

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2017-11-07
Docket Number / Aktenzeichen:	X ZR 63/15
Name of Decision / Name der Entscheidung:	Digitales Buch



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 63/15

Pronounced on:
7 November 2017
Anderer
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Digitales Buch/
Digital Book

German Act on International Patent Conventions Art. II Sec. 6(1) sentence 1 No. 3

The fact that all embodiments described in an application have a certain feature precludes claiming protection for embodiments without that feature if it can be inferred from the content of the application that the means provided for in the claim serve to solve a problem that presupposes the presence of the feature in question (supplement to Federal Court of Justice, judgment of 11 February 2014 X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 31 Kommunikationskanal).

Federal Court of Justice, judgment of 7 November 2017 - X ZR 63/15 –
Federal Patent Court

ECLI:DE:BGH:2017:071117UXZR63.15.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 7 November 2017, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Dr. Bacher as well as the judge Dr. Kober-Dehm

ruled that:

The appeal against the judgment of the 2. Senate (Nullity Senate) of the Federal Patent Court of 15 May 2015 is dismissed at the expense of the defendant.

By operation of law

Facts of the case:

1 The defendant is the proprietor of the European patent 1 659 501 (patent in suit), granted with effect for the Federal Republic of Germany, which concerns a display device with an interface in the pivot joint. The patent in suit arose by way of division from a parent application of 21 September 1998 (WO 99/15982 A1, NK2) and claims the priority of a German application of 19 September 1997 (DE 197 41 453 A1). Patent claim 1, to which seventeen further claims refer back, reads in the process language:

"Display device, in particular for the reproduction of text and/or image information, comprising a housing with a main part (1) and at least one secondary part (2), the main part and the at least one secondary part being arranged in such a way that the housing can be folded open and closed in a book-like manner about a folding axis (A) of a rotary joint, a display unit with at least one screen (3, 4), characterized in that an interface for the power supply and/or for the transmission of data signals from or to other information processing systems is arranged in the rotary joint, the interface being in the form of an electrical plug connection."

2 The plaintiff has argued that the subject matter of the patent in suit goes beyond the content of the parent application and is not patentable. Further, the invention was not disclosed in such a way that the skilled person could carry it out. The defendant defended the property right with a main request and two auxiliary requests in amended versions.

3 The Patent Court declared the patent in suit null and dismissed the action insofar as its subject matter extended beyond the version of the patent claims defended by auxiliary request II.

4 This is contested by the defendant's appeal, which pursues its claims that were unsuccessful at first instance. The plaintiff opposes the appeal.

Grounds of the decision:

5 The admissible appeal is unfounded.

6 I. The patent in suit concerns a display device with an interface in
the rotary joint.

7 1. According to the statements in the patent in suit, the devices
known in the state of the art for displaying book, newspaper and magazine
information and the like do not enable a technical layman to hold and operate
them in an uncomplicated and comfortable manner. Laptops and notebooks are
not sufficiently ergonomic due to their purpose as working tools and the resulting
features and require a high operating effort. Electronic books known in the state
of the art also often required cumbersome and time-consuming operating
operations. In an embodiment known from US patent specification 5 534 888
(NK5), a large number of electrical connectors are arranged on the back of the
central part. Their identification requires technical knowledge. In addition, the
device could no longer be held by the spine in the manner of a book or placed
on a support when electrical leads were connected to the connectors.

8 Against this background, the patent in suit concerns the technical
problem of providing a device for displaying book information and the like which
allows easier handling and operation.

9 2. In order to solve this problem, the patent in suit, in the version of
claim 1 defended by the main request, proposes a digital display device, the
features of which can be structured as follows (amendments to the granted
version are highlighted, the deviating structure of the Patent Court is given in
square brackets):

1. The digital display device serves ~~in particular~~ to display text
or image information [1a] and comprises:
 - a) a housing with a main part (1) and at least one
secondary part (2) [1b],
 - b) a display unit with at least one screen (3, 4) [1d].
2. The main and secondary parts are arranged in such a way
that the housing can be folded open and closed in a book-
like manner about precisely one folding axis (A) of a rotary

joint [1c].

3. An interface for the power supply ~~and/or for the transmission of data signals from or to other information processing systems~~ [1e] is arranged in the swivel joint which

a) is designed in the form of an electrical plug connection [1f],

b) has a guide and supply opening (7') [1g],

(1) in which mating contacts (8') for the current supply are arranged [1h], and

(2) which is cylindrical in such a way that its longitudinal axis is coaxial with the folding axis [1i].

10 3. In this version, the distinction expressed in the description between relatively large, more difficult-to-operate devices such as laptops or notebooks and handier, easier-to-operate devices such as digital books is not reflected.

11 a) The term "digital book" used in numerous places in the description of the patent in suit designates a mobile display device which, due to its special design, is suitable for being handled like a book.

12 However, neither the patent claims nor the description contain an exact definition of which features must be realized in detail for this purpose. However, it follows from the objective stated in the description that the device according to the invention should offer the user the possibility of easy handling that only devices are to be regarded as digital books which, both because of their dimensions and weight and because of the function and arrangement of their operating elements, can be taken in hand in a comparable manner to a conventional, not too bulky and heavy book.

13 The description states that the digital book according to the invention is intended to offer the user a simple handling option to enable him to read extensive literature and to offer him the advantage over a conventional voluminous and heavier book of being able to read any number of pages in a handy form. In this context, the reading and viewing habits of conventional book, magazine and newspaper readers are to be taken into account. In particular, the aim is to ensure safer and more ergonomic holding and operation in different

situations, for example when walking, lying down or in other situations where there is no support surface (Par. 8).

14 It is true that neither exact maximum dimensions for the size or weight of a device in question nor minimum requirements for the functionality of individual operating elements can be derived from this. Nevertheless, it follows from the indicated objective that as a digital book in the sense of the patent in suit only devices come into consideration which, due to the totality of their equipment features, enable a handling comparable to that of a conventional, not too voluminous and heavy book.

15 Whether a device meets these requirements is to be determined, if necessary, by the judge of fact. The distinction required for this may not be easy to make in the case of certain devices. Particularly in the case of more modern devices, the aforementioned requirements may also be met if the device, due to its other features, can not only be handled like a book but can also optionally be used like a personal computer and can therefore be classified as a laptop or notebook at the same time. However, these features are not necessarily present in every mobile electronic device, in particular not in a portable computer which, due to its weight and the arrangement of its controls, is not suitable to be used like a book.

16 b) The term "display device for displaying text and/or image information" used in feature 1 [1a] of patent claim 1 is not a synonym for "digital book". Rather, it also includes display devices that cannot be handled in the manner mentioned.

17 aa) According to common technical usage, a display device is a device with which image or text information can be displayed. In principle, this also includes devices that cannot be handled like a book.

18 bb) This linguistic usage is also the basis of the patent in suit.

19 At the beginning of the description it is stated that the invention concerns "a digital book, i.e. a mobile display device in particular for the reproduction of book, newspaper and magazine information and other documentation or publications in electronic or digital form by means of text, graphic, photo and/or

video and audio information for operation by lay users" (para.1). From this it follows on the one hand that every digital book in the sense of the patent in suit is at the same time a mobile display device. On the other hand, it follows from the indications already given above concerning the objective of the invention that not every mobile display device is a digital book within the meaning of the patent in suit, but that additional requirements have to be fulfilled for this purpose. This is in accordance with the general usage.

20 It cannot be inferred from the statements in the same context that certain users often reject "the use of an electronic or digital book (a mobile digital display device)" if these give an impression that is too much oriented towards computer technology (para. 8, sentence 3, lines 2-8) that the two terms are to be understood as synonyms. The addition of an expression in brackets to an expression with a similar meaning may, in individual cases, be understood as an implied definition of a term similar to a legal definition. In the present context, however, such an assumption is out of the question, if only because the passage in question concerns a phenomenon that can occur in the same way with digital books and with other mobile display devices.

21 The fact that numerous other passages in the description refer to a digital mobile display device according to the invention does not lead to a different assessment. These passages merely reflect that each digital book is at the same time a mobile display device. It cannot be inferred from them that the two terms are to be used as synonyms.

22 c) No further requirements result from features 1 a and 2 [1b and 1c], according to which the housing must consist of two parts which can be folded open and closed about an axis in a book-like manner. The attribute "book-like" in this context refers only to the folding process, not to the nature of the device as a whole.

23 d) No further restrictions also result from the distinction between a main part and a secondary part provided in feature 1 a. Patent claim 1 does not specify which technical functions these two parts must fulfill. Contrary to the view taken by the Regional Court of Düsseldorf in the infringement dispute (judgment of 14 January 2014 - 4a O 207/12, juris para. 122), this feature can

therefore also be realized in a device that cannot be handled like a book. It can be left open which part of the housing is to be regarded as the main part.

24 e) Further requirements, for example that the device is easy to handle and enables simple operation or that the two parts can be separated from each other, are not provided for in patent claim 1. Therefore, the conclusion that the meaning of the patent claim refers only to devices having these additional features cannot be drawn from the relevant statements in the description.

25 II. The Patent Court gave the following main reasons for its decision:

26 The subject matter of the patent in suit as defended by the main request goes beyond the content of the parent application. The skilled person, an engineer of electrical engineering with a technical college degree and several years of professional experience in the conception and development of mobile information devices, would only take the inventive intention of improving a digital book from the parent application. All claims were directed to such an object. Laptops and notebooks were recognizably distinguished from this and described as downright unsuitable. The fact that the skilled person might have recognized that individual measures could also be suitable for other devices was not sufficient for disclosure as belonging to the invention.

27 The same applied to the subjectmatter defended by auxiliary claim I. The generic term "one-piece base with a screen and a coupled laptop keyboard" used therein encompassed all types of screens to which a laptop keyboard could be coupled. It thus also goes beyond the content of the parent application.

28 III. This assessment stands up to scrutiny in the appeal proceedings.

29 1. The Patent Court rightly concluded that the subject matter of claim 1 in the version defended by the main request goes beyond the content of the parent application.

30 a) According to the established case law of the Federal Court of Justice, the principles of novelty examination apply to the assessment of identical disclosure. Accordingly, it is required that the skilled person can directly

and unambiguously infer the technical teaching designated in the claim from the original documents as a possible embodiment of the invention. When exhausting the content of the disclosure, generalizations of examples of embodiments disclosed by the origin are also permissible. This applies in particular if only one or only some of several features of an embodiment example, which taken together but also considered individually are conducive to the success of the invention, have been included in the claim (Federal Court of Justice, judgment of 11 February 2014 - X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 21 et seq. - Kommunikationskanal; order of 8 November 2016 - X ZB 1/16, GRUR 2017, 54 marginal no. 44 - Ventileinrichtung).

31 b) The Patent Court correctly decided that only digital books are disclosed in the parent application of the patent in suit as belonging to the invention.

32 aa) However, as the Patent Court also correctly saw, this does not already follow from the fact that all claims formulated in the parent application are directed only to protection for a digital book.

33 Insofar as claims are already formulated in an application, these are only of a provisional nature, as the appeal correctly points out in this respect. Only in the course of the subsequent examination proceedings is it necessary to work out what is protectable in the light of the state of the art and for which claims the applicant seeks protection (Federal Court of Justice, judgment of 11 February 2014 - X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 22 Kommunikationskanal).

34 bb) However, the Patent Court rightly considered it decisive that all embodiments described in the parent application relate to a digital book in the sense described above and that the invention disclosed in the application requires the use of such a device.

35 However, the fact that all embodiments described in an application have a certain feature does not preclude the claiming of protection for embodiments without this feature if no concrete relationship between the feature in question and the means provided in the claim for solving a technical problem described

can be inferred from the content of the application (see Federal Court of Justice, judgment of February 11, 2014 - X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 marginal no. 31 - Kommunikationskanal). In the case in dispute, however, it can be inferred from the parent application that the means provided for in the claim serve to solve a problem that requires the use of a digital book.

36 However, this connection does not already follow from the fact that laptops and notebooks are described in the description as unsuitable for the intended purpose. As the defendant rightly asserts in this respect, the description also criticizes electronic books known in the state of the art as being inadequate (NK2 p. 2 line 32 to p. 3 line 4). Against this background, there would in principle remain room for the assumption that the disclosed solvents are suitable for digital books as well as for other display devices and are claimed as belonging to the invention.

37 The fact that only digital books are disclosed in the parent application as belonging to the invention is, however, apparent from the explanations contained in the description concerning the function of the interface provided in feature group 3. As has been pointed out above, with respect to the electronic book disclosed in NK5, the description states that the arrangement of the electrical connectors on the back of the central part means that the device can no longer be held by the spine of the book or placed on a support when electrical leads are connected to the connectors (NK2 p. 3 lines 15-23). Advantages of the different arrangement of the connectors disclosed in the parent application are said to be, among others, a better possibility to place the device on a table surface or the lap, a more favorable symmetry and balance, less irritation by disturbing cables and a reduction of the "technical impression" (NK2 p. 6 line 10 to p. 7 line 6). The disclosed design should therefore make it possible to handle the device like a book, especially to hold it by the spine, even with the cables connected. This in turn requires that the device can be handled like a book due to its dimensions and weight as well as due to the selection and arrangement of its operating elements.

38 cc) The fact that the parent application discloses an independent solution with respect to various individual aspects of a digital book does not lead to a different assessment.

39 However, the fact that a disclosed invention comprises several aspects of a solution between which there is no functional connection may indicate that individual aspects are also disclosed individually as belonging to the invention.

40 However, the decisive aspect in the dispute - the design of the interface according to the specifications defined in feature group 3 - is functionally related to the suitability of the device to be handled like a book for the reasons stated above. Thus, the corresponding design of an interface in a device which does not meet these requirements is not disclosed as belonging to the invention.

41 The fact that some of the advantages (NK2 p. 6 line 21 to p. 7 line 6) of such an interface as mentioned in the parent application may also be realized in other devices does not justify a different assessment. In the enumeration of these advantages, the easy manageability is in the foreground. In view of this, it is not directly and unambiguously disclosed that also such embodiments belong to the invention in which individual advantages are achieved in a device, which cannot be used like a book.

42 2. The Patent Court also correctly concluded that the subject matter of claim 1 in the version defended by auxiliary request I also goes beyond the content of the parent application.

43 a) According to auxiliary request I, feature group 1 is to be replaced by the following wording, which is also to find its way into feature 2:

 "One-piece output base with a screen and a coupled laptop keyboard".

44 b) The Patent Court correctly decided that protection is thus also claimed for devices which cannot be handled like a book due to their spatial and functional design.

45 Thus, for the reasons explained above in connection with the main request, the subject matter claimed by this request also goes beyond the content of the parent application.

46 c) Contrary to the opinion of the appeal, the fact that the parent application already discloses a device in Figure 26a, drawing file e, in which, according to the description, a screen described as a one-piece base is coupled

with a laptop keyboard (NK2 p. 20 lines 24-27), does not lead to a different assessment.

47 In principle, however, the user is not precluded from claiming protection for an embodiment that is specifically disclosed in an embodiment example.

48 The embodiment example shown in figure 26a, however, also does not concern any device in which a one-piece output base is coupled with a laptop keyboard, but only a digital book with these features.

49 This is indicated by the partial figures a and b of this figure, in which a screen element is shown whose embodiment essentially corresponds to that of the previously described examples, the fact that this embodiment example is shown in connection with other examples, which consistently concern individual aspects of a digital book, and the explanations taken up by the appeal in another context, according to which Figure 26a shows, on the example of a one-piece initial base, the coupling of an exemplary handle, a book cover, a laptop keyboard or a card station described in Figure 26 (NK2 p. 41 Z. 15-19). Indications that the arrangement disclosed in Figure 26a is also claimed for devices with a different spatial-functional design as belonging to the invention cannot be inferred from the parent application.

50 IV. The decision on costs is based on Sec. 121(2) Patent Act and Sec. 97(1) Code of Civil Procedure.

Meier-Beck

Gröning

Grabinski

Bacher

Kober-Dehm

Previous instance:

Federal Patent Court, judgment of 15 May 2015 – 2 Ni 14/13 (EP) –