

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-09-13
Docket Number / Aktenzeichen:	X ZR 64/14
Name of Decision / Name der Entscheidung:	Datengenerator



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 64/14

Pronounced on:
13 September 2016
Hartmann
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Datengenerator/
Data generator

Patent Act Sec. 64(1). Sec. 83(4). Sec. 116(2)

- a) If the patent proprietor defends the patent in suit in the nullity proceedings only with certain sets of claims, it justifies the complete declaration of nullity of the patent if it does not prove to be legally valid as a whole in any defended version. However, when examining the patent proprietor's claims, the court must not be guided by the wording of the patent proprietor's requests, but must determine what is actually intended and take into account the patent proprietor's entire submissions (following Federal Court of Justice, order of 27 June 2007 - X ZB 6/05, BGHZ 173, 47 Informationsübermittlungsverfahren II).
- b) If the patent proprietor submits a set of claims for decision which contains subordinate claims which are not only in a relationship of subordination due to different claim categories but also contain factually different solutions, the assumption that the patent proprietor does not want to defend the other patent claims either, if the subject matter of only one of these claims proves to be unpatentable or a claim proves to be inadmissible or not legally valid for other reasons, is usually far from being true.

Federal Court of Justice, judgment of 13 September 2016 - X ZR 64/14 –

Federal Patent Court

ECLI:DE:BGH:2016:130916UXZR64.14.0

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 13 September 2016, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Dr. Grabinski, Hoffmann, the judge Schuster and the judge Dr. Deichfuß

ruled that:

On appeal by the defendant and dismissing the further appeals of the parties, the judgment of the 2nd Senate (Nullity Senate) of the Federal Patent Court of 23 January 2014 is amended.

German patent 41 03 173 is declared partially null to the extent of claims 1, 5 and 8 to 13 in that patent claim 1 and the direct or indirect reference back to patent claim 1 in claims 5 and 8 to 13 are omitted.

In all other respects the action is dismissed.

The costs of the legal dispute are ordered to be borne two-thirds by the plaintiff and one-third by the defendant.

By operation of law

Facts of the case:

1 The defendant is the registered proprietor of German patent 41 03 173 (patent in suit), which expired due to the passage of time and was filed on 2 February 1991. Patent claims 1, 3, 4 and 5 were given the following wording in the opposition proceedings:

- "1. Apparatus for protecting against unauthorized use of software, in which at least one external data generator (11) connectable to a signal input of a computing system (10) generates data, the data output from the data generator (11) being dependent on data received from the computing system (10), and the computing system is brought into an error state or the software in the computing system does not operate appropriately, if the computing system receives no data or faulty data via the signal input (13), characterized in that the data generator (11) recognizes data or data sequences not provided for and/or data or data sequences not provided for in time as attempts at manipulation and, if an attempt at manipulation is recognized, changes the contents of a memory in the data generator and, as a result, outputs no data or faulty data when further data is received and/or changes a user authorization.
3. Device according to the generic term of claim 1, in particular in conjunction with the characteristic of claim 1 and/or 2, characterized in that the data generated by the data generator (11) have a non-deterministically generated redundancy.
4. Device according to the generic term of claim 1, in particular in connection with the characteristic of claim 1, 2 and/or 3, characterized in that the data generator (11) has two states A and B, on the assumption of which the data output by the data generator depend, the data generator can be brought from state A into state B only by at least five successive further states C, which are assumed on the basis of received data, and the data output by the data generator do not depend on the states C.
5. Device according to one of claims 1 to 4, characterized in that data on authorization to use the software are stored in the data generator (11), and the authorization data control access to specific programs and/or program parts and/or determine the type of computing system (10) or exclude at least one type and/or limit access in time and/or control access quantitatively."

2 The plaintiff claiming from the patent in suit has challenged the patent in

suit to the extent of claims 1, 3 to 5 and 8 to 13 by means of the nullity action. It claimed that the subject matter of the patent in suit was not patentable in this respect. Moreover, the patent in suit did not disclose the invention so clearly and completely that a skilled person could carry it out. The subject matter of the patent in suit went beyond the content of the patent application as originally filed. Finally, the scope of protection of the patent in suit had been extended in the opposition proceedings. The defendant defended the patent in suit as amended and on the basis of five auxiliary requests.

- 3 The Patent Court declared the patent in suit partially null, rejecting the further claim, by giving the following wording to the entirety of the attacked patent claims in accordance with the fifth auxiliary request of the defendant:

"Apparatus for protecting against unauthorized use of software, in which at least one external data generator (11) connectable to a signal input of a computing system (10) generates data, the data output by the data generator (11) being dependent on data received from the computing system (10), and the computing system being brought into an error state or the software in the computing system not operating appropriately when the computing system receives no data or receives erroneous data via the signal input (13).

characterized in that the data generator (11) detects attempts to tamper with the received data, wherein

the data generator (11) recognizes data or data sequences which are not provided and/or data or data sequences which are not provided in time as manipulation attempts and, when a manipulation attempt is recognized, changes the contents of a memory in the data generator and, as a result, outputs only erroneous data in a time-limited manner when further data is received, the data generated by the data generator (11) having non-deterministically generated redundancy wherein the data generator (11) has two states A and B, on the assumption of which the data output by the data generator depend, the data generator can be brought from state A into state B only by at least five successive further states C which are assumed on the basis of received data, and the data output by the data generator do not depend on the states C. "

- 4 The defendant's appeal is directed against this, with which it defends the patent in suit in the main request in the valid version, but with omission of patent claim 1, as well as with an auxiliary request. With its appeal, the plaintiff continues to pursue the first-instance claim insofar as it was rejected.

Grounds of the decision:

5 I. The patent in suit concerns devices for protecting computer programs against unauthorized use.

6 1. According to the description in the state of the art, in order for software to be used only by an authorized person, components such as plugs were known which must be connected to the computer so that the program can be used. In the simplest case, the computer queries the presence of the component; if it is missing, the program flow is disrupted.

7 A data generator is also described as such an external component. It receives signals from the computer and returns defined response signals. Only if the response signals correspond to the expected signals, the program can be used. However, the patent in suit sees as a disadvantage that this protection can be circumvented by analyzing the input and output data of the data generator, by reducing the input and output behavior to simple logic functions using logic minimization techniques, or by developing a model of the data generator to simulate it.

8 The description describes it as the task of the invention to provide an improved device for protecting software against unauthorized use, which makes it "extremely" difficult to analyze the functioning of the data generator on the basis of its inputs and outputs (Sp. 2 lines 36 to 40).

9 2. In the current version as well as in the version of the patent in suit last defended by the defendant, three secondary solutions are proposed for this purpose, which can also be combined with each other. However, since the combination is only optional, it can, as the Patent Court rightly assumed, be disregarded for the examination of patentability.

10 The patent claims 3 to 5 in the last defended version protect a device for protection against unauthorized use of software [M1, in square brackets the structure of the Patent Court] with the following features 1 and 2, to which in each case one of the further features 3 (patent claim 3), 4 (patent claim 4) or 5 (reference back to patent claim 1 in patent claim 5, which is no longer defended as such, as well as a characterizing feature of this claim) is added:

- 1 At least one external data generator (11) is provided [M3], which is
 - 1.1 is connectable to a signal input (13) of a computing system (10) [M2],
 - 1.2 receives data from the computing system and
 - 1.3 outputs data which are dependent on received data from the computing system [M4].
- 2 The computing system is placed in an error state (or the software does not operate appropriately) if the computing system receives no data or incorrect data via the signal input (13) [M5].
- 3 The data generator (11) generates data that has non-deterministically generated redundancy [M6].
- 4 The data generator (11)
 - 4.1 has two states A and B [M7a],
 - 4.2 can be brought from state A to state B only by at least five successive additional states C, which are assumed based on received data [M7b], and
 - 4.3 outputs data that depend on the assumption of states A and B, but not on states C [M7a/c].
- 5 The data generator [11]
 - 5.1 detects (timed) unscheduled data (sequences) as manipulation attempts [M5a],
 - 5.2 changes the contents of one of its memories when a manipulation attempt is detected [M5b],
 - 5.3 as a result, does not output any data or outputs incorrect data when receiving further data or changes a user authorization [M5c],
 - 5.4 has stored data on authorization to use the software, which control access to certain programs or parts of programs, determine the type of computing system, exclude at least one type, or limit or quantitatively control access.

11 3. The technical teaching of the invention requires further explanation in some points:

12 The data generator according to the invention is an external device located outside the computing system, to which it can be connected via a signal input of the computing system. Whether the two devices are in a common housing or are housed separately is not determined by this.

13 The instructions contained in features 3 to 5 are intended to achieve the

aim of the invention, which is to make the output behavior of the data generator as difficult as possible to analyze and thus to prevent unauthorized access to a protected program. For this purpose, only feature 5 requires that the data generator detect "manipulation attempts". The data generator does this by interpreting an unintended input as a "manipulation attempt on the received data" (feature 5.1) and storing that it has detected a manipulation attempt (feature 5.2). According to feature 5.3 this has the consequence that further inputs, even correct ones, do not lead to the release of the program use. In contrast, features 3 and 4 of patent claims 3 and 4 do not deal with the detection of "manipulation attempts" by incorrect inputs, but specify measures which, regardless of whether or not a manipulation attempt has been made, are intended by a certain structure of data generation and output to make it more difficult to determine from the output data the data input required to open access to the protected program.

14 According to feature 3, the data generated by the data generator have redundancy for this purpose in that the information content of the output data is transmitted several times. This corresponds to the general technical meaning of the term "redundancy" in information theory and technology. The fact that in the teaching according to the invention the idea may not be in the foreground to enable a verifiability of the reliability of the data transmission between the data generator and the computing system by means of the redundancy does not justify - contrary to the opinion of the plaintiff - to reduce the redundancy required by feature 3 to the addition of randomly generated data. Neither the description, which does not explain the term redundancy, nor the definition in the English-language Wikipedia to which the plaintiff has referred support such a reading. In particular, even the definition as "number of bits used to transmit a message minus the number of bits of actual information in the message", as the further explanations show, only expresses the basic idea of multiple transmission of the "actual information".

15 The redundancy is non-deterministically generated by associating at least a part of the output data with a random value obtained by interrogating a separate hardware element inside or outside the data processing equipment. This hardware element may be, in particular, a hardware-separate random

number generator or the interrogation of a separate timer not exclusively determined by a predetermined program sequence (Sp. 3 lines 18 to 21).

16 According to feature group 4, the data generator takes (at least) two "states" A and B, in which the output data are generated differently based on the received data. To complicate the analyzability of this relationship, there are five other states between states A and B, states C1 to Cn \geq 5, in which there is no dependence between "the state" of the data generator and the generated data. The "state" of the data generator denotes a defined relationship between data reception and data generation at a particular point of data reception. In states A and B, the received data (error-free or erroneous) determine the data generation, while in states C1 to Cn they do not. Nevertheless, data is also generated in states C1 to Cn. However, the values of this data are not derived from states A, B or C1 to Cn, but have a random, possibly pseudorandom origin. Thus, states C1 to Cn serve to disguise the data generated in states A and B because all data in all states appear to be externally the same. For the change into one of the states C1 to Cn there must be nevertheless a causal relation to the data reception from the computer system.

17 The characteristics 2 and 5.1 leave open whether a manipulation attempt and the error condition in the computer system caused thereupon are already assumed by the data generator with the first not intended data or only with a plurality of such data.

18 The measures described in features 3 to 5 equally have the effect, by different means which can be combined with each other, that the data generator produces data which have a structure which excludes conclusions about the data input required for opening program access or at least makes this considerably more difficult.

19 II. The Patent Court has justified its decision, as far as relevant for the appeal, as follows:

20 Neither, with an exception no longer of interest for the appeal proceedings, does the subject matter of the invention go beyond the content of the original application, nor is the scope of protection of the patent in suit

broadened compared to the granted version of the patent claim. The invention was disclosed so clearly and completely that a skilled person could carry it out. This also applies to the question of how the data generator detects manipulation attempts. It was clear to the skilled person, who was a graduate engineer or computer scientist with experience in the development of authorization procedures for software, that there must be validity rules for the data received by the computer system, non-compliance with which would be evaluated by the data generator as an attempt at manipulation.

21 The patent in suit was not valid either in the version of the main request or in the version of the auxiliary requests I to IV, because the subject matter of claim 4 contained therein had been suggested by the state of the art. The skilled person was familiar with a device with features 1 and 2 from US patent specification 4,747,139 (NK13). NK13 showed a device for protecting software against unauthorized use, which used an external data generator connected to the computer system for this purpose and output data to this system which depended on the data received. Based on this device, the use of a state machine had been obvious, which, depending on the received data, carried out state changes according to feature group 4, in which correct or random data were output depending on the state. Since the state machine of NK13 was described only as an exemplary design, changes, in particular with regard to the number of possible states and the state transitions, did not leave the scope of expert action. The specification that the data generator could only be brought into state B by at least five states C was no more than a professional measure.

22 In contrast, the subject matter according to auxiliary request V (the combination of features 1 to 5.3, the latter limited to the second alternative and supplemented by the addition of "limited in time") was new and based on inventive step. NK13 did not disclose features 5.2 and 5.3. Even if it could be considered obvious to provide own states in the sense of feature group 4 for the output of random data after the receipt of inadmissible input data, this did not result in a change of the contents of a memory in the data generator according to feature 5.2. 2 Above all, however, there is no indication in NK13 that only faulty data is to be output for a limited time on receipt of

impermissible data, i.e. on recognition of a manipulation attempt, on receipt of further data (restricted feature 5.3). For the case of a manipulation attempt, the NK13 only contains the teaching to react exactly once with random, therefore incorrect data, but to output correct data again after the receipt of further, permissible input data. In order to arrive at a further development with feature 5.3, several steps were necessary for the skilled person, for which the NK13 offered neither indications nor suggestions; in particular, the citation contained no indications for a time specification for the output of erroneous data.

23 The further citations were even further away from the subject matter of the patent in suit.

24 III. This essentially does not withstand the defendant's appeal; the plaintiff's appeal proves to be unfounded.

25 1. The Patent Court wrongly considered the subject matter of claim 4 as unpatentable and, on this ground, declared the patent in suit null also to the extent of claims 1 and 3 contained in the first instance auxiliary requests I to IV.

26 a) This is, as the defendant's appeal rightly complains, already legally erroneous because the assumed lack of patentability of the subject matter of claim 4 did not justify declaring the patent in suit null also to the extent of claims 1 and 3. Contrary to the Patent Court's opinion, the Senate's order of 27 June 2007 (X ZB 6/05, BGHZ 173, 47 Informationsübermittlungsverfahren II) on opposition proceedings in particular does not provide a basis for this.

27 aa) However, the Patent Court correctly assumed that the standards developed in this decision are also applicable in patent nullity proceedings. If the patent proprietor requests in opposition proceedings that the patent be maintained to a limited extent with a certain claim set or certain claim sets, this request of the patent proprietor is decisive and generally justifies revocation of the patent if even the subject matter of a claim from the claim set defended by the patent proprietor proves to be unpatentable (BGHZ 173, 47 marginal no. 22 Information Transmittal Proceedings II). The same applies in patent nullity

proceedings. Pursuant to Sec. 64(1) Patent Act, the patent proprietor may limit the patent as he wishes by (admissible) amendments to the patent claims, and he may also obtain the complete revocation of the patent, without it being relevant whether there is a ground for revocation within the meaning of Sec. 21(1) Patent Act. The powers granted to him by Sec. 64(1) Patent Act may also be exercised in patent nullity proceedings; the provisions of Sec. 83(4) and Sec. 116(2) Patent Act are based on this. If a partial or complete declaration of nullity of the patent in suit complies with the patent proprietor's request, it is therefore no longer relevant whether a ground for nullity exists or not.

28 bb) At the same time, however, the Senate also pointed out that when examining the patent proprietor's request - as is always the case - the wording of the patent proprietor's requests must not be taken as a basis, but rather the actual intentions must be determined and the entire submissions of the patent proprietor must be taken into account in order to determine these (BGHZ 173, 47, marginal no. 23, Informationsübermittlungsverfahren II). In particular, if the patent proprietor defends a set of claims containing subordinate claims which are not only in a relationship of secondary order due to different claim categories, but also contain factually different solutions, the assumption that the patent proprietor does not want to defend the remaining claims if the subject matter of only one of these claims proves to be unpatentable or if a claim proves to be inadmissible or not legally valid for other reasons is regularly far-fetched. This would generally be contrary to the patent proprietor's interest in not surrendering more of his property right than is required by the factual and legal situation. If the patent proprietor - as in the case in dispute - has submitted further limited sets of claims for decision in the alternative, it must be clarified as a rule - for example by discussion at the oral proceedings - how these auxiliary requests are to relate to a petition not expressly formulated to comply only in part with a request having formal priority. The Patent Court failed to do this in a procedurally incorrect manner.

29 b) However, the Patent Court cannot be agreed with the assumption that the subject matter of claim 4 is not patentable.

30 aa) Contrary to the plaintiff's view, all features of claim 4 must be

taken into account when examining inventive step. The objection that features 4.2 and 4.3 are non-technical and do not solve a technical problem is already wrong at the outset. According to established case law of both the Federal Court of Justice and the Boards of Appeal of the European Patent Office, the fact that a patent claim contains features relating to the design of a data processing program, the reproduction of information or the application of mathematical methods does not prevent patentability at all or consideration in the examination of inventive step. Rather, for the exclusion to be overcome, it is sufficient that the invention teaches the solution of a technical problem by technical means in the first place, and any feature that determines or at least influences the solution of the technical problem must also be taken into account when examining inventive step (Federal Court of Justice, judgments of 25 August 2015 - X ZR 110/13, GRUR 2015, 1184 marginal no. 18 Unblocking image; of 26 February 2015 - X ZR 37/13, GRUR 2015, 660 marginal no. 35 - Image stream, both with further references). Consequently, it is not important whether features 4.2 and 4.3 are technical in themselves and solve a technical problem, but whether, in the context of the teaching according to the invention, they contribute to solving the problem underlying the latter of making it more difficult to analyze the data output of the data generator.

31 The solution to this problem, as explained, consists in giving the data output by the data generator a certain structure which makes it more difficult to analyze the connection with the data input and which is variously designed in features 3 to 5. This structure is determined precisely by features 3 to 5. This is therefore a technical solvent; the fact that the details are defined (solely) by certain algorithms is irrelevant.

32 bb) The assumption of the Patent Court that the subject matter of claim 4 is suggested by NK13 is not supported by the disclosure content of the citation, as the appeal of the defendant rightly complains. It is undisputed and correctly stated by the Patent Court that NK13 shows feature group 1 and feature 2. Nevertheless, the instructions of features 4.2 and 4.3 are neither disclosed in nor suggested by NK13.

33 In the embodiment example according to Figure 2 referred to by the

Patent Court, there may be several, i.e. also five further states, via which the data generator can reach state B (9) from state A (6). However, the direct transition from A to B is also possible if the appropriate input is made. Feature 4.2 is therefore not shown; the safety measure that at least five further states must always be passed through between states A and B is not realized.

34 The same applies to feature 4.3. In the "C-states" (2 and 3) random numbers are generated (the finite state machine would sense on improper input and would generate some random output). But the data generation is not independent of the input and therefore of the respective state C, as can be seen from the above quotation. Nothing else applies to the initialization phase, which the plaintiff continued to rely on in the appeal proceedings. Consequently, this security measure is also not realized.

35 It is also not shown in what way the citation could suggest these two measures and their combination.

36 2. The judgment under appeal, as far as claim 4 is concerned, is also not correct in its result for other reasons.

37 a) The subject matter of patent claim 4 is also not suggested by the further state of the art cited by the plaintiff, neither in itself nor in combination with NK13. Neither the US patent specification 4 791 565 (NK12) nor the German patent specification 35 26 130 (NK14) disclose feature group 4. The plaintiff does not claim anything to the contrary either.

38 b) The subject matter of patent claim 4 does not go beyond the content of the original application documents.

39 aa) An impermissible extension does not lie in the fact that, according to feature 4.3, the data output in states A and B depends on these states. The dependence of the output data on the state of the data generator in a deterministic manner is the normal case according to feature 1.3. Insofar as the application (disclosure document Sp. 2 lines 52 to 59) mentions that there are these two states as well as a third state C in which the output data should not depend on this state, the skilled person therefore reads in the reverse conclusion that in states A and B the output data should very well

depend on the respective state. To mention this explicitly in the patent claim (feature 4.3) does not constitute an inadmissible extension.

40 bb) The same applies to feature 4.2, insofar as it is stated there that the states C are assumed on the basis of received data. In accordance with the normal case according to feature 1.3, the data generator basically operates on the basis of the data received from the computing system. In this context, the skilled person also understands a change to one of the states A, B and C to mean that this is in each case causally based on the receipt of data. This did not need to be explicitly mentioned in the original application documents.

41 3. Patent claim 3 is also legally valid.

42 a) Its subject matter is not suggested to the skilled person by the state of the art.

43 aa) It is true that NK13 discloses that the data to be output are supplemented with pseudo-random values in order to make an analysis of the correlation between received and output data more difficult (Sp. 3 lines 8 to 13). However, this does not lead to a non-deterministic redundancy in the sense of the patent in suit. Neither are the pseudo-random values generated non-deterministically, because they are obtained exclusively on the basis of a program routine, nor are these random values linked to the data to be output in order to transmit the information content of these data several times and thus to be able to check this transmission.

44 bb) The further citations also do not disclose any redundancy in the sense of feature 3. Furthermore, no indications, suggestions or other aspects are apparent from the general knowledge of the skilled person, which the Patent Court correctly defined, which would indicate a reason to further develop the data output of a data generator corresponding to NK13 towards a redundancy according to feature 3.

45 b) The teaching of patent claim 3 is also executably disclosed.

46 As the Patent Court correctly pointed out, the skilled person was

familiar with constructing a data generator with features 1 and 2. In particular, this was known to him from NK13.

47 Furthermore, the skilled person was familiar with generating a non-deterministic random value by means of a separate random generator. The use of such generators was part of the general expertise of the skilled person.

48 4. In contrast, the patent in suit is null to the extent of claims 5 and 8 to 13, insofar as these are directly or indirectly related to claim 1. This is because the subject matter of patent claim 1, which the defendant no longer defends as such, is not patentable; insofar as patent claims 5 and 8 to 13 further substantiate this subject matter, this also does not lead to a patentable teaching.

49 a) The subject matter of patent claim 1 is not new; it is already disclosed in NK12.

50 The specification describes a software protection device 10, which can be connected by means of a data line between a computer terminal 14 and a central processor 16 of a computer system (NK12, Sp. 2 Z. 31 to 38, Sp. 3 Z. 49 to 53). In response to an authorized request to the program protection device, a response authorizing further program execution is sent to the central processor (Sp. 5 lines 12 to 17). In case of a larger number of unauthorized requests, which is detected by exceeding a threshold value, it is provided that the protected program is blocked in the central computer and must first be released again for use in a certain manner (Sp. 5 lines 19 to 37; Sp. 6 lines 33 to 57).

51 As the Patent Court correctly recognized, this corresponds to feature group 1. This is not contradicted by the fact that, in particular for the description of the embodiments, NK12 refers to a computing system with a mainframe computer and terminals connected thereto. The subject matter of the patent in suit does not contain limitations to computing systems of certain types, nor does it limit the connections between the computing system and the data generator to certain constellations, under which a system with a mainframe computer and terminal units connected thereto would not fall.

52 In addition, NK12 also discloses feature 2 and feature group 5. As explained, it is in accordance with the subject matter of the patent in suit if the reaction to the detection of erroneous data occurs only after a certain number of such data and the computing system is brought into an error state only then. With the blocking of the program in the central computer after a certain number of impermissible queries and the waiting for a release before responses allowing the program to run again are issued, NK12 discloses features 5.1 and 5.3. The waiting for a separate release is - recognizable to the skilled person - inevitably connected with a saving of the detected manipulation attempt and thus a change in the contents of the memory in the data generator (feature 5.2).

53 b) It is neither asserted nor apparent to the Senate that the combination with feature 5.4 or the characterizing features of claims 8 to 13 would result in patentable subject matter. Claims 5 and 8 to 13, insofar as they directly or indirectly refer back to claim 1, are therefore null for lack of patentability of their subject matter.

54 This justifies the declaration of nullity of the patent in suit to the extent of claims 1, 5 and 8 to 13 insofar as claim 1 and claims 5 and 8 to 13 no longer directly or indirectly refer back to claim 1, and the dismissal of the remaining claims.

55 a) It is true that the defendant, both in the requests it formulated in the statement of grounds for appeal and in the requests it made most recently in the oral proceedings, maintained that certain versions of the subordinate patent claims were linked to each other in complete sets of claims. However, according to the principles of claim interpretation described above, it cannot be concluded that the defendant only wants to submit the complete set of claims for decision under all circumstances.

56 b) With the last main request filed after discussion of an appropriate version of the request, the defendant no longer defended patent claim 1 as such, but maintained the reference to patent claim 1 in patent claim 5 (and the further challenged subclaims). With this and with auxiliary request VI, which it finally submitted for decision, it expressed that it primarily attaches importance

to the dismissal of the action to the extent of patent claims 3 and 4 and especially to the extent of patent claim 4; in the version of auxiliary request VI, only the subject matter of patent claim 4 is further specified and limited, while the other patent claims are dropped. It would be inconsistent with this recognizable legal protection objective if the Senate did not find in accordance with the defendant's main request to the extent of patent claims 3 and 4, which prove to be legally valid.

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

Meier-Beck

Grabinski

Hoffmann

Schuster

Deichfuß

Previous instance:

Federal Patent Court, judgment of 23 January 2014 – 2 Ni 19/12 –