

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2015-10-13
Docket Number / Aktenzeichen:	X ZR 74/14
Name of Decision / Name der Entscheidung:	Luftkappensystem

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# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 74/14

Pronounced on:  
October 13, 2015  
Wermes  
Judicial Secretary as  
Clerk of the court  
registry

in the matter

Luftkappensystem/  
Air cap system

Patent Act Sec. 14; EPC Art. 69

If two measures differing only in degree (here: blocking and restricting of an air flow) are named in a patent specification without further differentiation as the starting point for a difficulty occurring in the state of the art, it cannot be concluded without further ado from the fact that only the stronger-acting measure (here: blocking) is mentioned in the patent claim, that the weaker-acting measure is not sufficient to realize the protected teaching.

Federal Court of Justice, judgment of October 13, 2015 – X ZR 74/14 –  
Higher Regional Court of Karlsruhe  
Regional Court of Mannheim

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on October 13, 2015, attended by the judges Gröning, Dr. Bacher and Hoffmann, the judges Schuster and Dr. Deichfuß

ruled that

On appeal on points of law by the plaintiff, the judgment of the 6<sup>th</sup> Civil Senate of the Higher Regional Court of Karlsruhe pronounced on June 25, 2014 is set aside.

The matter is referred back to the Court of Appeal for a new hearing and decision, including on the costs of the proceedings on appeal on points of law.

By operation of law

Facts of the case:

1 The plaintiff, as the proprietor of an exclusive license, asserts claims against the defendants for infringement of European patent 596 939 (patent-in-suit), which relates to an air cap system for a paint spray gun and expired on 8 July 2012, due to expiration of the term of protection. Patent claim 1 reads in the language of the proceedings:

An air cap system for a paint spray gun comprising:

- (a) an air cap (10) including:
  - (1) a central passage (36) coaxially aligned with a central longitudinal axis of the air cap,
  - (2) at least one paint spray shaping passage (46, 47) in the air cap configured and arranged for directing a flow of pressurized air against a stream of atomized paint discharged from the central passage (36) so as to alter the shape of the paint spray, and
  - (3) at least one venting passage configured and arranged so as to be ineffective for directing a flow of pressurized air against a stream of atomized paint discharged from the central passage so as to alter the shape of the paint spray, and
- (b) a blocking means effective for blocking air flow through the paint shaping passage while permitting air flow through the venting passage when in a first position and permitting air flow through the paint shaping passage while blocking air flow through the venting passage when in a second position;

characterized in that

- (c) at least one venting passage (54) is located in the air cap (10);
- (d) the blocking means (18) is operable for directing air flow between the paint shaping passage (46, 47) and the venting passage (54) independently of the flow of a fluid through the central passage (36).

2 Defendants 2 and 3 offer for sale in Germany a paint spraying system, which they obtain from defendant 1. The plaintiff has argued that all the features of claim 1 of the patent in suit are literally realized in this system, or at least by equivalent means.

- 3           After the patent in suit had lapsed, the Regional Court finally dismissed the action seeking an accounting, destruction, recall, removal from the distribution channels, reimbursement of pre-litigation attorney's fees and a declaration of liability for damages. The Court of Appeal dismissed the plaintiff's appeal. The plaintiff has appealed against this decision in an appeal on points of law allowed by the Senate, which the defendants oppose.

Grounds of the decision:

4 The appeal on points of law is successful.

5 I. The patent in suit relates to an air cap for a paint spray gun.

6 According to the statements in the patent specification, paint spray guns were known in the state of the art in which the paint is sprayed by supplying air with high volume and low pressure (HVLP) and which, in addition to a central channel for the paint, have additional air channels with which the shape of the paint spray jet can be influenced. Known were also embodiments with a rotatable blocking plate, which, depending on its position, closes off individual or all of these forming channels so that a horizontal, vertical or round spray shape can be created as desired.

7 The patent in suit states that in portable blower devices, it has been found desirable to reduce back pressure. In particular, it has been observed that the blower motor spins too fast or overheats when the outlet of the air source is blocked or restricted. The patent in suit concerns the technical problem of providing a paint spraying system in which less load is placed on the motor.

8 To solve this problem, the patent in suit proposes an air cap system for a paint spray gun, the features of which are as follows:

- (a) The system includes an air cap (10) having.
  - (1) a central channel (36) coaxially aligned with the central longitudinal axis of the air cap,
  - (2) at least one shaping channel (46, 47) constructed and arranged to direct a stream of pressurized air against a stream of atomized paint discharged from the central channel (36), thereby changing the shape of the paint spray stream
  - (3) at least one vent channel constructed and arranged so as not to produce the effect referred to in (2).
- (b) The system comprises a blocking device
  - (1) for blocking the flow of air through the mold channel upon release of the flow of air through the vent

- channel in a first position; and
- (2) for unblocking air flow through the mold channel upon blocking air flow through the vent channel in a second position.
  - (c) At least one vent channel (54) is disposed in the air cap (10).
  - (d) The blocking device (18) is adapted to redirect air flow between the mold channel (46, 47) and the vent channel (54) regardless of whether a fluid is flowing through the central channel (36).

9           II.     The Court of Appeal gave the following main reasons for its decision:

10           Feature (b)(2), which is the sole feature in dispute, is neither literally realized nor realized by equivalent means. In the challenged embodiment, air escapes to a small extent through at least two of the total of four venting channels even if the system is set in such a way that a vertical or horizontal specification of paint can take place. Thus, there was no blocking of the air flow within the meaning of the said feature.

11           According to the general sense of the word, "blocking" means that a certain path is closed off, sealed off, i.e. closed. The patent specification offered no indication that the term had a different meaning according to the invention. In the description of the state of the art, a distinction is made between blocking and restricting. Patent claim 1 requires blocking. In the further description, the pair of opposites is always formed, that the air flow is permitted or allowed in one position, but is blocked in another position. No indication for a different understanding could be inferred from the embodiment examples. Feature (d) also gives a clear indication that the air flow is diverted "between" the mold channel and the vent channel, i.e. that a channel for the air flow should be either free or closed. No passage in the patent specification suggests that any particular degree of restriction of the air outlet should be sufficient. Moreover, if it were sufficient for blocking that the air flow could not influence the paint spray pattern, feature (a)(3) would not have any independent meaning.

12           Feature (b)(2) further requires that all existing vent channels be blocked in the manner stated when air flow through a mold channel is unblocked. According to the patent specification, it is necessary to prevent the air escaping from the vent channels from coming into conflict with the paint spray pattern. It must therefore be concluded that the air flow should escape either through the mold channel or through the vent channel. The vent channel only serves to prevent a backflow when the mold channel is closed. This means that it must be closed when the mold channel is open. This applies to all existing vent channels.

13           Realization by equivalent means was to be denied, if only because there was no replacement means. In any case, however, a skilled person would not consider the solution of the challenged embodiment as equivalent when orienting himself to the meaning of the patent in suit, because the patent in suit precisely provides for an embodiment in which the vent channels are blocked in the situation in question, thus leading the skilled person away from a solution in which air can escape.

14           III.     This assessment does not stand up to review under the law of appeals on points of law.

15           1.     The Court of Appeal erred in law in concluding that an air duct is blocked within the meaning of characteristic (b)(2) only if air entry is completely prevented.

16           According to the established case law of the Senate, it is not the linguistic or logical-scientific meaning of the terms used in the patent claim that is decisive for the interpretation of a patent, but their technical meaning, which is to be determined taking into account the task and solution as they objectively result from the patent (see only Federal Court of Justice, judgment of November 12, 1974 – X ZR 76/68, GRUR 1975, 422, 424 – *Streckwalze*; judgment of March 2, 1999 – X ZR 85/96, GRUR 1999, 909, 912 – *Spannschraube*). The decisive factors are the meaning of a patent claim in its entirety and the contribution of the individual features to the performance result of the patented invention (see only Federal Court of Justice, judgment of April 17, 2007 X ZR 72/05, BGHZ 172, 88 = GRUR 2007, 778 marginal no. 14 – *Ziehmaschinenzugeinheit I*). From

the function of the individual features in the context of the patent claim it must be deduced which technical problem these features actually solve individually and in their entirety (see only Federal Court of Justice, judgment of July 17, 2012 – X ZR 113/11, GRUR 2012, 1122 marginal no. 22 – *Palettenbehälter III*).

17           2.     In interpreting feature (b)(2), the Court of Appeal assumed a general literal meaning, for the determination of which it relied on the linguistic meaning. This is not objectionable in principle. From this starting point, however, the Court of Appeal essentially only dealt with the question of whether the patent specification provides indications for a different understanding. This approach is in conflict with the principles outlined above.

18           a)     Both the term "block" and the terms "shut off", "seal" and "close" cited as synonyms by the Court of Appeal may often suggest in the context of an air flow that any possibility of passage is to be prevented. The Court of Appeals implicitly concluded from this for the teaching of the patent in suit that it is not sufficient if the airflow is only partially prevented. In doing so, it neglected to examine whether this result of interpretation is compatible with the relevant technical meaning of the feature in the context of the solution of the problem posed. The Court of Appeal should have addressed the question of whether feature (b)(2) requires complete blocking or whether partial blocking can suffice. The latter is the case.

19           a)     It is clear from the description that partial blocking of the air flow is sufficient, provided that the effect intended by the invention is thereby achieved.

20           In the description of the state of the art, the terms "blocked" and "restricted" are used side by side in the patent specifications (column 1 line 19: blocked or restricted). In this context, however, the two terms are not more closely distinguished from each other. Rather, both a blocking and a restricting of the air flow are named as the cause of the disadvantageous effects, the prevention of which is the subject of the patent in suit.

21           In the further description of the patent in suit, only the term "block" is used. However, also in this context there is no indication that the distinction between "block" and "restricting" is of decisive importance. Therefore, from the

fact that only the former of the two terms is subsequently mentioned, the conclusion cannot be drawn that the patent in suit deals only with the prevention of disadvantages caused by completely blocking the flow of air. Rather, it is clear from the task of the patent in suit and the function of the features provided in claim 1 that it is a matter of ensuring, irrespective of the setting selected in each case, an air flow which, on the one hand, leads to the desired shape of the paint spray jet and, on the other hand, is sufficient to prevent excessive loading of the blower motor. The patent specification contains no indication that these purposes are to be pursued only by completely blocking the vent channels in particular in each case. The linguistically imperfectly chosen term "blocking" characterizes in this respect rather the general mechanism of action of the change between the different settings according to the patent in suit, but not the degree of blocking.

22           Based on this, the patent claim is to be interpreted to the effect that complete blocking of the air flows is not required either for feature (b)(1) or for feature (b)(2). Rather, it is sufficient if the air flow through the respective channel is prevented in a manner that enables the achievement of the stated objective.

23           b)     Contrary to the opinion of the Court of Appeal, no deviating conclusions result from feature (a)(3).

24           The design provided for in feature (a)(3) prevents the air stream passing through the vent channel from acting on the air stream exiting the central channel and changing the shape of the paint spray jet. This is achieved by the vent channel being suitably formed and arranged. In the embodiment described in the description of the patent in suit, the venting channel is arranged for this purpose in such a way that it extends radially outward in such a way that the escaping air moves away from the paint spray jet (column 3, lines 48 to 56).

25           Contrary to the opinion of the Court of Appeal, the blocking of the air flow in the vent duct provided for in feature (b)(2) is not necessary, on the other hand, to fulfill the function mentioned. It is also not suitable for this purpose, because it does not exclude the patent in suit, but provides precisely as a rule that the air flow through the central duct and the air flow through the vent duct are released at the same time.

26           3.       The opinion of the Court of Appeal that the requirement formulated in feature (b)(2) refers to all vent ducts belonging to the air cap system is also not able to support the contested decision.

27           Feature (b)(2) is realized in the challenged embodiment even if the requirements formulated therein would apply to all vent ducts. For the reasons explained above, this feature only requires that the vent channel is at least partially blocked as long as a corresponding mold channel is unblocked. This requirement is fulfilled in the challenged embodiment with respect to all vent channels. In view of this, it can be left open whether it would already be sufficient for the realization of feature (b)(2) if only some of the existing vent channels satisfy the requirements defined therein.

28 IV. The matter is not ready for final decision (Sec. 563(3) Code of Civil Procedure).

29 According to the findings of fact of the Court of Appeal, the defendants have denied that the plaintiff has been validly granted a license to the patent in suit. The Court of Appeal did not deal with this question – logically from its point of view. It will have to clarify it in the reopened appeal instance.

30 The *Formstein* objection raised by the defendants, on the other hand, is not relevant to the decision. This objection is only relevant in the case of patent infringement by equivalent means (Federal Court of Justice, judgment of April 29, 1986 X ZR 28/85, BGHZ 98, 12, 21 et seq. = GRUR 1986, 803, 805 et seq. – *Formstein*). In the case in dispute, however, the features of patent claim 1 are infringed literally.

Gröning

Bacher

Hoffmann

Schuster

Deichfuß

Previous instances:

Regional Court of Mannheim, judgment of August 17, 2012 – 2 O 33/12 –

Higher Regional Court of Karlsruhe, judgment of June 25, 2014 – 6 U 92/12 –