

## Deckblatt Übersetzung

### Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-08-23
Docket Number / Aktenzeichen:	X ZR 76/14
Name of Decision / Name der Entscheidung:	V-förmige Führungsanordnung

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



# FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 76/14

Pronounced on:  
23 August 2016  
Hartmann  
Judicial Secretary as  
Clerk of the court  
registry

in the matter

V-förmige Führungsanordnung/  
V-shaped guide formation

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

The orientation of the considerations of the skilled person, with which he can find an exchange means having the same effect in the sense of the feature of the invention as having the same effect, to the patent claim and thus the infringement of the patent with equivalent means cannot regularly be denied on the grounds that the patent proprietor, with the concrete formulation of the feature, has committed himself to a design corresponding to its literal sense.

Federal Court of Justice, judgment of 23 August 2016 - X ZR 76/14 –  
Higher Regional Court of Düsseldorf  
Regional Court of Düsseldorf

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 23 August 2016, attended by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski, Hoffmann and the judge Dr. Kober-Dehm

ruled that:

On appeal by the plaintiff, the judgment of the 15th Civil Senate of the Düsseldorf Higher Regional Court of July 8, 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 appeal.

By operation of law

Facts of the case:

1           The plaintiff is the proprietor of European patent 1 259 105 (patent in suit), which was granted with effect for the Federal Republic of Germany, was filed on 31 January 2001, claiming the priority of two British patent applications dated 4 February and 31 May 2000, and relates to a replaceable wear part for mounting on a front edge of a working tool.

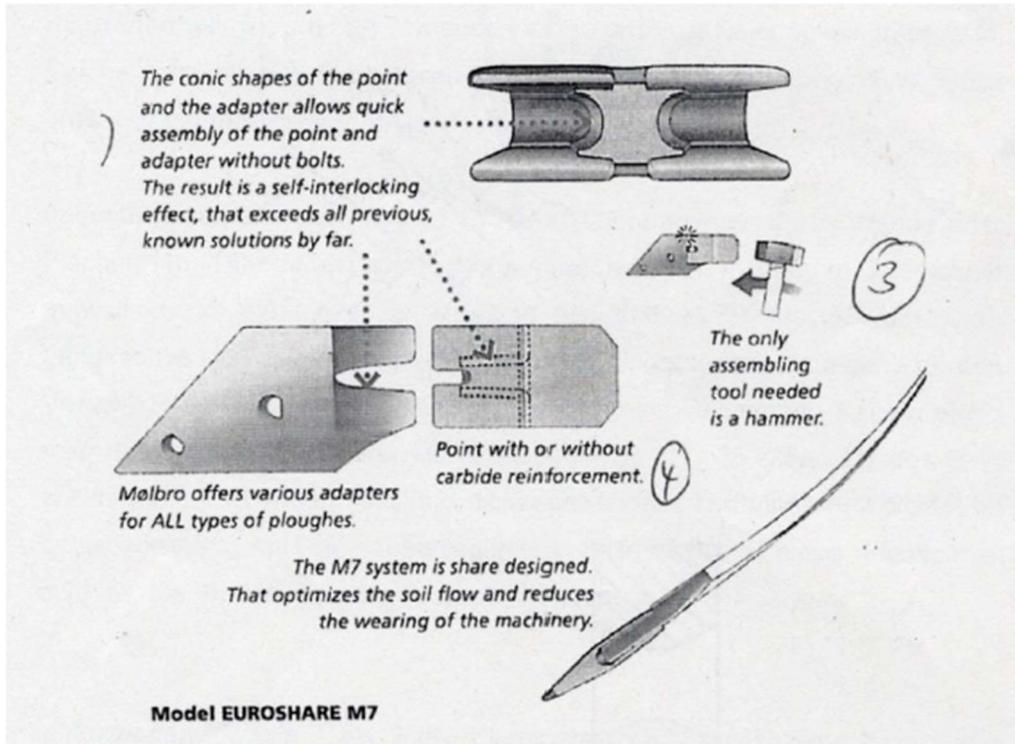
2           Claim 1 is worded as follows in the language of the patent-in-suit as amended in the opposition proceedings:

"A replaceable wear part (13, 22, 22a, 32, 41) for mounting on a leading edge (12, 27) of a working tool (10, 27, 30), said leading edge and said wear part having co-operative guide formations (16, 18) extending generally perpendicular to the leading edge and which provide a socket and projection type of slidable inter-fit and allow the wear part to slide in a direction generally perpendicular to the leading edge, and are arranged to exert a wedging action on the wear part so that the greater the distance travelled, the stronger will be the frictional engagement forces acting between the guide formations, whereby the wear part can be driven by a force extending generally perpendicular to the leading edge in order to take up a working position in which it is secured against displacement from the working position by frictional inter-engagement between the guide formations (16, 18) on the wear part and the leading edge, and without need for threaded or other separate removable fasteners, said co-operative guide formations (16, 18) allowing the wear part (13) to slide in a direction generally perpendicular to the leading edge (12), and providing a wedge-type inter-engagement between the guide formations (16, 18) such that the greater the distance travelled, the stronger will be the frictional engagement forces acting between the guide formations:  
characterised in that the guide formations are defined by

walls or faces (16, 18) which are each of matching V-shape in cross section to oppose relative rotation of the wear part (13) about its longitudinal axis (19), the guide formations (18) of the wear part (13, 22, 22a, 32, 41) are provided on opposed edges of a rearwardly-projecting mounting portion (17, 25, 25a, 32) of the wear part, and the guide formations (16) of the working tool are provided on opposed side walls of a socket portion of the working tool."

- 3 The defendant offers in the Federal Republic of Germany under the designation "Euroshare M7" exchangeable wear parts for agricultural machinery (impugned embodiment). They are mounted on a supplied adapter, which in turn is attached to the working tool with bolts. Their design and mode of operation can be seen from the accompanying photographs and the following illustration from a brochure of the defendant.





4 The plaintiff filed a claim against the defendant for direct infringement of the patent in suit for injunctive relief, information, rendering of accounts and a declaration of the obligation to pay damages. The Regional Court dismissed the action. The appeal filed against this decision was unsuccessful. In the appeal allowed by the Senate, which the defendant opposes, the plaintiff continues to pursue its claims on appeal.

Grounds of the decision:

5           The admissible appeal leads to the reversal of the judgment of the Court of Appeal and to the remittal of the case to the Court of Appeal.

6           I.       The patent in suit relates to a replaceable wear part for mounting on the front edge of a working tool used, for example, as a plow for soil cultivation.

7           According to the patent specification of the patent in suit, such wear parts are conventionally mounted on the tool by two screws. Such a connection is sufficiently stable to withstand all twisting, rotational movements or other forces occurring during use (para. 6), but has the disadvantage that replacement of the wear parts, for example in the field, can be time-consuming and difficult, especially if the fasteners are difficult to loosen because of damage, rust or the like (para. 7).

8           In order to simplify assembly and disassembly, it is known to provide only one fastener. This requires a suitably shaped bearing surface which locks the wear parts against rotation about the axis of the individual fastener (para. 10). As an example of this, the description cites a wear part with a narrow protruding boss that is received by a recess in the main body of a tine cutter to resist rotation about the axis of the fastener. This design relied on the strength of the narrow projection, but in use it was subjected to concentrated forces that could cause premature failure.

9           Accordingly, the problem underlying the invention can be formulated - without considering possible solutions - as providing an arrangement of replaceable wear parts which are reliably secured against displacement from the working position in a simple and quickly mountable manner (cf. para. 13).

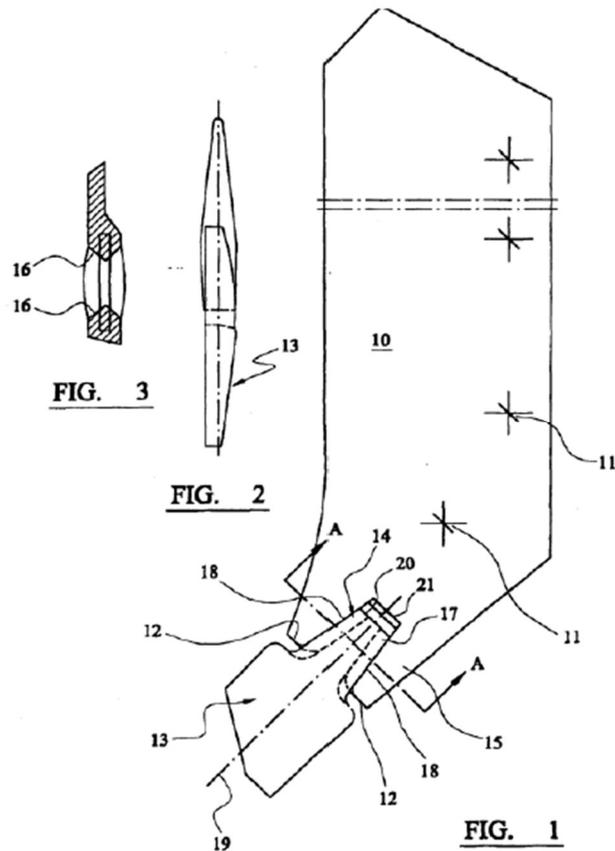
10          According to patent claim 1, this is to be achieved by an arrangement with the following features [in square brackets the outline of the Court of Appeal]:

1           The replaceable wear part (13) is suitable for mounting on a leading edge (12) of a working tool (10) [1].

- 2 The front edge (12) and the wear part (13) have cooperating guide arrangements (16, 18), of which
  - 2.1 the guide arrangements (18) of the wear part (13) are formed on opposite edges of a rearwardly projecting mounting portion (17) of the wear part [7], and
  - 2.2 the guide arrangements (16) of the working tool (10) are formed on opposite edges of a receiving portion (14) of the working tool [8].
- 3 The cooperating guide arrangements (16, 18)
  - 3.1 extend generally perpendicular to the leading edge (12) [2].
  - 3.2 provide a slidable receiving projection fit and allow the wear part (13), without the need for screws or other separately removable fasteners, to slide in a direction generally perpendicular to the leading edge (12) [from 3 and 5] and to be propelled by a force extending generally perpendicular to the leading edge to assume a working position in which it is secured against displacement from the working position by frictional engagement between the guide arrangements [4],
  - 3.3 permit a wedge-like engagement of the wear part (13) [in the working tool], so that the frictional forces acting between the guide arrangements (16, 18) are stronger the greater the distance covered [from 3 and 5] and
  - 3.4 are defined by means of walls or surfaces

which are each of matching V-shape in cross-section, in order to counteract relative rotation of the wear part (13) about its longitudinal axis (19) [6].

- 11           According to the description, a replaceable wear part according to the invention can be driven into the working position, for example with a hammer, while sliding in a direction generally perpendicular to the leading edge due to the cooperating guide arrangements. The guide arrangements are designed to permit wedge-like engagement of the wear part, as a result of which the frictional forces between the guide arrangements become stronger the further the distance covered (features 3.2 and 3.3). A screw fastening or the like is thus dispensed with. To counteract rotation of the wear part relative to the leading edge about its longitudinal axis, the walls and surfaces defining the cross-sectional shape of the guide arrangements each have a V-shape adapted to one another (feature 3.4; par. 19).
- 12           The drawings reproduced below are taken from the patent application and show an example of an embodiment according to the invention:



13            II.        The Court of Appeal substantiated its decision essentially as follows:

14            The challenged embodiment does not make use of feature 3.4 [6] in the literal sense because the cross-section of the guide arrangements is U-shaped and not V-shaped.

15            However, the teaching of claim 1 is also not realized in a patent-law equivalent manner. The design of the challenged embodiment with semicircular or U-shaped guide arrangements is in any case not equivalent. It may well be that a U-shape also achieves the performance result of the patent-protected teaching, because a rotation of the wear part about its longitudinal axis can also be effectively prevented with this. However, the patent specification in suit does not guide the skilled person to such a design, because it precisely specifies the V-shape. If any geometric shape of the guide arrangement that could ensure interlocking to prevent rotation were to be regarded as equivalent use, the design taught by the patent in suit would no longer have any independent

meaning. The fact that the patent proprietor had deliberately determined this design is apparent from a systematic interpretation of claim 1, taking into account the other features of the claim. For with regard to the shape of the guide arrangements of the wear part in their spatial arrangement to each other - i.e. whether this is rectangular, trapezoidal or otherwise configured - the claim, in contrast to the configuration of the cross-section of the guide arrangements, does not specify. This speaks in favor of understanding the specification of the V-shape as a deliberate selection decision. Moreover, due to its arcuate course, a U-shape is also qualitatively less suitable than a V-shape for preventing rotation about the longitudinal axis of the wear part.

16           The fact that the patent proprietor had made a deliberate selection decision in favor of the V-shape also became apparent when the B2 specification, which had been amended compared to the original patent specification due to the limitation of the patent in the opposition proceedings, was additionally interpreted in the granted version of the patent (B1 specification). The requirement of legal certainty and the fact that the content of the relevant amended version can only be determined on the basis of such a comparison speak in favor of taking it into account when interpreting the amended patent. The granted version of the patent was also part of the interpretative material covered by Art. 69 EPC, since, unlike the grant documents, it had been accessible to the public, which had thus been able to adjust to its content. It had been recognizable from paragraph 19 of the description in the version of the B1 specification in conjunction with the claim wording of patent claim 1 that the patent proprietor had decided against other cross-sectional shapes of the guide arrangement than the V-shape in the sense of an explicit selection decision, since it had additionally been pointed out there that cross-sectional shapes other than the V-shape could also be used to counteract rotations about the longitudinal axis of the wear part. If only the V-shape was expressly included in patent claim 1, the skilled person would understand this as a specification of only such a shape.

17           III.     This assessment does not withstand review by the Court of Appeal.

18           1.     The Court of Appeal left open whether the challenged embodiment

with the cross-sectional shape of the guide arrangements described in the appeal judgment as semicircular or U-shaped counteracts a rotation of the wear part relative to the front edge of the working tool about its longitudinal axis and therefore - at least in principle - achieves the effect which is to be achieved according to the invention with the V-shape specified in feature 3.4. Furthermore, it left open whether the skilled person could find such a design without inventive effort as having the same effect in this sense. For the review under the law of revision, this must therefore be assumed in favor of the plaintiff.

19           2.       Accordingly, an infringement of the patent in suit can only be denied if the considerations of the skilled person, with which he would be able to recognize this embodiment as having the same effect, would not be oriented to the sense (meaning) of the technical teaching described in the patent claim and, consequently, this embodiment could not be regarded as equivalent from the point of view of a skilled person (Federal Court of Justice, judgment of 12 March 2002- X ZR 168/00, BGHZ 150, 149, 154 - Schneidmesser I; Urteil vom 14 December 2010 - X ZR 193/03, GRUR 2011, 313 Rn. 35 - Crimpwerkzeug IV; judgment of 13 January 2015 - X ZR 81/13, GRUR 2015, 361 Rn. 18 - Kochgefäß). This was assumed by the Court of Appeal; however, its reasoning given for this is not free of legal errors.

20           a)       The Court of Appeal chose an abstract comparison of geometric shapes as the starting point for its considerations and contrasted the V-shape mentioned in feature 3.4 with a U-shape as an "other" geometric shape. This is in any case not unobjectionable, since the formation of a pair of opposites between a V-shape and a U-shape is not intended in the patent in suit. A U-shaped cross-section is not mentioned anywhere in the patent claim or in the description. Decisive for the assessment of the question whether the consideration of the skilled person that he could achieve the effect of the cross-sectional shape of the cooperating guide arrangements taught by feature 3.4 also with the embodiment of the challenged embodiment described as U-shaped is oriented to the patent claim must not be a categorical comparison of different geometrical shapes. Rather, what matters is what the skilled person is able to infer from feature 3.4, taken in isolation and in connection with the teaching according to the invention, about a technically possible variation of the

cross-sectional shape of the guide arrangements that can no longer be understood as V-shaped. For the assessment of the question whether the considerations of the skilled person, which allow him to replace a feature according to the wording by a modified means, but which has the same effect in the context of the technical teaching of the patent, are oriented to the patent claim, in case of doubt it is less the spatial-physical design of the means as such than their function in the context of the teaching according to the patent which is important.

21           b)     This leads to the central argument of the Court of Appeal that the patent proprietor, by including the V-shape in the patent claim, (deliberately) specified or limited itself precisely to this shape of the cross-section of the guide arrangements. Thus, the exclusion of the design of the cross-section of the guide arrangements realized by the challenged embodiment from the scope of protection of the patent in suit cannot be justified.

22           aa)    The appeal rightly complains that this reasoning ultimately amounts to excluding equivalent embodiments (similar to the foreseeable equivalents of U.S. patent law) from the scope of protection whenever the patent proprietor recognized (or could have recognized) that substitute means are conceivable for a solution element named in the claim and failed to work towards a version of the patent in which the substitute means would have been encompassed by the literal meaning of the patent claim. This finds no basis in the case law of the Federal Court of Justice and cannot be justified on the merits.

23           By concretizing a certain element of the teaching according to the invention in a certain way, as was done in the dispute with the characterization of the cross-section of the guide arrangements as V-shaped, the patent proprietor always "commits" himself to a technical embodiment which corresponds to the literal sense of this concretization. Such a "determination" neither positively nor negatively determines the question whether, from the point of view of a skilled person, means of replacement having the same effect are equivalent.

24           bb)    This is not changed by the consideration of the Court of Appeal that neither the patent claim nor the description make a statement as to what

shape the guide arrangements must have in relation to each other in order for them to interlock in a wedge-like manner (feature 3. 3), the receiving and mounting sections could also be trapezoidal or rounded at their respective ends, and in contrast to this, the patent claim expressly specifies the V-shape for the cross-section of the guide arrangements and thus teaches that of the various cross-sectional shapes conceivable in principle, only this one is provided in order to prevent a rotational movement of the wear part about its own longitudinal axis under the action of the considerable forces to be expected. For it results from this at most that the technical teaching of the invention may be more concretized with respect to the cross-sectional shape of the guide arrangements than with respect to the manner of their wedge-shaped interlocking. This stronger concretization may also have an effect on the determination of the type and extent of possible equivalent means. However, it does not in itself justify an exclusion of all or certain means of substitution from the scope of protection of the patent in suit.

25           cc)     Finally, the Court of Appeal's consideration that a skilled person would recognize that the U-shape, because of its rounded, arcuate course without corners and edges, would be more likely to permit rotary movements of the wear part about its own longitudinal axis than the V-shape, which exerts a greater wedge effect due to a pointed or angular apex region, is also not sustainable. On the one hand, these statements contradict the assumption of the Court of Appeal that the skilled person recognizes that the rotational forces acting on the wear part about its longitudinal axis can also be countered by a U-shape as an alternative to the V-shape. Moreover, this consideration - which concerns the question expressly left open by the Court of Appeal at another point as to whether the design of the guide arrangements having a U-shape in cross-section in the challenged embodiment has the same objective effect - is again a quasi-abstract consideration of a U-shape without concrete reference to its appearance and mode of action in the guide arrangements of the challenged embodiment.

26           c)     Contrary to the opinion of the Court of Appeal, an infringement of the patent in suit by equivalent means cannot be denied by invoking the principles developed by the Federal Court of Justice on selection decisions.

- 27           aa) For cases in which the patent claim is based on a selection decision between different possibilities, the Senate has concretized the requirement of orientation to the patent claim to the effect that the technical considerations of possible variations must also be in line with this selection decision. Therefore, a patent infringement by equivalent means is generally to be denied if the description discloses several possibilities of how a certain technical effect can be achieved, but only one of these possibilities has been included in the patent claim (Federal Court of Justice, judgment of 10 May 2011 - X ZR 16/09, BGHZ 189, 330 marginal no. 36 - Okklusionsvorrichtung; judgment of 13 September 2011 - X ZR 69/10, GRUR 2012, 45 marginal no. 44 - Diglycidverbindung).
- 28           bb) These requirements are not met in the case in dispute. The description of the patent in suit does not disclose that the guide arrangements, which are defined by walls or surfaces and are intended to counteract a relative rotation of the wear part about its longitudinal axis, can be designed in cross-section not only V-shaped but also U-shaped. On the contrary, the description mentions and shows exclusively a V-shaped configuration of the same (paras. 19, 41, 44; Figure 1). Therefore, the V-shaped design of the guide arrangements prescribed in feature 3.4 of patent claim 1 cannot be attributed to a selection from several possibilities of design disclosed in the description.
- 29           cc) The Court of Appeal did not misjudge this, but thought that a selection decision in favor of an (exclusively) V-shaped design of the guide arrangements had to be assumed because, although not in the valid version of the patent in suit, but in the granted version, paragraph 19 of the description also referred to possible other cross-sectional shapes ("The walls or faces defining the guide formations may be of matching V-shape in cross section, although other cross sectional shapes may be provided ..."). This cannot be accepted either.
- 30           It can be left open whether the content of the description in an earlier version of the patent can be used at all to interpret the patent claim and to determine its scope of protection, in particular in the present constellation, in which - as the Court of Appeal believes - this is not intended to take account of a limitation of the patent, but is required in order to counter an inadmissible

extension of the scope of protection by interpreting the patent in suit in the light of a description amended in the opposition proceedings.

31 For in the earlier version of the description, with the reference to other possible cross-sectional shapes, a U-shaped design is likewise not disclosed. Rather, the original version of the description of the patent in suit also discloses only the V-shape as a preferred design of the cross-section of the guide arrangements. In such a constellation, the inclusion of equivalents to the disclosed embodiment is regularly not excluded (see Federal Court of Justice, judgment of 14 June 2016 - X ZR 29/15, GRUR 2016, 921 marginal no. 53-61 - Pemetrexed [intended for BGHZ]). Points of view from which it could result that the focus on the V-shape in the patent claim is nevertheless based on a selection that excludes the inclusion of similar cross-sectional shapes of the guide arrangements in the scope of protection (see Federal Court of Justice, juris, paras. 62-68 - Pemetrexed) are neither established nor discernible for the Senate.

32 IV. Accordingly, the case must be referred back to the Court of Appeal for a new hearing and decision, including on the costs of the appeal.

Meier-Beck

Gröning

Grabinski

Hoffmann

Kober-Dehm

Previous instances:

Regional Court of Düsseldorf, judgment of 13 August 2013 – 4a O 23/12 –

Higher Regional Court of Düsseldorf, judgment of 8 July 2014 – I-15 U 29/14 –