

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-05-12
Docket Number / Aktenzeichen:	X ZR 43/13
Name of Decision / Name der Entscheidung:	Rotorelemente

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



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

**X ZR 43/13**

Pronounced on:  
12 May 2015  
Hartmann  
Judicial secretary as  
Clerk of the Court registry

In the matter

Rotorelemente/rotor elements

Patent Act Sec. 38, Sec. 14; EPC Art. 123(2), Art. 69(1)

- a) The examination of an inadmissible extension must be preceded by the determination of the meaning of the patent claim to be checked.
- b) In determining the meaning of a patent claim, even an unequivocal wording is not decisive, if the interpretation of the claim, using the description and further claims of the patent, shows that two of the terms in the claim have to be exchanged for each other.

Federal Court of Justice, judgment of 12 May 2015 - X ZR 43/13 - Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing of 12 May 2015 attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Bacher, Dr. Deichfuß and judge Dr. Kober-Dehm

ruled that:

On appeal by the defendant, the judgment of the First Senate (Nullity Senate) of the Federal Patent Court, delivered on 23 January 2013, is set aside.

The case is referred back to the Patent Court for a new hearing proceedings and decision, including on the costs of the appeal.

By operation of law

Facts of the case:

1           The Defendant is the owner of the European patent filed and granted on 20 March 2001, claiming a British priority of 15 April 2000, with effect in the Federal Republic of Germany.

2           Claim 1 reads:

"A machine for the manufacture of elements (8) from strip stock, the elements (8) in use being stacked to provide an assembly of stacked elements (8) for an electrical motor, each element (8) including body (10) and pole (12) portions which are integrally formed, the machine including a die assembly including a first die member (22) for providing by punching at least parts of the body portions (10) of each element and a second die member (32) for providing by punching, the pole portions (12) of each element (8), and **characterised in that** the body and pole die members (22, 32) are relatively moveable between successive punching operations when the body and pole portions (10, 12) of the elements (8) are provided, whereby incremental adjustment of the position of the second die member (32) relative to the first die member (22) is effected so that whilst each of the body portions (10) of the elements (8) is provided along a common centre line, the pole portion (12) of each of the successive elements (8) is incrementally offset relative to the pole portion (12) of each of the respective previous elements (8) with respect to the said common centre line of the body portion (10)."

3           The Plaintiffs claim that the subject-matter of the patent in suit is inadmissibly extended and not patentable. The defendant has defended the patent in suit as granted and, alternatively, with several amended sets of claims.

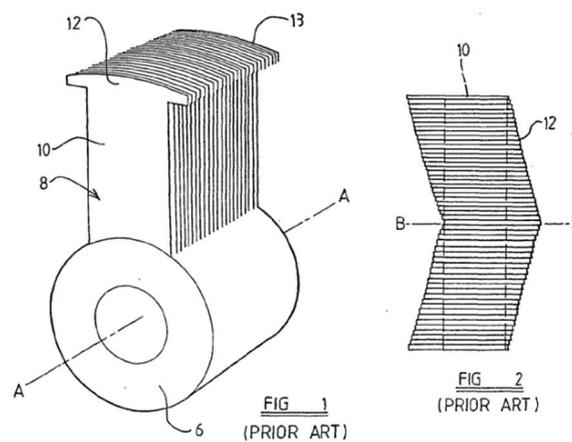
4           The Patent Court has declared the patent in suit null.

5           The defendant's appeal is directed against this decision. The Defendant continues to seek dismissal of the action

Grounds of the decision:

6 The admissible appeal leads to the annulment of the contested judgment and to refer the case back to the Patent Court for examination of the patentability of the subject-matter of the patent in dispute. The assumption by the Patent Court that the patent in suit is an 'aliud' to the application under protection, does not stand up to review on appeal.

7 I. The patent in suit relates to a device for the production of elements of strip-like material, wherein in use the elements are stacked on top of each other to form an array of stacked elements for an electrical machine. An electrical machine with distinct poles is, as the Patent Court has stated, known under the technical term "limb pole machine". For cage and three-phase windings it is common practice to bevel the slots for noise as well as harmonic wave damping. The single sheets are offset against each other, so that grooves and conductors run helically, if necessary also in sections with different helix directions, resulting in a shape known as an angle or arrow shape. In accordance to this the patent in suit states, that the pole sections are to be bevelled at an angle, while the basic bodies remain unchanged, as shown in Figure 2 of the patent in suit (reproduced below with Figure 1).



8 For this purpose, the state of the art requires either both parts to be manufactured separately and being connected afterwards, for example by welding, or a separate mould is to be punched for each sheet, which means a large number of different shapes of punching tools is required. The patent in suit is based on the task of making it easier to manufacture a rotor with the

desired angular profile. According to the invention, this is achieved by two punching tools, which are moved stepwise (incrementally) against each other and thus cause a successive displacement of the pole section to the base body.

- 9           The patent court has divided claim 1 into features as follows:
- 1.1    Device for manufacturing elements
  - 1.2    from strip material,
  - 1.3    whereby the elements are stacked on top of each other during use to form an arrangement of stacked elements to form for an electrical machine,
  - 1.4    whereby each element has a base body and pole sections that are integrally formed,
  2.     wherein the machine has a punching arrangement
  - 2.1.   which is equipped with a first punching element, for providing by punching out at least parts of the Basic body sections of each element,
  - 2.2    and a second punching element for providing by removal punching the pole sections of each element, and characterized by this,
  - 3.1    that the punching elements for base bodies and poles are movable relative to each other, between successive punching operations,
  - 3.2    when the basic body and pole sections of the elements can be formed,
  4.     whereby a gradual phasing out of the position of the second punching element relative to the first punching element is executed so that
  - 4.1    during each of the basic body sections of the element formed along a common center line,
  - 4.2    the pole section of each of the successive elements is offset step

by step relative to the pole section of -each of the corresponding preceding element in relation to the said common center line of the basic body section

10 II. The Patent Court saw this subject matter as an impermissible extension of the disclosure of origin, and essentially justified this as follows:

11 The claim is based on claim 11 of the application, whereby

- characteristics 1.2 to 1.4 were newly added,

- in characteristic 3.1, the second half-sentence was newly added,

- in characteristics 4 and 4.2 "gradually" had been added,

- the claim 11 on elements limited to rotor elements had been generalized,

- the assignment of the basic body sections and the pole sections to the punching elements according to characteristics 2.1 and 2.2 had been switched,

- according to these features at least parts of the basic body sections and the pole sections (as a whole) would be punched out whereas according to claim 11 of the application, it was vice versa,

- the center line of the associated base body section has become a common center line of the base body section.

12 While the first three deviations from Claim 11 of the application could be derived from the original documents and the fourth could be regarded as a permissible generalization, the further amendments are no longer acceptable. Contrary to the patentee's view, this was not an obvious error in the wording of the patent claim which could be corrected. Claim 1 is coherent in itself and does not show any contradictions. The contradictions in the description and drawings seen by the defendant could only be taken into account within the framework of the interpretation.

13 In this respect, the Patent Court stated that claim 1 leaves open, which

punching element is stationary and which is movable; only the relative movement is claimed. In features 4.1 and 4.2, the claim refers to a common center line as a reference line for movement. In the original documents, the center line was referred to the base body section. If, however, the center line were referred to the sheet metal strip or the punching machine, the first punching element and the basic body sections would be arranged in a static manner and, consequently, the second punching elements and the pole sections would be arranged in a movable manner, which would represent an aliud to the originally disclosed system depicted in the figures. Following the argument of the Plaintiffs, who see something different in the claimed common center line of the base body section than in the originally disclosed center line of the associated base body section, a system is to be regarded as claimed by the patent in suit in which the base body sections lie on a now common center line when punching out and the associated punching tool is consequently stationary. The fact that the description and the embodiment examples refer exclusively to a system with a stationary punching tool for the pole sections and a movable punching tool for the base body sections cannot turn the meaning of the patent claims into their opposite. An interpretation contrary to the wording (in the sense of an interpretation contrary to the meaning) of the patent claims was not permissible.

14           III.     This assessment is not free of legal errors. If the patent claim 1 is interpreted correctly, it does not contain the deviations from the disclosure of the application assumed by the Patent Court, and the same applies to process claim 7.

15           1.     The appeal rightly complains that the Patent Court failed to interpret claim 1 first by referring to the description and the drawings before addressing the question whether the subject-matter of the patent in suit, which emerges as the result of the interpretation, is disclosed in the original documents as the invention applied for or as belonging to it.

16           According to the established case law of the Federal Court of Justice, the interpretation of the patent claim is always required and may not be omitted even if the wording of the claim appears to be unambiguous(see among others BGH, judgment of 29 April 1986 - X ZR 28/85, BGHZ 98, 12, 18

- Formstein; 12 March 2002 - X ZR 168/00, BGHZ 150, 149, 153 - Schneidmesser I; decision of 17 April 2007 - X ZB 9/06, BGHZ 172, 108 - Information transmission procedure I; decision of 17 July 2012 - X ZR 117/11, BGHZ 194, 107, marginal 27 - polymer foam I). This is because the description of the patent can define terms independently and thus constitute a "patent's own lexicon" (BGH, judgment of 2 March 1999 - X ZR 85/96, GRUR 1999, 909 - Spanschraube). Also the principle that in case of contradictions between claim and description the claim has priority, because it is the claim and not the description that defines and thus also limits the protected subject matter (BGH, judgment of 10 May 2011 - X ZR 16/09, BGHZ 189, 330, para. 23 - Occlusion device), does not exclude the possibility that the description and the drawings may lead to an understanding of the patent claim that differs from that conveyed by the mere wording of the claim. The function of the description is to explain the protected invention. In case of doubt, therefore, an understanding of the description and the claim is required which does not bring the two parts of the patent specification into conflict with each other, but rather understands them as parts of the technical teaching made available to the skilled person with the patent as a meaningful whole. Only if and to the extent that this is not possible is it justified to conclude that parts of the description may not be used for interpretation. An interpretation of the patent claim which would have the consequence that none of the examples of the embodiment described in the patent specification would be covered by the subject matter of the patent can therefore only be considered if other possibilities of interpretation which would lead to at least the inclusion of some of the examples of embodiments are necessarily ruled out or if sufficiently clear indications can be derived from the patent claim that something is actually claimed which deviates so extensively from the description (BGH, judgement of 14 October 2014 - X ZR 35/11, GRUR 2015, 159, margin 26 - Access rights).

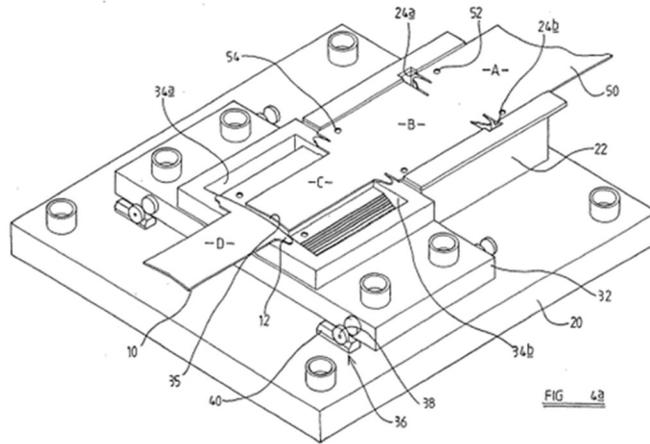
17           The content of the original documents or the publication of the application message shall not be taken into consideration in the interpretation. Neither may the patent claim be interpreted in accordance with what was originally disclosed in order to avoid an inadmissible extension (BGHZ 194, 107, marginal 28 - Polymer foam I), nor, conversely may its meaning be

determined by comparing the wording of the patent claim with wording of the application that deviates from the wording of the patent claim. At most, if it remains doubtful whether the claim and the description can be meaningfully related to each other, the "claim history" may be used for further clarification of the question whether the claim protects an object which differs from or falls short of the one disclosed in the description (BGHZ 189, 330, marginal 25 - occlusion device; BGHZ 194, 107, marginal 28 - polymer foam I).

18           2.     Taking these principles into account, it follows in the case in dispute that features 2.1 and 2.2 are to be read, in deviation from the wording of the claim, as meaning that at least parts of the pole sections of each element are provided by punching with the first punching element and the basic body sections of each element are provided by punching with the second element

19           a)     According to the general part of the description, the invention is intended to provide a means of easily producing rotor elements with pole sections (pole heads) that are offset by different distances from a center line of the base body section (pole shaft) (Para. 12 of the description). Preference is given to the part of the pole section produced by the first punching element that is the common to all rotor elements (scilicet irrespective of the extent of the offset from the center line) (Para. 13), i.e. the pole section is only partially punched out by the first punching element, while the rest of the material is taken away during subsequent punching out of the base body section.

20 This is explained in more detail below with reference to the drawings, of which figure 4a reproduced below, like figures 5a and 6a, represent views of a device according to the invention (Para. 17).



21 Thereafter, a first stationary punching element (die member) 22 is placed on a base plate 20 and a second movable punching element 32 arranged adjacent to it (Para. 22). Punch element 22 has two punch openings 24a and 24b, each corresponding to a surface adjacent to a part of the perimeter of the pole section (Para. 23). The movable punching element 32 has punching openings 34a and 34b, each corresponding to a surface adjacent to the (longitudinal) side of the base body section, and a third punching opening 35 extending therebetween (Para. 24). Using these punching openings, the rotor elements are punched out by means of punches not shown here (Paras. 27 ff.), in that in position B the pole sections are first partially punched out (Par. 28) and in position C the main body section by means of the punch members 64a and 64b and a third punch 65 formed integrally with these, the punching out of the pole sections is simultaneously completed and a complete rotor element is available in position D (Para. 30). The description further explains that it is understood that the punches of both punching elements 22, 32 are operated simultaneously. Following each punching operation, a drive means 36 is actuated to displace the punching element 32 incrementally in one direction and thus produce an offset of the pole section from the center line of the base body section (Para. 32).

22           b)     At first glance, patent claim 1 (and likewise process claim 7) is not consistent with this representation of the process according to the invention and a device suitable therefor. For according to feature 2.1 the (fixed) first punching element seems to be intended for punching out (at least) parts of the base body section and the (movable) second punching element for punching out the pole sections. However, from the overall content of the description and the further claims 2 to 6, it appears that in this case the base body and the pole sections have been interchanged and feature group 2 is therefore to be read as meaning that the machine has a punching arrangement which is provided (2.1) with a first punching element for punching out at least parts of the base body sections and (2.2) with a second punching element for punching out the pole sections of each element. 23           (1)

This is indicated first of all by the fact that a literal claim 1 contradicts not only parts of the description, such as individual or all embodiment examples, but also the description as a whole, without any plausible reason being recognizable for this. This becomes particularly clear in the alleged instruction of feature 2.1 to punch out at least parts of the base body section with the first punching element. As mentioned above, in the description it is explained at the outset as a preferred procedure to use the first punching element to produce parts of the pole sections, namely the (outer) outline of the pole heads common to all pole sections. With the basic body section punched out, the upper edge of the (leading) pole section is then punched and at the same time the lower edge of the next pole section is formed in dependence on the amount of the offset of the second punching element in such a way that a corresponding offset of the pole section with respect to the common center line of the basic body section (feature 4.2) results. In this way, different pole head shapes can be produced with one tool. Whereas, the possibility of punching out only part of the (uniform) base body with the first punching tool, but the pole section and the rest of the base body section with further punching tools, does not find any appeal in the description.

24           (2)     In addition, the wording of feature group 4 is not incompatible with the understanding developed by the Patent Court, but when viewed in the context of the description and the other patent claims, it also supports the assumption that, in accordance with the claim, the first punching element is not

intended for punching out at least parts of the base body sections, but rather the pole sections.

25           The Patent Court considered, correctly in its starting point, that the patent claim in features 3.1, 3.2 and 4 leaves open which punching element is fixed and which is movable, since feature 3.1 only specifies that both punching elements can be moved relative to each other. However, it concluded from feature 4.2 that the first punching element (partially) punching out the base body section is arranged stationary, because in this feature reference is made to a common center line of successive elements, the skilled person can understand nothing else by this than a center line common to all elements and consequently a device is protected in which the base body sections lie on a common center line during punching out.

26           Patent Claim 1 is a substantive claim, the features of which are intended to describe the protected object, i.e. in the case in dispute the machine and thus possibly indirectly the design of the products that can be manufactured with it. If feature 4.2 is used - as always required (instead of all BGHZ 194, 107, para. 27 Polymer Foam I) – in the context of feature group 4 and this is read in the context of the entire claim and against the explanatory background of the description, feature group 4 states that the relative position of the second punching element is changed stepwise (incrementally) in such a way that the pole section of each element is offset in relation to the pole section of the preceding element by a corresponding step width relative to the common center line of the base body sections. In other words, the relative movement of the punching elements (device feature 4) is to be such that the (rotor) elements produced with the device correspond to features 4.1 and 4.2. The base body sections thus have a common center line, while the (non-symmetrical) pole sections have an offset from the center line in one direction or the other.

27           In contrast, an understanding of feature 4.2 as an indirect description of the stationary arrangement of the first punching element would mean that the question left open in patent claim 1 as to which punching element is fixed and which is movable would be answered in the sense of a fixed arrangement of the first punching element, as the Patent Court also assumed. At the same

time, patent claim 2, which just determines that the first punching element is to be fixed and the second is to be moved incrementally relative to it, would thereby lose its function of concretizing the device protected by patent claim 1 and, in other words, would merely repeat the factual content of patent claim 1.

28           (3)     Finally, claim 6 and the corresponding method according to claim 9 in conjunction with the description also support the assumption that features 2.1 and 2.2 are to be read in the sense of an interchange of base body and pole sections.

29           From a technical point of view, the initially only partial punching out of the base body section, which feature 2.1 appears to provide for, could only be understood to mean that the punching out of its longitudinal edges is followed by the punching out of its foot line, possibly together with the upper edge of the preceding pole section. For this purpose, as explained, in the embodiment example the punch 65 is used which, together with the curved inner surface of the base body section, produces the curved outer surface of the pole section. As a result, as explained in paragraph 35 of the description, the center line of the radius of curvature of the pole sections remains substantially on the centerline C/L of the base body section, even though the offset of the pole section differs by one step from the theoretical position. Thus, at the same time, the center line of the outer surface of the pole sections of the stacked rotor elements and the air gap between this outer surface and the inner surface of the stator remain constant despite the angular arrangement. The advantages of this arrangement can be used without the disadvantage of changing the thickness of the air gap in the axial direction of the rotor arrangement (Para. 36)

30           The punch 65 belongs to a third punching member 35, which is used for punching out a peripheral edge between the base body portion of a member and the pole portion of a member formed by the previous punching-out operation, according to claim 4. According to claim 6, the second and third punching elements are integrally formed. Thus, in patent claim 6, integrally formed punches 64a, 64b, 65 are protected as explained in the description and shown in Figure 7. As required by patent claim 9, they can be moved together stepwise between successive punching operations.

31           With this one-piece moving tool, however, it is not possible to produce radii of curvature of the pole sections that lie essentially on the center line C/L of the base body section. It is not even possible to produce the (uniformly) curved inner surfaces of the basic body section, with which the rotor elements are arranged on the shaft in the embodiment example, because the one-piece punch is displaced relative to the basic body section.

32           (4)   Taking into account the overall content of the description, the meaning of feature group 4, and the wording of patent claims 2,6 and 9, the skilled person who undertakes to develop a meaningful and, if possible, contradiction-free overall understanding of the claims and the description intended to explain them must therefore conclude that with the wording of the patent claim in features 2.1 and 2.2, contrary to the wording, which is inaccurate in this respect, nothing has been protected which deviates from the device disclosed in the description, in which with the first (fixed) punching element (at least) parts of the pole sections of each element and with the second (movable) punching element the basic body sections of each element are provided by punching.

33           (c)   Contrary to the opinion expressed by the applicants at the oral proceedings, the interpretation of patent claim 1 described above, which applies accordingly to patent claim 7, is also not in conflict with a limitation of the subject-matter of the patent in suit compared to the subject-matter claimed in the application, which was made when the patent in suit was granted. For it remains the case that the patent claim has been defined by the additional features pointed out by the Patent Court as a narrower subject-matter compared to the application.

34           3.    Thus, the subject-matter of the patent in suit does not contain an inadmissible extension in this respect. The Patent Court did not err in law in assuming that there was no such extension in other respects either; the oppositions on appeal do not object to this.

35           IV.   Since the Patent Court - consistent with its starting point - has not dealt with the patentability of the subject-matter of the patent in suit,

the matter shall be referred back to the Patent Court, with the judgment under appeal being set aside (Sec. 119(2) and (3) Patent Act).

36 It is a basic idea of the reformed patent nullity procedure, that patentability is first assessed by the Patent Court, which is also attended by technically competent judges, and that this assessment is reviewed by the Federal Court of Justice. A final decision by the Federal Court of Justice (Sec. 119(5) Patent Act) is therefore generally not appropriate if the initial assessment of the state of the art by the Patent Court has been omitted. There is nothing to indicate that anything different would apply in the case of a dispute, and the parties have not asserted any such claim.

Meier-Beck

Gröning

Bacher

Deichfuß

Kober-Dehm

Previous instance:

Federal Patent Court, judgment of 23 January 2013 - 1 Ni 1/12 (EP) (additional 1 Ni 25/12 (EP)) -