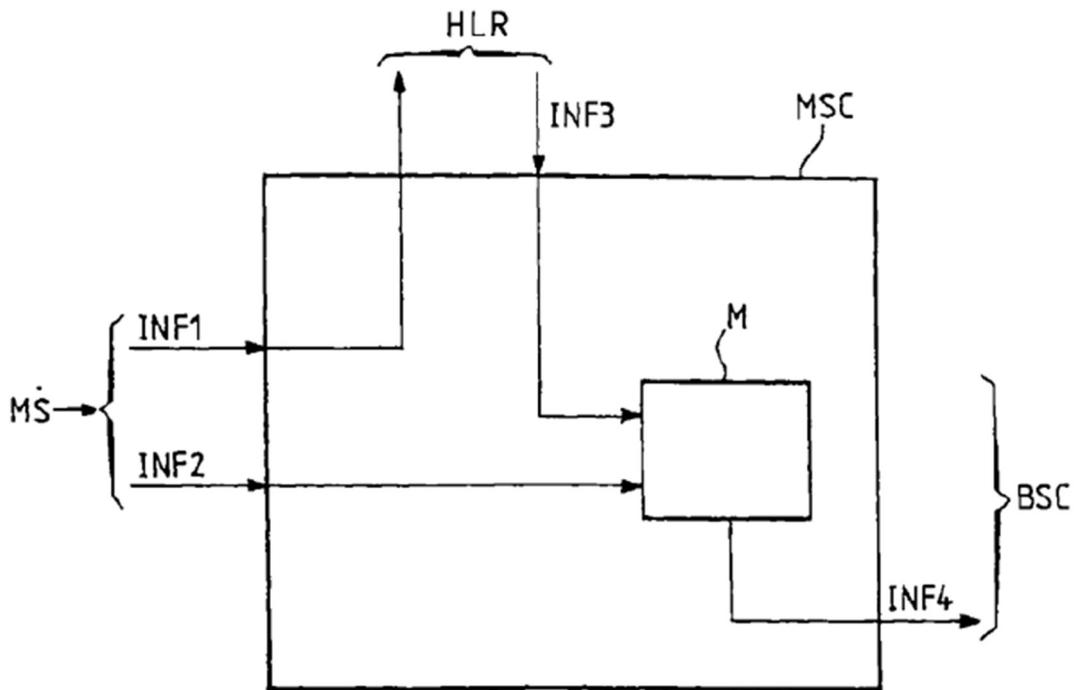
164           In cellular mobile networks, it was also known to perform cell reselection in the course of the connection in order to determine the most suitable cell. This is referred to as handover. The selection can be made by the network on the basis of measurement results transmitted by the mobile station. The first cell in which the resources for this connection are available is then selected from a candidate list drawn up on the basis of the measurement results (par. 13).

165           A handover could also be performed to pass a connection from the initially selected cell to a more suitable cell selected later. This is referred to as a "directed retry". Such a switch might be necessary, in particular, if the original and later cell selections were made according to different criteria (para. 14).

166           With this in mind, NK6a proposes a procedure in which the mobile station selects the cell with respect to network access. In a second step, the base station controller decides whether to hand over the connection to a cell of a different type that is more suitable for the service in question (para. 19).

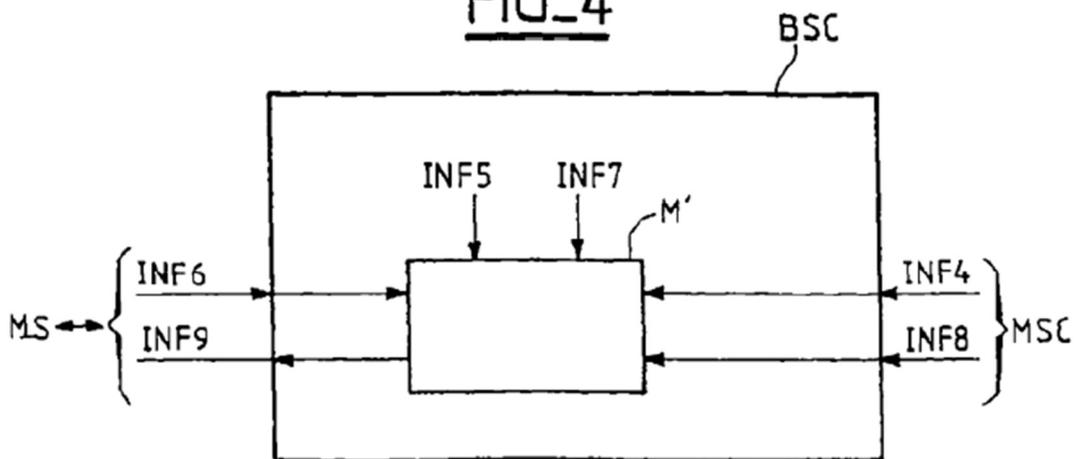
167           The processes leading up to a possible handover are shown in Figures 3 and 4 reproduced below.

FIG\_3



168 The mobile switching center (MSC) receives information from the mobile station (MS) on the identification of the user (INF1) and the desired type of service (INF2). It also queries the home location register (HLR) for information on the services that the user is authorized to use (INF3). On this basis, it determines information on the cell type that is most appropriate for the service, user and connection in question (INF4) (paras. 33-35).

FIG\_4



169 The base station controller (BSC) then decides whether a handover

should take place. In addition to the information transmitted by the MSC on the most suitable cell type (INF4), it takes into account the type of cell currently selected (INF5), the measurement results transmitted by the mobile station (INF6) and the availability of resources in the candidate cells (INF7 or INF8). If a handover is to take place, it transmits the information required for this (INF9) to the mobile station (MS) (par. 37 f.).

170           (2)    Thus, features 1 to 1.2 as well as a cell selection based on cell and connection type in the sense of features 1.6 to 1.7 are disclosed.

171           Contrary to the view of the defendant, features 1.6 to 1.7 are not lacking disclosure because in the method disclosed in NK6a the cells to be considered as candidates are determined by measuring the signal strength. Such pre-selection is not precluded by features 1.6 to 1.7. These concern the selection among several available cells, but not the determination of available cells. Patent claim 13 of the granted version and patent claim 9 in the version of auxiliary request 3 even expressly provide for a pre-selected measurement of the signal strength of cells under consideration.

172           (3)    Not disclosed is a cell selection in the idle state in the sense of features 1.3 to 1.5.

173           During the initial assignment, the cell is selected with the algorithm selected from the state of the art. Only measurement results flow into this, but not information on the desired service.

174           cc)    Contrary to the opinion of the Patent Court, the subject matter defended by auxiliary request 3 is suggested by NK6a starting from NK1.

175           (1)    From NK1, there was reason to search for possibilities to optimize cell allocation in connection mode.

176           NK1 discloses that a switched-on terminal must be assigned to a cell both in idle mode and in connection mode, i.e., when establishing a dedicated connection or redirecting an existing connection. As the Patent Court rightly assumed in its approach, the citation does indeed primarily deal with allocation and prioritization in idle mode, whereas for connection mode it refers to

procedures known in the state of the art. However, as already pointed out above, in the embodiment example, in which exclusive functions are offered in picocells for the employees of a certain company, an allocation deviating from the usual procedure is also made for active connections (Column 10 lines 25 f.). This gave reason to search for possibilities to further optimize the allocation also for currently existing or to be established connections.

177           (2)     In the search for such solutions NK6a offered itself as a source of knowledge, because there the allocation of a cell in the connection mode is in the center.

178           From a supplementary reference to NK6a, starting from NK1, the indication emerged that after the establishment of a connection, a renewed check can take place whether the cell used meets the requirements associated with the connection mode, and that this is advantageous in particular to relieve particularly powerful cells if the requirements associated with the selected connection can also be offered in other cells.

179           A combination of this approach with the approach disclosed in NK1 suggested itself already because both approaches are based on the same basic concept.

180           (3)     Contrary to the Respondent's view, the approaches taken in NK1 and in NK6a are not mutually exclusive.

181           It is true that the two citations focus on different operating states. However, both citations show that it is not enough to find a cell that is as suitable as possible in the idle state, but that there may be a need to correct the allocation when a new connection is established and during the existence of an already established connection and to use different allocation criteria for this purpose. Also this point of view gave reason not to deal with a selection between one of the two methods, but to combine both approaches in order to achieve the best possible result.

182           Contrary to the opinion of the Patent Court, this is not contradicted by the fact that in the embodiment example shown in NK1 (Column 10 lines 44-54) criteria are also used for the connection mode which are determined by the user

device or the user himself. Rather, a comparison with NK6a showed that cell and service types can also be linked to in the connection mode.

183           (4)    The fact that other aspects may be important for the selection of a  
suitable cell in the idle state, such as the circumstance addressed in NK8 that  
the energy requirement of the terminal device is typically lower in a macro cell  
than in smaller cells, does not lead to a different assessment.

184           This aspect did argue for not completely disregarding the criteria used in  
the state of the art. However, it was clear from NK1 that there is nevertheless  
scope for further optimization if the capabilities of the end device are also  
included in the consideration.

185           V.    The legal dispute is ripe for decision (Sec. 119(5) sentence 2  
Patent Act).

186           1.    As granted and in the versions of auxiliary requests 0 to 3, the  
patent in suit is not valid for the reasons stated above.

187           2.    The subject matter defended by auxiliary request 4 is also not  
based on inventive step.

188           a)    According to auxiliary request 4, patent claim 1 in the version of  
auxiliary request 3 is to be supplemented by the additional features 1.3.2 and  
1.3.3 from auxiliary request 2.

189           b)    These features are disclosed in NK1 for the reasons already  
explained in connection with auxiliary request 2.

190           VI.   The decision on costs is based on Sec. 121(2) Patent Act in  
conjunction with Sec. 91(1) and Sec. 97(1) Code of Civil Procedure as well as  
Sec. 110(8) Patent Act in conjunction with Sec. 516(3) sentence 1 and Sec.  
100(1) Code of Civil Procedure.

191           1.    Pursuant to Sec. 110(8) Patent Act in conjunction with Sec. 516(3)  
and Sec. 100(1) Code of Civil Procedure, the third and fourth plaintiffs shall bear  
their share of the court costs and the extrajudicial costs of the defendant at  
second instance because they have withdrawn their appeal. The fact that their

claim pursued with the withdrawn appeal was successful on the merits is irrelevant in this respect.

192 It is also irrelevant whether the defendant is prevented from asserting claims for costs against the plaintiffs 3 and 4 on the basis of an agreement with them. Such an agreement is unaffected by the decision on costs.

193 2. The remaining costs shall be borne by the defendant pursuant to Sec. 121(2) Patent Act in conjunction with Sec. 91(1) and Sec. 97(1) Code of Civil Procedure because it has been unsuccessful on the merits.

194 This also applies to the first instance costs of the third and fourth plaintiffs. Pursuant to Sec. 516(3) Code of Civil Procedure, the withdrawal of the appeal declared by the third and fourth plaintiffs only affects the costs incurred at second instance. With regard to the costs of the first instance, however, the decision to be taken is that which the Patent Court would have had to take if it had decided correctly on the merits.

195 If several plaintiffs are involved in the legal dispute as necessary co-parties, the first instance costs decision may also have to be corrected in favor of a plaintiff who did not appeal the first instance judgment (Federal Court of Justice, judgment of 27 October 2015 - X ZR 11/13, GRUR 2016, 361 marginal no. 49 - Fugenband). The same applies to a plaintiff who initially filed an appeal and later withdrew the appeal.

Bacher

Deichfuß

Kober-Dehm

Marx

Rensen

Previous instance:

Federal Patent Court, judgment of 25 September 2018 – 6 Ni 26/16 (EP) –