

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2018-01-30
Docket Number / Aktenzeichen:	X ZR 27/16
Name of Decision / Name der Entscheidung:	Wasserdichter Lederschuh



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 27/16

Pronounced on:
30 January 2018
Anderer
Judicial Secretary
as Clerk of the
Court Registry

in the patent nullity proceedings

Wasserdichter Lederschuh/
Waterproof leather shoe

EPC Art. 69; Patent Act Sec. 14

a) If, according to the protected process, a semi-finished product is to be processed in a certain way (here: a leather side is to be finished in a certain way), the purpose of the processing limits the subject matter of the process only to the extent that the processed semi-finished product must be suitable for further processing in accordance with the purpose.

b) If a material claim protects the finished product manufactured using the semi-finished product, it regularly covers only an object in which the semi-finished product has been further processed in accordance with the purpose.

Federal Court of Justice, judgment of 30 January 2018 – X ZR 27/16 – Federal Patent Court

ECLI:DE:BGH:2018:300118UXZR27.16.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 30 January 2018, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Bacher and Hoffmann and the judges Dr. Kober-Dehm and Dr. Marx

Ruled that:

On appeal by the defendant and dismissing the further appeal, the judgment of the 2nd Senate (Nullity Senate) of the Federal Patent Court of October 22, 2015 is amended and reworded as follows:

European patent 1 139 805 is declared partially null with effect for the territory of the Federal Republic of Germany in that the patent claims are replaced by the following:

1. Shoe characterized in that it comprises an upper of water-proofed leather (1) or a sole of waterproofed leather (1), wherein the leather (1) is waterproofed by a process, which comprises pressing on the internal surface of the leather (1) at least one semipermeable membrane (2) whose surface contacting the leather (1) is provided with a glue pattern, characterized in that said semi-permeable membrane (2) is elastic with a grade of elongation higher than 50 % and that the semi-permeable membrane (2) is not porous and carries out the water vapor passage by osmosis.
2. Shoe according to the preceding claim, characterized in that the glue pattern of the semi-permeable membrane (2) is thermoadhesive, and that the pressing of said membrane on the leather (1) is a hot-pressing.
3. Shoe according to any of the preceding claims, characterized in that said semipermeable membrane (2) is made of polyurethane.
4. Shoe according to any of the preceding claims, characterized in that said semipermeable membrane (2) has a thickness included between 5 μm and 100 μm .
5. Shoe according to any of the preceding claims, characterized in that said semipermeable membrane (2) is combined with a support sheet (3).
6. Shoe according to the preceding claim, characterized in that the support sheet (3) is made of fabric and is firmly fastened to the membrane (2).
7. Shoe according to any of the preceding claims, characterized in that the glue pattern is formed of a multiplicity of dots having a diameter included between 0,1 mm and 0,8 mm.

8. Shoe according to any of the preceding claims, characterized in that the glue pattern is formed of a multiplicity of dots having a density included between 50 dots/cm² and 200 dots/cm².
9. Shoe according to the preceding claims, characterized in that it comprises an upper of waterproofed leather that is made of two or more pieces sewed together.

The remainder of the action is dismissed.

The costs of the legal dispute are ordered to be borne 2/3 by the plaintiff and 1/3 by the defendant.

By operation of law

Facts of the case:

1 The defendant is the owner of European patent 1 139 805 (patent in suit), which was filed internationally on 20 October 1999, claiming the priority of an Italian patent application of 20 October 1998, and was granted with effect for the Federal Republic of Germany. The patent in suit comprises 13 claims according to the version obtained in the opposition proceedings; the subsidiary claims 1, 10, 12 and 13 are in the language of the proceedings:

- "1. Process for waterproofing leather (1), which comprises pressing on the internal surface of the leather (1) at least one semi-permeable membrane (2) whose surface contacting the leather (1) is provided with a glue pattern, characterized in that said semi-permeable membrane is elastic with a grade of elongation higher than 50 %.
- 10. Leather (1) waterproofed by a process according to one of the preceding claims, which comprises pressing on its internal surface at least one semi-permeable membrane (2) whose surface contacting the leather (1) is provided with a glue pattern, characterized in that said semi-permeable membrane is elastic with a grade of elongation higher than 50 %.
- 12. Shoe characterized in that it comprises an upper of waterproofed leather according to claim 10 or 11.
- 13. Shoe characterized in that it comprises a sole of waterproofed leather according to claim 10."

2 The plaintiff has argued that the patent in suit does not disclose the invention sufficiently clearly and completely for a skilled person to carry it out, and that its subject matter is not patentable. The defendant defended the patent in suit as amended and, in the alternative, in limited versions.

3 The Patent Court declared the patent in suit null. In its appeal, which the plaintiff opposes, the defendant continues to seek dismissal of the action; in the alternative, it defends the patent in suit in several limited versions. According to its auxiliary request I, patent claim 1, which is followed by eight further claims, is to be amended as follows:

"Shoe characterized in that it comprises an upper of waterproofed leather (1) or a sole of waterproofed leather (1), wherein the leather (1) is waterproofed by a process, which comprises

pressing on the internal surface of the leather (1) at least one semipermeable membrane (2) whose surface contacting the leather (1) is provided with a glue pattern, characterized in that said semi-permeable membrane (2) is elastic with a grade of elongation higher than 50 % and that the semi-permeable membrane (2) is not porous and carries out the water vapor passage by osmosis."

Grounds of the decision:

4 The admissible appeal is well-founded insofar as the defendant defends the patent in suit in the version of auxiliary request I, and leads to the dismissal of the action to this extent. The remainder of the appeal is unsuccessful.

5 I. The patent in suit relates to a process for waterproofing leather, in particular leather intended for the manufacture of shoes, and to the leather product obtained by the invention itself, in particular and according to the alternatively defended claims exclusively to a corresponding shoe. 1.

6 1. According to the description of the patent in suit, it was known to chemically impregnate the outside of leather for the manufacture of shoes, clothing or accessories by spraying thin layers of water-repellent substances; however, this procedure was of little efficiency in the long run. Sewing a fabric lining combined with a semi-permeable film into the inside of the leather, which on the one hand is intended to prevent further water penetration into the shoe or article of clothing, and on the other hand to allow transpiration to the outside, is disadvantageous because water can penetrate under the leather in any case. In the case of shoes in particular, undesirable water cushions formed between the fabric sealed against water and the inside of the leather. In addition, a lining would have to be applied in combination with a semi-permeable film, which would increase production costs and be impractical for articles such as summer shoes or clothing. The method of impregnating a leather tread disclosed in U.S. Patent Specification 5,598,644 (D19), in which a semipermeable membrane is adhered to the edge regions of the tread, does not prevent the formation of water cushions; moreover, the membrane must also be edged from above at the edge, which impairs the transpiration properties.

7 2. Against this background, the patent in suit concerns the problem of specifying a method for providing waterproof leather which avoids the disadvantages described. To this end, claim 1 proposes a process whose features can be structured as follows, following the judgment under appeal:

- a) The process serves to waterproof leather (process for waterproofing leather).
- b) At least one semi-permeable membrane is pressed onto the internal surface of the leather, which membrane is
 - b1) is provided with an adhesive pattern on its surface facing the leather and
 - b2) is elastic with a degree of elongation greater than 50%.

8 Patent claim 1 as amended by auxiliary claim I may be structured as follows:

- (1) The shoe comprises an upper of waterproofed leather or such a leather sole.
- (2) The leather part has been made waterproof by a process in which at least one semi-permeable membrane has been pressed onto its internal surface which
 - (a) is provided with an adhesive pattern on its surface facing the leather,
 - (b) is elastic with a degree of elongation greater than 50%,
 - (c) is non-porous, and
 - (d) allows the passage of water vapor by osmosis.

9 3. The English term waterproofing in German translation includes impregnation conceptually. According to general German technical usage, however, it is understood to mean allowing impregnating active substances dissolved or dispersed in a solvent to be absorbed into the material to be protected (textiles, wood, concrete) so that it exhibits the desired protection after evaporation or drying of the solvent or dispersion medium. The pressing on of a semi-permeable membrane provided for in feature 3 is therefore not to be understood as impregnation, but rather, as the Patent Court correctly pointed

out, as the application of a solid layer; neither of the parties opposes this in the second instance.

10 The adhesive, which is to bond the leather and the membrane, is to be applied to the membrane in a pattern. The adhesive is not to be applied to cover the entire surface, but in spots. On the one hand, this discontinuous structure is intended to ensure, in the interests of wearer comfort, that only part of the pores of the leather are blocked by the adhesive and that water vapor can escape to the outside (description in section 6). On the other hand, the adhesive pattern is to be designed in such a way that the membrane can be bonded directly to the leather and the use of the lining with membrane, which is known from the state of the art to be disadvantageous, and the penetration of water into the area between the leather and the lining (water cushion) can be avoided (par. 5). According to the invention, the leather becomes waterproof not by the fact that water cannot enter the leather, but by the fact that water cannot pass through the leather (over a large area). In this respect, patent claim 1 leaves it to the skilled person to select the size and density of the adhesive dots in such a way that the objectives stated in paragraphs 5 and 6 are achieved, in particular that no water cushions can form. More detailed indications of the ideas underlying the patent in suit concerning the size of the adhesive dots, the density of their distribution on the membrane and, correspondingly, the free leather surface available for water vapor diffusion are provided to the skilled person in paragraph 11 of the description and in subclaims 9 and 10. According to this, the diameter of the adhesive dots can be between 0.1 and 0.8 mm with a distribution density of 50 to 200 dots per square centimeter.

11 Patent claim 1 requires only a two-layer structure consisting of a leather layer and the semipermeable membrane. However, additional layers are not excluded. The description describes a support layer that can be provided on the side of the membrane facing away from the adhesive pattern. It may consist of paper and be removable after the membrane has been adhered to the leather, but it may also consist of a fabric and be firmly bonded to the semipermeable membrane (description para. 13, claims 6 and 7).

12 The requirement formulated in feature 4 that the membrane is elastic with a grade of elongation higher than 50% requires that the membrane material can

be stretched under tensile load by more than 50% relative to its original length without significant plastic, i.e. permanent, deformation occurring.

13 4. The feature of the internal surface of the leather requires special discussion.

14 a) The Patent Court held that it does not allow any statement as to which side of the leather is meant. Neither the manufacture of a garment nor the use of the membrane-coated side of the leather as the inner surface of such a garment was claimed. It was therefore irrelevant for the process to which leather surface the membrane was pressed onto the leather, and the claims in which a shoe was claimed were also not to be interpreted differently against this background.

15 b) This cannot be accepted without reservation.

16 The application of the semi-permeable membrane serves to prepare the leather for the manufacture of a shoe or an article of clothing. The process result is a semi-finished product consisting of the leather and the pressed-on semipermeable membrane. The membrane is to be applied to that side of the leather which is intended or can be intended to be worn on the body, as it is there to be repellent to water penetrating from the outside and permeable to moisture occurring in the shoe or on the inside of the garment. By referring to the inner surface, the patent claim expresses the distinction from the methods discussed in the description for impregnating the outer surface of the leather.

17 Since, as the Patent Court correctly pointed out, the manufacture of a shoe or garment is not claimed, and since nothing has been established or argued by the defendant to show that a leather side - before or at least after the application of the membrane - (always) has properties that make it reasonably appear usable only as an inner or outer side, the reference to the internal surface, however, initially contains only a statement of purpose. For the understanding of feature b of patent claim 1, it follows from this only that the leather provided with the membrane must be suitable for use in accordance with the purpose, i.e. with the surface thus processed on the inside of the shoe or article of clothing.

18 However, the situation is different in the case of the shoe claimed in auxiliary claim I. If a material claim protects the finished product manufactured using a semi-finished product, it regularly covers only an object in which the semi-finished product has been further processed in accordance with the purpose and accordingly achieves the effect intended to be achieved according to the invention. Since the shoe comprises the leather part processed (and used according to the purpose) according to the process of the invention, the internal surface in feature 2 is the internal surface of the leather upper or sole of the shoe. Not differently than it would be the case in a method for manufacturing a shoe, the technical teaching of the subject matter claim directed to a shoe is to provide a shoe in which the leather upper or the leather sole has been finished in such a way that the leather remains permeable to water vapor, whereas water can penetrate the leather but cannot pass through into the interior of the shoe because the membrane forms a barrier in this respect.

19 II. The Patent Court judged the subject matter of patent claim 1 to be affected by US patent specification 5 244 716 (D15) in a manner detrimental to novelty; the subject matter of auxiliary claim I had been suggested to the skilled person - a university engineer specializing in textile technology with several years of experience in the development of waterproof, breathable materials - by Japanese published application Sho 64-90300 (D1).

20 The citation D15 deals with the production of waterproof breathable garments and uses for this purpose a film made of a polymer that prevents the penetration of water but is permeable to water vapor. Two thin inner layers, one of which consists of the polymer film, are attached to a third outer layer, which - as explained for a glove - can also be made of leather. The polymer layer is semi-permeable and is attached to the leather by means of an adhesive, which is applied to the polymer layer in a net-like or dot-like manner, with the application of pressure. The polymer film also exhibits elasticity according to the invention, since D15 indicates that the film does not break up to an elongation of 200% and does not exhibit a yield point and consequently does not show a transition to plastic deformation (does not show a yield point).

21 The subject matter of claim 1 according to auxiliary request I is suggested by citation D1. With the exception of the feature of bonding by means of an

adhesive pattern, which corresponds to general technical knowledge, the document discloses all spatial and physical features of the subject matter of the invention. A waterproof leather is provided which is used for shoes. According to the D1, waterproofing is performed by laminating or directly coating with a non-porous, water vapor permeable polyurethane elastomer. From a solvent solution of the same, a 10 µm thick film is made on a peelable paper and an adhesive is applied to this film. The film together with the adhesive is then bonded to the leather in a lamination process under a 24-hour pressure load. The skilled person is advised to use a polymer that matches the hardness of the leather and, according to one example, is supposed to be stretchable by 100% at a tensile stress of at least 30 kg/cm². The fact that this is an elastic elongation is obvious to the skilled person due to the lack of usability of a plastically deforming material. It was irrelevant that it was not disclosed to press the film onto the inner surface of the leather.

22 III. The Patent Court rightly considered the subject matter of claim 1 as granted in the patent in suit to be unpatentable. It is suggested to the skilled person by the citation D1.

23 1. The paper relates to the provision of a waterproof leather usable for footwear, clothing and the like. It describes as insufficient methods in which water-repellent materials are used in the form of an emulsion or solution which is absorbed by the leather and fixed by drying. The aim is therefore to provide a coating that brings out the water vapor permeability inherent in leather, but forms a tough material that is not destroyed even in the long term and significantly improves water resistance without losing the feel and appearance of the leather. For this purpose, elastomers of polyurethanes are to be used to provide a material of suitable stability and elongation, which, using a solution, allows treatment of the leather by lamination or direct coating (roller application, brush coating, spraying). For this purpose, a polyurethane elastomer of polyethylene glycol and polyalkyl ether polyol reacted with polyisocyanate is proposed, for which a "modulus at 100% elongation 30 to 150 kg/cm², breaking strength 250 to 500 kg/cm², elongation at break 250 to 600%" are given. It is pointed out that leather is generally very tough and excellently flexible, and there are both relatively hard to soft types. Accordingly, a polymer should be selected

that has a modulus at 100% elongation matching the leather hardness from a range of at least 30 kg/cm².

24 In a film lamination process, a solution of an appropriate polyurethane is provided and a film of 10 µm thickness is prepared on release paper. As an adhesive for lamination, a solution mixture of 100 parts of this polyurethane and 5 parts of an additive of trimethylpropane and toluene diisocyanate is used and applied to the film. The whole is immediately layered on the leather material and is to rest under pressure for one day. This is said to achieve excellent resistance to water pressure with good water vapor permeability, while hardly affecting the feel of the leather.

25 2. It was obvious to the skilled person to carry out the described film lamination process and to modify it in one point so that it corresponded to features a to b2 of claim 1.

26 The film lamination process is described in D1 as particularly suitable because it has a significantly better resistance to water pressure than can be achieved with a roller application, brush coating or spraying or spraying on (see comparative table D1, p. 838). The film is used to waterproof a leather (feature a), pressed ("under pressure") onto a surface of the leather which, even if this is not the intention of D1, can be used as an internal surface of a leather shoe or garment (feature b). The Senate also shares the assessment of the skilled Patent Court that the film is a solid membrane within the meaning of the patent in suit. This is because the dissolved polyurethane is applied to a release paper, and an adhesive is separately applied to the film - only in this process. Since the adhesive consists essentially of the same polyurethane, this alone speaks against a liquid film. Moreover, such a film would penetrate the leather, and leaving it to rest under pressure for 24 hours would hardly make sense. The significantly higher resistance to water pressure compared to the other application methods also speaks against the assumption made by the appeal that a liquid film is applied to the leather.

27 The Senate is unable to make any clear statement on the elastic extensibility of the membrane from the D1. However, it was obvious to the skilled person that it should be designed in such a way that it is elastic with a degree

of elongation of more than 50% (feature b2). From the point of view of a skilled person, the modulus referred to at 100% elongation is to be understood as the modulus of elasticity; the defendant does not point to any other reasonable understanding. For the skilled person, it therefore follows that the material characteristic value for an elastic elongation of 100% is discussed, especially since considerably higher tensile stresses are specified for the breaking strength. In addition, it is expressly pointed out that the elasticity of the material is to be selected according to the leather. As the Patent Court correctly pointed out, this can meaningfully be referred only to elastic elongation, whereby the skilled person has reason to provide a certain reserve in elastic elongation as a precaution and to ensure that the residual deformation is not so great as to jeopardize the maintenance of the intimate bond between the leather and the membrane. The patent in suit does not indicate why it requires an elastic elongation of more than 50%. According to the above, this justifies the assumption that it is either a measure that the skilled person can recognize as necessary for a sufficiently elastic membrane or exceeds this necessary measure to an arbitrarily chosen extent and therefore does not require a specific suggestion.

28 Adhesive is applied to the surface of the semipermeable film facing the leather, as explained. In deviation from feature b1, however, D1 does not teach that the film is to be provided with an adhesive pattern. However, it was readily available to the skilled person to use such an adhesive pattern.

29 As the Patent Court stated without being challenged, the use of an adhesive pattern corresponds to the actions of a skilled person. The paper by Gottwald, Water Vapor Permeable PUR Membranes for Weatherproof Laminates, J. of Coated Fabrics 1996, 168 (D3) states that various adhesives are used to bond a textile to a water vapor permeable membrane. One option, it says, is to apply a continuous layer of a water vapor permeable adhesive; another is to apply a spot-applied non-permeable adhesive (p. 169 below). Since the D1 uses a water vapor permeable adhesive, he can apply it over the entire surface without compromising the water vapor permeability of the membrane. On the other hand, if the skilled person wanted to use a different

adhesive, he was required to apply it in spots to allow the water vapor permeability of the membrane to take effect.

30 The subject matter of claim 1 is therefore not based on inventive step.

31 IV. On the other hand, patent claim 1 in the version of auxiliary claim I is legally valid.

32 1. The claim version of auxiliary claim I is admissible; in particular, it does not contain an inadmissible extension of the invention disclosed by the origin.

33 The plaintiff wrongly sees such an inadmissible extension in the fact that the patent claim in this version allows that both the upper part and the sole of the shoe consist of leather finished according to the invention, whereas these measures were originally disclosed only alternatively. It is true that - contrary to the appellant's view - the claim version indeed includes both the finishing of either the upper or the sole as well as a corresponding finishing of both. However, the patent claim does not go beyond the content of the application, because it is obvious to the skilled person that he can make use of the equipment of a shoe upper or a sole provided for in claims 13 and 14 of the application (published as WO 00/22948) both alternatively and cumulatively.

34 2. The subject matter of patent claim 1 as amended by auxiliary claim I is also executably disclosed. The plaintiff therefore doubts this because the patent in suit does not indicate the standard according to which the elasticity of the membrane is to be measured. However, this is not a question of the practicability of the teaching according to the invention, but of its interpretation. In view of this, the question may arise whether the wording of the claim complies with the clarity requirement of Art. 84 sentence 2 EPC. However, it is not at issue in the dispute, since the wording according to auxiliary request I corresponds in this respect to claims 10, 12 and 13 of the granted patent (cf. Federal Court of Justice, judgment of 27 October 2015 X ZR 11/13, GRUR 2016, 361 = BIPMZ 2016, 272 - Fugenband).

35 3. The subject matter of claim 1 as amended by auxiliary claim I, the novelty of which is not at issue, was not obvious to a skilled person and is thus patentable.

36 a) The citation D1 does not suggest to the skilled person to apply the film lamination process proposed and preferred therein on a leather side facing the inside of the shoe. It takes known impregnation processes as a starting point and improves them with the aim of increasing the resistance to water pressure without impairing the visual and haptic leather effect. Measures aimed at accepting the penetration of water into the leather and applying the barrier on the inside are in direct contradiction to this. It is true, as the plaintiff claims, that the D1 process may not be very suitable for leather soles because of the abrasion to be expected. However, the D1 does not cover soles either.

37 b) There is also no obvious route from US patent specification 5 598 644 (D19) to the subject matter of the invention.

38 The citation concerns a waterproof and breathable shoe sole. It describes the problem that leather soles have advantages due to their water vapor permeability, but also have the disadvantage of absorbing water. In the state of the art, attempts have been made to overcome this disadvantage by inserting a polyurethane (PUR) or polyvinyl chloride (PVC) element between the leather sole and the foot support area, but this eliminates the breathability of the leather. In contrast, it is proposed to provide a leather outsole at least partially covered with a preferably microporous membrane of waterproof but water vapor permeable material such as Gore-Tex or the like and joined, at least along its perimeter, to at least one upper member of rubber, PUR, PVC or equivalent material having one or more through holes at least in the areas covered by the membrane. It is stated of the membrane that it forms a monolithic body with the outsole, since it is joined to the latter by suitable adhesives distributed, for example, along its periphery in the peripheral areas (column 2 lines 43-48).

39 Features 2a to 2d of patent claim 1 as amended by auxiliary claim I are thus not disclosed, nor does D19 convey any suggestion for a corresponding construction. This is because the membrane, at least in the peripheral region in which the adhesive is preferably to be applied, is in any case covered by the

upper part made of rubber, PUR, PVC or an equivalent material, which in the embodiment according to Figure 5 even leaves only individual openings for the passage of water vapor. The document therefore does not give the skilled person any reason to worry about the water vapor permeability of the membrane in the areas covered with adhesive, nor about an intimate bond between the membrane and the leather as a whole and the degree of elastic stretching of the membrane required for this.

40 Nor did the skilled person have any reason to consider a combination of the D19 with the D1. This is already contradicted by the fact that D19 only deals with the (inner) coating of a leather sole, while such a coating is in turn outside the scope of D1, which coats a leather upper from the outside.

41 c) The citation D15 also did not suggest the subject matter of the invention to the skilled person.

42 The printed matter relates to articles of clothing, such as in particular stockings and gloves, which comprise a (two-layer) barrier component with a film or membrane layer which is impermeable to water but permeable to water vapor and thus semi-permeable. The layered structure of the products shown in D15 is consistently three-layered: outer layer (in the case of socks made of wool, in the case of gloves also of leather), film 105 and inner layer. The writing is mainly concerned with stockings and here in particular with the problem that the film 105 must be so stretchable that the stocking fits tightly to the body when worn, but can nevertheless be pulled over the ankle and foot (column 1 lines 30-38 = D15 p. 2 lines 28 - p. 3 lines 2). It is true, the writing explains, that there are polymer membranes which can be stretched considerably before they rupture, but if the membrane layer and the inner layer are placed on top of each other unstretched and are to be used in this way, no satisfactory result can be achieved. Therefore, it is a continuous design and manufacturing principle of the citation to spread out the membrane layer unstretched and to stretch the inner layer (smaller in dimensions unstretched) until it is congruent with the larger membrane and to glue both layers in this state (column 10 lines 59-61 = D15 p. 21 lines 26-28). When the tension is removed from the inner layer, it then contracts to approximately its original unstretched size, while the film 105 shrinks more noticeably and wrinkles or takes on a wavy or curled surface, as

is described many times in D15 (cf. for example column 15 line 20 ff. = D15Ü p. 30 line 26 ff.).

43 The production of a glove is described according to two simplified procedures for the production of stockings (beginning column 20 line 68 = D15Ü p. 41 column 30). Thereby it should be achieved - similar in principle to stockings - that on the one hand the glove fits tightly to the hand and the fingers, that on the other hand nevertheless a fist can be easily clenched (column 4 lines 40 f. = D15Ü p. 8 lines 33 f.). For this purpose, 105 adhesive dots (patterns) can be printed on both sides of the semi-permeable film; the film is then first bonded to the third inner layer. In a process described in more detail (beginning column 22 line 1 = D15Ü p. 43 line 33), the side of the film facing the outer layer and provided with adhesive dots can be pressed onto the outer layer of the glove under pressure. The connection between the semi-permeable layer and the outer layer is intended to prevent the barrier component from being pulled out with the glove when it is removed (D15 column 22 lines 15-18 = D15Ü p. 44 line 1316).

44 Thus, in any case, features 1, 2 and 2b are not (fully) disclosed. Neither does the D15 describe a shoe, nor is the leather that can be used for the glove described made waterproof by a process in which a membrane that can be elastically stretched by more than 50% is pressed onto its inner surface. Since the membrane is to be bonded to the stretched inner layer and assume a wavy or crimped surface on the unstretched inner layer, there is no need to provide for elastic stretchability greater than 50%. The conclusion of such an elasticity cannot be drawn from the statement of D15 for an example of an embodiment that the film shows no yield strength and does not break up to an elongation of 200% (p. 18 lines 21-23). According to the uncontradicted statements in the expert opinion submitted by the defendant, Prof. Dr. Dr. h.c. B. R. (B12 para. 16), it is known to the expert that polyurethane films do not have to have a yield point, i.e. no defined transition between elastic and plastic deformation, before they tear. Nor can any firm conclusions be drawn from the reference (D15 column 24 lines 39-44) to US patent specification 3 709 864 (D16), especially since, as the appeal points out, the information on the intrinsic viscosities preferred in the context of D15 does not correspond to the corresponding

information in D16. Due to the crimped surface of the membrane and the rather loose connection between the outer layer and the inner layers by means of adhesive dots, it can furthermore and above all not be achieved that the membrane lies so tightly and firmly against a leather used as outer layer that water cushions are avoided and the leather is consequently made waterproof in the sense of the patent in suit.

45 The plaintiff does not show what could cause the skilled person to deviate from the D15 disclosure on these points. The document does not take shoes into consideration at all and even leather rather marginally. Its teaching is characterized by the composite of the inner layer and the crimped or corrugated membrane layer connected to it. A reason to deviate from this cannot be conveyed to the skilled person by the D15, and it is also not otherwise discernible.

46 d) The other claims are even further removed from the subject matter of claim 1 as amended by auxiliary claim I and therefore cannot suggest this subject matter of the patent in suit.

47 4. The subclaims are supported by the patentability of the subject matter of claim 1.

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

Meier-Beck

Bacher

Hoffmann

Kober-Dehm

Marx

Previous instance:

Federal Patent Court, judgment of 22 October 2015 – 2 Ni 32/13 (EP) –