

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2019-09-24
Docket Number / Aktenzeichen:	X ZR 62/17
Name of Decision / Name der Entscheidung:	Lenkergetriebe

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



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 62/17

Pronounced on:  
September 24, 2019  
Zöller  
Judicial Secretary as  
Clerk of the Court  
Registry

in the matter

Lenkergetriebe/  
Steering gearbox

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

If the patent claim requires that the protected device be capable of performing a particular operation and specifies a means by which that capability is to be achieved, the patent claim must, in case of doubt, be construed to mean that the means is intended to, and must accordingly be capable of substantially contributing to the operation when it is performed.

Federal Court of Justice, judgment of September 24, 2019 – X ZR 62/17 –  
Higher Regional Court of Munich  
Regional Court of Munich I

ECLI:DE:BGH:2019:240919UXZR62.17.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on September 24, 2019, attended by the judges Dr. Bacher, Dr. Grabinski and Hoffmann as well as the judges Dr. Kober-Dehm and Dr. Marx

ruled that:

On appeal on points of law by the defendant, the judgment of the 6<sup>th</sup> Civil Senate of the Higher Regional Court of Munich of May 18, 2017 is set aside on the issue of costs and insofar as it was found against the defendant.

The plaintiff's appeal against the judgment of the 21<sup>st</sup> Civil Chamber of the Regional Court of Munich I of June 22, 2016 is dismissed to the extent that it is still pending.

The plaintiff shall bear the costs of the appeals.

By operation of law

Facts of the case:

1 The plaintiff is the registered proprietor of German patent 196 31 042, which was filed on August 1, 1996 and has since lapsed due to the passage of time. Patent claim 1 has the following wording after a patent limitation procedure has been carried out:

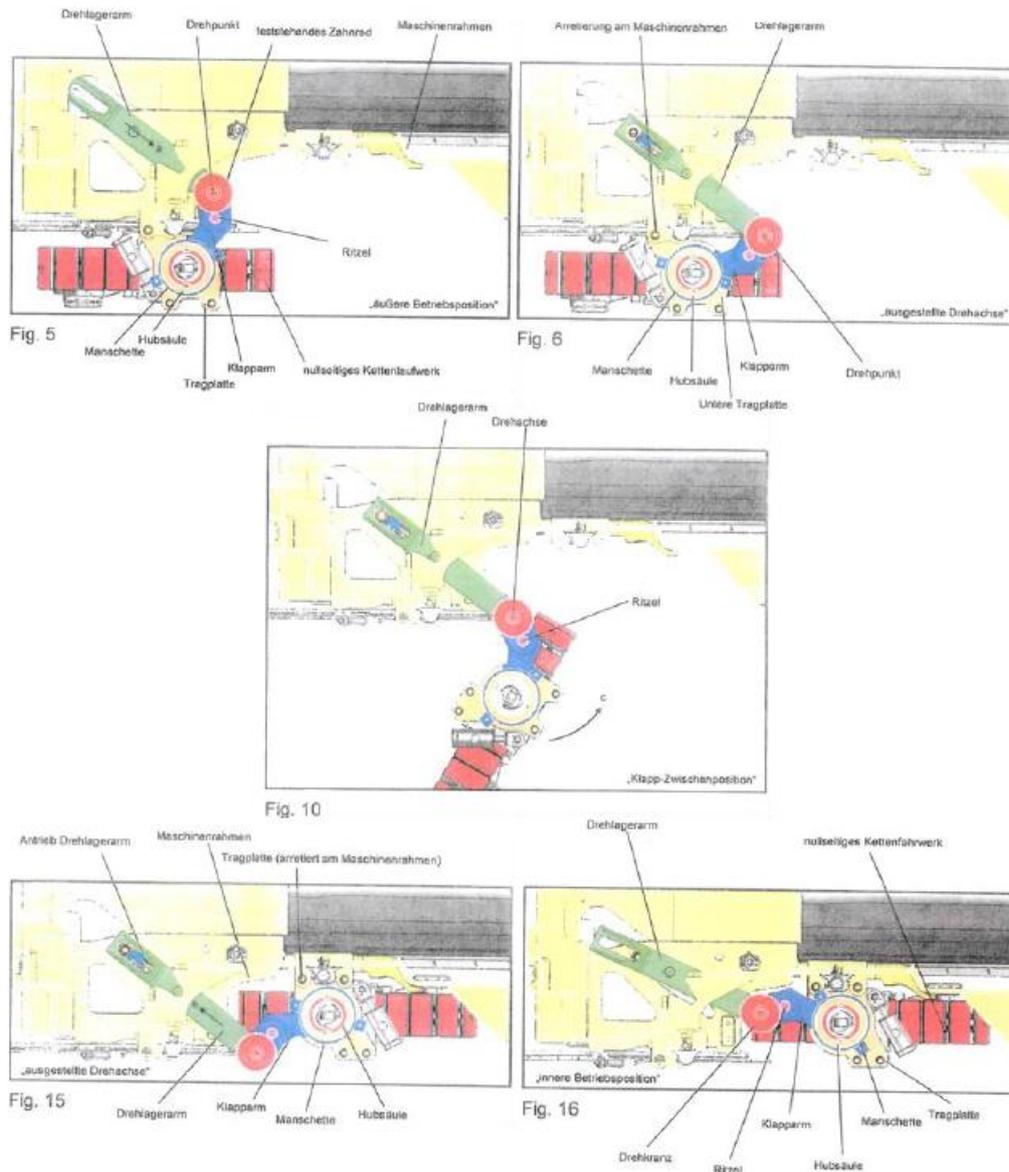
"Cold milling machine for road surface removal,

- with a self-propelled chassis, consisting of a steerable front chassis axle (6) with two support wheels (12) driven by a hydraulic motor and of two rear support wheels (14, 16) driven by a hydraulic motor, adjustable in height and independent of each other,
- with a driving position (4) for a vehicle driver arranged in the area of the two rear support wheels (14, 16) on the so-called zero side on a machine frame (8) supported by the undercarriage
- with a milling roller (20) mounted in or on the machine frame (8) as a working device (20), which is arranged at the rear end of the machine frame (8) and terminates approximately flush therewith and one end face (21) of which terminates approximately flush therewith on the so-called zero side (24) of the machine frame (8),
- wherein the rear support wheel (16) located on the zero side can be pivoted from an outer end position (26) parallel to the longitudinal direction of the machine frame and projecting beyond the zero side (24) into an inner end position (28) pivoted inwardly into a recess (18) of the machine frame (20) and parallel to the longitudinal direction of the machine frame (8), in which inner end position the support wheel (16) does not project beyond the zero side,
- wherein the rear support wheels (14, 16), when the rear support wheel (16) located on the zero side is in its outer end position, are located at the level of the milling roller axis of the milling roller (20) extending orthogonally to the direction of travel, and
- with a drive motor for the drive power required for driving the working device (20) and the travel operation,

**characterized in that**

the pivotable support wheel (16) can be pivoted from the outer end position (26) into the inner end position (28) by means of a steering gearbox (30) located in a horizontal plane situated below the operator's platform (4), the steering gearbox (30) being coupled to a drive device (34)."

2 The first defendant, whose managing directors are the second and third defendants, sells cold milling machines in the Federal Republic of Germany with the designations BM , BM and BM , which differ with regard to the milling width, but not in their design. The pivoting process of the rear zero-sided crawler track into a recess in the machine frame is shown in the following schematic drawings.



3 In Figure 5, the rear support wheel is in its outer end position with the swivel bearing arm retracted. In Figure 6, the swivel bearing arm is extended, but the support wheel is still locked to the machine frame. In Figure 10, the support wheel is pivoted about the axis of rotation in direction "c". In Figure 15, the support wheel is swiveled into the recess provided for this purpose. In Figure

16, the pivot arm is retracted and the gear wheel no longer protrudes over the machine frame. A change in position of the support wheel (as shown in Figure 10) is only possible when the swivel bearing arm (as shown in Figure 6) is extended.

4           According to the plaintiff, these cold milling machines make use of the technical teaching of the patent in suit in the literal sense.

5           The action brought against all the defendants for injunctive relief, information and accounting, destruction, recall and removal from the distribution channels, reimbursement of pre-judicial legal costs and a declaration of liability for damages was unsuccessful before the Regional Court. On the plaintiff's appeal, the Court of Appeal ordered the defendants to provide information and an accounting, and additionally ordered the first defendant to destroy, recall, and remove the challenged cold milling machines from the distribution channels, and found that the defendants were obligated to pay damages. It awarded only part of the claim against the defendants for reimbursement of pre-trial legal costs, rejecting the further claim, and ordered the defendants to pay the costs of the legal dispute, also with regard to the application for injunctive relief, which was declared to have been settled in the appeal proceedings after the expiry of the property right. In their appeal on points of law, which was allowed by the Senate, the defendants seek the restoration of the judgment of the Regional Court dismissing the action, the first defendant in the alternative seeks restoration insofar as the claims for destruction, recall and removal from the distribution channels were rejected there, and in the further alternative seeks a limitation of the sentence in respect of these claims to the effect that it is only required to modify the cold milling machines concerned insofar as they no longer fall within the scope of protection of claim 1 of the patent in suit. The plaintiff opposes the appeal on points of law.

Grounds of the decision:

6           The admissible appeal on points of law of the defendant is successful. It leads to the reversal of the contested judgment and to the dismissal of the plaintiff's appeal against the judgment of the Regional Court dismissing the action to the extent still pending.

7           I.       The patent in suit relates to a cold milling machine for removing road pavement.

8           According to the patent application, cold milling machines of the type W and W from the plaintiff's company were known for milling off road surfaces. These milling machines had a swivel arm for the rear support wheel on the so-called zero side, where the end face of the milling drum is almost flush with the side edge of the machine frame. In the case of the swivel arm, the vertical lifting column of the support wheel and the vertical rotary shaft, which is rotatable but otherwise rigidly mounted on the machine frame, are rigidly connected via two horizontal, vertically spaced struts. By means of the swivel arm, the support wheel could be swiveled from a position next to the milling drum into a recess in the machine frame located in front of the milling drum about the vertical swivel axis fixed to the machine frame, either manually or with the aid of a drive engaging the rotary shaft via a gear wheel (paras. 2, 3). Another milling machine had support wheels attached to the milling drum that swivel about a vertical axis (para. 4). Milling machines of newer design with all-wheel drive also had a zero-sided rear support wheel that could be swiveled about a vertical swivel axis, enabling milling close to the edge (para. 6).

9           In the latter milling machines and those of type W , the zero-sided rear support wheel and its uniaxial vertical bearing obstructed the free view of the working area in front of the milling drum both in the swung-out and swung-in states and also required a lot of space (vertically). Due to the space required, it was not possible to place a cabin on top of the operator's platform. The operators have to climb up and down from behind, which is detrimental to safety. In addition, the support wheel changes its direction of travel when swiveled without further measures (paras. 2, 7).

- 10           The patent in suit describes it as the task of the invention to further design a cold milling machine of the type mentioned at the beginning of the patent specification in such a way that the free view of the working area in front of the working device is improved when working close to the edge with a support wheel that can be swiveled on the zero side of the machine.
- 11           For the solution claim 1 of the patent in suit in the version after the patent restriction proposes a cold milling machine with the following features:
- 1.1   Cold milling machine for pavement removal
  - 1.2   with a self-propelled undercarriage consisting of
    - 1.2.1   a steerable front crawler axle
      - 1.2.1.1   with two support wheels
      - 1.2.1.2   the two support wheels are driven by a hydraulic motor
    - 1.2.2   and two rear support wheels
      - 1.2.2.1   the two rear support wheels are driven by a hydraulic motor,
      - 1.2.2.2   adjustable in height and
      - 1.2.2.3   independent of each other
  - 1.3   with a driving position for one driver
    - 1.3.1   the driving position is located in the area of the two rear support wheels
    - 1.3.2   on the so-called zero side
    - 1.3.3   on a machine frame supported by the running gear
  - 1.4   with a milling drum mounted in or on the machine frame as a working device,
    - 1.4.1   which is arranged at the rear end of the machine frame
    - 1.4.2   and approximately flush therewith
    - 1.4.3   and one end face of which terminates on the so-called zero side of the machine frame approximately flush therewith,
  - 1.5   wherein the rear support wheel located on the zero side
    - 1.5.1   from an outer end position parallel to the longitudinal direction of the machine frame and protruding beyond the zero side
    - 1.5.2   into an inwardly pivoted recess of the machine frame
    - 1.5.3   inwardly into a recess of the machine frame, in which the support wheel does not project beyond the zero side,

- 1.6.1 the rear support wheels being in their outer end position when the rear support wheel located on the zero side is in its outer end position,
- 1.6.2 being at the height of the milling roller axis of the milling roller,
- 1.6.3 the milling roller axis extending orthogonally to the direction of travel,
- 1.7 with a drive motor for the drive power required for driving the working device and for travel operation
- 1.8 characterized in that the pivotable support wheel can be pivoted from the outer end position into the inner end position by means of a steering gearbox mechanism
  - 1.8.1 the steering gearbox lies in a horizontal plane
  - 1.8.2 the horizontal plane is below the driving position
  - 1.8.3 the steering gearbox is coupled to a drive unit.

12 II. The Court of Appeals gave the following main reasons for its decision:

13 The skilled person would understand feature 1.8 in the light of the task (improving visibility, approaching an obstacle during near-edge milling) in such a way that the "inner end position" of the swiveled-in rear support wheel is only reached when – as also shown and described for the embodiment example according to Figures 2, 3a to 3c – no further gear element or other obstacle protrudes beyond the zero side, because only then can near-edge milling and direct approaching of an obstacle take place.

14 A steering gearbox according to the invention, which is located in a horizontal plane below the driving position, can absorb high vertical forces despite its small vertical extension. Since the patent in suit is otherwise silent on the more detailed technical design, the skilled person relies on his general technical knowledge in this respect. The design of a steering gearbox mentioned in the description and shown in figures 3a to 3c of the patent in suit with four vertical joint axes and two steering arms pivotable in a horizontal plane is only exemplary and does not limit the subject matter of patent claim 1. With regard to the wording of feature 1.8 ("via a [not "by means of"] steering gearbox") and a function-oriented approach, the steering gearbox only had to make a contribution essential to the invention in ensuring that the zero-sided rear support wheel moved from the outer end position to the inner end position by

means of a pivoting mechanism, so that milling close to the edge was possible, but did not have to be involved as such in the change in position of the support wheel itself.

15           With this understanding of claim 1, the challenged embodiments also made use of feature 1.8, which was the only feature in dispute. There, the support wheel is pivotable from the outer to the inner end position, which is reached only when the pivot bearing arm is retracted again, because only then no more machine parts overlap the zero side. The swiveling is also done by a steering gearbox, because without the extension of the swivel bearing arm a movement of the support wheel from the outer to the inner operating position for edge milling is not possible. The fact that the pivot bearing arm and the folding arm only act in this phase as a thrust crank mechanism (in the sense of a steering gearbox mechanism according to the invention) and that the thrust crank mechanism in the sense of a functional unit does not itself participate in the subsequent swiveling process by means of power transmission is – apart from the fact that this is not a process claim but a device claim – irrelevant when interpreted according to function.

16           III.       This assessment does not withstand review under the law of appeal on points of law in one decisive point.

17           1.       Contrary to the opinion of the Court of Appeal, it is not sufficient for the realization of feature 1.8 if a steering gearbox merely creates the conditions for the rear zero-side support wheel to be swiveled from the outer to the inner end position, but does not participate in the swiveling movement itself. For irrespective of whether the wording used by the feature of the pivotability of the support wheel "via a steering gearbox" could be understood in this sense when viewed in isolation, it results in any case from an interpretation aligned with the overall context of the patent claim, taking into account the description and figures, that the steering gearbox must be designed in such a way that it participates in the pivoting of the support wheel in a significant manner when such pivoting takes place.

18           a)       According to settled case law, when interpreting a patent claim, the meaning of the claim as a whole and the contribution of the individual

features to the result of the invention must be determined. For the understanding of an individual technical feature, at least in case of doubt, the function it has in bringing about the success of the invention is decisive. In this context, the description and drawings are to be consulted, which explain and illustrate the technical teaching of the patent claim and are therefore to be taken into account not only for the determination of the scope of protection (Art. 69(1) EPC, Sec. 14 Patent Act), but also for the interpretation of the patent claim (see Federal Court of Justice, judgment of July 17, 2012 – X ZR 117/11, BGHZ 194, 107 marginal no. 27 = GRUR 2012, 1124 – *Polymerschaum*). Patent claims are to be interpreted in such a way that a meaningful whole results from the totality of their features (see Federal Court of Justice, judgment of March 31, 2009 – X ZR 95/05, BGHZ 180, 215 marginal no. 16 = GRUR 2009, 653 – *Straßenbaumaschine*; order of July 8, 2008 X ZB 13/06, GRUR 2008, 887 marginal no. 21 – *Momentanpol II*). If the patent claim requires the suitability of the protected device to be able to carry out a certain operation and if it designates a means by which this suitability is to be achieved, the patent claim is therefore to be interpreted in case of doubt to the effect that the means is intended for this purpose and must accordingly be suitable to participate in a significant manner in the operation when it is carried out.

- 19           b)       Feature group 1.5, according to which the rear zero-sided support wheel is pivotable from an outer to an inner end position, determines that the protected cold milling machine must be designed in such a way that a pivoting operation can be carried out to the required extent. This is concretized in feature 1.8 to the effect that the support wheel can be pivoted from the outer end position to the inner end position via a steering gearbox, the steering gearbox being coupled to a drive device. From the point of view of the skilled person, the relationship thus expressed between the steering gearbox and the pivoting process which is to be realized via the latter is to be understood to the effect that, according to the invention, the steering gearbox is provided as a means for this purpose and must be suitable for contributing in a considerable manner to the movement with which the support wheel is pivoted from the outer to the inner end position.

20           It is true that the patent claim does not expressly require that the pivoting of the support wheel be effected "by means of" a steering gearbox. However, this is of no decisive importance in this context. For there is no indication either in the patent claim or in the description that the formulation of the swivel capability "via" a steering gearbox is to be understood as meaning that it should be sufficient if the steering gearbox is designed to create a prerequisite for the swivel capability of the support wheel, but without being involved in the swivel movement itself. The wording "via" a steering gearbox selected in feature 1.8 merely expresses the fact that other elements not expressly mentioned in the claim can participate in the pivoting movement or that there can be operating states in which the steering gearbox is not involved in carrying out the pivoting movement.

21           c)       This understanding of the claim is also supported by the other contents of the patent specification.

22           According to the description, the steering gearbox is intended to replace the swivel mechanism known from the state of the art, in order in this way to reduce the vertical space requirement for the swivel device of the support wheel, so that the view of the working area in front of the working device is improved. For this purpose, according to the invention, the transmission is arranged in a horizontal plane located under the operator's platform (paras. 11, 12). If it is stated in this context that the horizontal position of the transmission considerably reduces the space required for the swiveling device with the support wheel, so that the support wheel with the swiveling device allows a better view of the working area in front of the working device in the swiveled-out and swiveled-in state (cf. para. 11), it cannot be inferred from this, contrary to the plaintiff's opinion, that the transmission and the swiveling device are separate devices. On the contrary, it is also clear from these explanations that the steering gearbox is part of the swiveling device and at least participates in a swiveling process, as is also mentioned for the embodiment example in the description (Para. 36).

23           With regard to the drive device to which the steering gearbox according to feature 1.8.3 is coupled, the description further explains that in this way the swiveling of the support wheel can be initiated by the vehicle operator on the

operator's platform at an operating panel (paragraph 15). This also expresses the fact that the steering gearbox is the swiveling device or, in any case, a decisive means by which the swiveling process is carried out.

24           This corresponds to the fact that in all exemplary embodiments of the protected invention shown in the patent application, the steering gearbox has the function of carrying out the pivoting process. In contrast, a steering gearbox, which merely creates the conditions for carrying out the swiveling process without being involved in the process itself is not shown anywhere.

25           2.       On the basis of the findings of the Court of Appeal on the design of the challenged cold milling machines, the contested judgment cannot be upheld insofar as it was found to be to the disadvantage of the defendant.

26           The unit of pivot bearing arm and folding arm identified by the court of appeal as a steering gearbox in accordance with the patent may act as a steering gearbox in the phase of retraction and extension of the pivot bearing arm. However, the pivoting movement of the crawler track, which is only possible when the pivot bearing arm is extended, is decoupled from this. According to the findings of the Court of Appeal, the extension of the swivel bearing arm creates the possibility of changing the position of the crawler track by swiveling. However, no linkage gear is involved in the swiveling movement itself. The means for carrying out the swiveling are the swivel axis located on the swivel bearing arm and the folding arm. These do not constitute a linkage within the meaning of the patent in suit, even according to the broad understanding of the concept of linkage by the Court of Appeal and the plaintiff.

27           IV.       Accordingly, the judgment of appeal is to be set aside insofar as it was decided to the disadvantage of the defendant.

28           The Senate can decide the matter itself because additional findings are neither necessary nor to be expected and the matter is therefore ready for decision (Sec. 563(3) Code of Civil Procedure).

29           According to the foregoing, the challenged cold milling machines do not make use of the teaching of the patent in suit, so that the plaintiff's appeal

against the judgment of the Regional Court dismissing the action must be dismissed to the extent last pending.

30 With regard to the claim for injunctive relief, which was declared settled by mutual agreement in the appeal proceedings, the judgment of the Regional Court dismissing the action is without effect. A separate pronouncement of this legal consequence is not required (see Federal Court of Justice, judgment of May 7, 2015 – I ZR 176/12, GRUR-RS 2015, 10416 marginal no. 4 – *Gute Laune Drops II*).

31 V. The decision on costs is based on Sec. 91(1), first sentence, 91a(1), first sentence, 97(1) Code of Civil Procedure.

Bacher

Grabinski

Hoffmann

Kober-Dehm

Marx

Previous instances:

Regional Court of Munich I, judgment of June 22, 2016 – 21 O 6887/15 –

Higher Regional Court of Munich, judgment of May 18, 2017 – 6 U 3036/16 –