

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-10-05
Docket Number / Aktenzeichen:	X ZR 78/14
Name of Decision / Name der Entscheidung:	Opto-Bauelement





FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 78/14

Pronounced on:
05 October 2016
Hartmann
Judicial Secretary as
Clerk of the court
registry

in the patent nullity proceedings

Opto-Bauelement/
Opto-component

EPC Art. 76(1) sentence 2; Implementing Regulations to the Convention on the Grant of European Patents Rule 22; German Act on International Patent Conventions Art. II Sec. 6(1)

The fact that a divisional application filed by the substantive right holder was formally defective does not preclude the granting of the seniority provided for in Art. 76(1) sentence 2 EPC in nullity proceedings, at least if the defect was remedied at a later date and a divisional application was still admissible at that date.

EPC Art. 56; Patent Act Sec. 4

- a) The choice of a certain citation or prior use as a starting point for the solution of a technical problem generally requires justification (confirmation of Federal Court of Justice, judgment of 16 December 2008 - X ZR 89/07, BGHZ 179, 168 = GRUR 2009, 382 marginal no. 51 - Olanzapin; judgment of 18 June 2009 - Xa ZR 138/05, GRUR 2009, 1039 marginal no. 20 Fischbissanzeiger).
- b) For the assessment of the question whether a certain starting point was obvious to the skilled person, it is generally irrelevant whether other starting points could possibly be considered as even more obvious.

Patent Act Sec. 117; Code of Civil Procedure Sec. 531(2) sentence 1 No. 3

An indication by the Patent Court under Sec. 83(1) Patent Act that a feature provided for in a subclaim is not likely to be known from the documents submitted regularly gives the nullity plaintiff cause to show the reasons for which patentability is to be denied for the subject matter of this subclaim.

Federal Court of Justice, judgment of 05 October 2016 - X ZR 78/14-

Federal Patent Court

The X. Civil Senate of the Federal Court of Justice, following the oral hearing on 5 October 2016, attended by the presiding judge Prof. Dr. Meier-Beck and the judges Dr. Grabinski, Dr. Bacher, Hoffmann and Dr. Deichfuß

ruled that:

The appeals of the parties against the judgment of the 2nd Senate (Nullity Senate) of the Federal Patent Court of 5 August 2014 are dismissed with the proviso that the costs of the legal dispute for both instances are set aside against each other.

By operation of law

Facts of the case:

1 The plaintiff is the proprietor of European patent 1 022 787 (patent in suit), which was granted with effect for the Federal Republic of Germany, is based on a parent application of 31 May 1989, and relates to a surface-mountable opto-component and a process for its manufacture. Patent claim 1, to which five further claims are referred back, reads as granted:

Method of manufacturing a surface-mountable opto-component in which

- a base body (1) having a front side and a rear side and having a recess (5) starting from the front side is formed on a lead frame by means of plastic encapsulation, and subsequently an optical transmitter or receiver (8) is arranged in the recess (5) and connected to an electrical terminal (6) of the lead frame by means of a bond-wire connection,
- the lead frame has two electrical connections (6, 7) which, viewed from the base body center, have narrow areas and wider areas arranged downstream thereof, which are each connected to one another,
- the base body (1) is formed in such a way that the electrical terminals (6, 7) protrude from the base body (1) on opposite side surfaces of the base body (1) in the course of the narrow regions, and
- the electrical connections (6, 7) are bent toward the rear side of the base body (1) in the narrow regions and, in the further course, are bent toward the center of the base body (1) in the wider regions at the level of the rear side of the base body (1) and are completely applied to the latter at the rear side of the base body.

2 Patent claim 7, to which five further patent claims are referred back, is directed to the protection of an opto-component with corresponding properties.

3 The plaintiff, who is being sued by the defendant for infringement of the patent in suit, has claimed that the subject matter of the patent in suit is not based on inventive step. The defendant requested dismissal of the action and defended the patent in suit with two auxiliary requests in amended versions.

4 The Patent Court declared the patent in suit null insofar as its subject matter extended beyond the version defended by auxiliary request 2, and

dismissed the action in all other respects. Both parties appeal against this decision. The plaintiff continues to seek a complete declaration of nullity of the patent in suit, the defendant a complete dismissal of the action. In the alternative, it defends the patent in suit in the first instance in a version amended again in comparison to the first instance auxiliary request 1 and in the second instance in the version of the contested judgment.

Grounds of the decision:

5 The appeals of both parties are unsuccessful.

6 1. The patent in suit relates to an opto-component, which can be mounted on the surface of a printed circuit board and a method for its manufacture.

7 1. The patent specification of the patent in suit states that the mounting of unwired electronic components (surface mounted devices, SMD) on the surface of printed circuit boards enables a size reduction of up to 70%, a more efficient production and a higher reliability compared to the conventional plug-in mounting of wired components.

8 The patent specification describes several devices known in the state of the art in which a semiconductor element is mounted on a lead frame and encapsulated in a translucent resin. With regard to one of these devices, it is described as a disadvantage that it is only suitable for through-hole mounting, and with regard to another that the external connection strips protrude laterally from the housing, which entails a comparatively high space requirement.

9 The component disclosed in the Japanese published application Shō 61-42939, in which the connection strips protrude laterally from the resin potting, but whose contact parts are bent under the resin potting, is judged in the patent specification to be more favorable in terms of space requirement. However, the fact that the connecting strips have several bends towards the rear of the resin encapsulation, which allow them to spring in the vertical and lateral directions, is described as a disadvantage. The production of these bends led to a high stress on the components and required a complex manufacturing process.

10 2. Against this background, the patent in suit concerns the technical problem of providing an improved opto-component and a method for its manufacture.

11 To solve this problem, the patent in suit proposes in claim 1 a method for manufacturing an opto-component, the features of which can be structured as follows (the deviating structure of the Patent Court is given in square brackets):

1. The method serves to manufacture a surface-mountable opto-component [A] and comprises the following steps:
 2. A base body (1) is formed [B] on a lead frame by overmolding with plastic, with
 - a) a front side and a rear side [B] and
 - b) a recess (5) extending from the front side [C].
 3. An optical transmitter or receiver (8) is arranged in the recess and connected to an electrical connection of the lead frame (6) by means of a bond-wire connection [D].
 4. The lead frame has two electrical connections (6, 7), which are
 - a) as seen from the center of the base body, have narrow areas and wider areas arranged downstream of these, each of which is contiguous [E];
 - b) project from the base body (1) on opposite side faces of the correspondingly formed base body (1) in the course of the narrow regions [F];
 - c) are bent in the narrow areas towards the rear side of the basic body (1) [G];
 - d) are bent in the further course in the wider areas at the level of the rear side of the basic body (1) towards its center [G];
 - e) at the rear side of the basic body (1) are completely applied to the latter [G].
- 12 3. Feature 2 [B] requires further discussion.
- 13 a) The base body (1) serves as an enclosure for the electrical lead frame and at the same time as a receptacle for the optical element (8). According to the description of the patent in suit, the separation of the base body and the optical element offers the advantage that the optical element can be varied in many ways with respect to design and material depending on the intended use without having to adapt the housing. This makes it possible to

manufacture a low-cost basic component and to couple it only after the assembly and soldering process with an optic adapted to the particular application (paras. 18-20).

14 b) The thickness and stability of the base body are not expressly specified in patent claim 1.

15 However, it follows from the requirement defined in feature 2 [B] that the base body is to be formed by overmolding the lead frame that it must completely surround the lead frame at least in a certain area. It can also be deduced from the connection with feature group 4 [features E, F and G] that the base body must be sufficiently stable to hold the two electrical connections (6, 7) together. This is explicitly emphasized in the description (para. 26).

16 This may lead to the conclusion that the base body must be sufficiently "solid". Contrary to the view of the defendant, however, this does not constitute an independent feature. How "solid" the base body must be is rather a result of the requirements it must meet in order to fulfill its function as an enclosure for the lead frame and a receptacle for the optical element.

17 c) The manner in which the optical element (8) is arranged or fastened in the base body (1) is specified in patent claim 1 only to the extent that the electrical connection to the lead frame is made by means of bond wire.

18 In the description it is additionally stated that the recess (5) in which the optical element is arranged can finally be filled with casting resin. This is mandatory in patent claim 2.

19 II. The Patent Court has justified its decision essentially as follows:

20 The subject matter of the patent in suit as granted and as amended by auxiliary claim 1 was obvious by the state of the art to a skilled person, a graduate engineer in electrical engineering with a technical college degree who was familiar with the manufacture of components suitable for surface mounting.

21 However, the parent application, from which the patent in suit arose, did not belong to the state of the art even if the divisional application on which the patent in suit was based should have been treated as null due to lack of identity

of the plaintiff; a procedural error in this respect did not constitute a ground for nullity and was cured by the grant of the patent in suit.

22 However, the subject matter of the patent in suit was suggested by the Japanese published application Shō 62-213223 (NK3). NK3 discloses a method of manufacturing a surface-mountable electronic device having feature 2 [B] and feature group 4 [features E, F, and G]. In the description of NK3, it is pointed out that the specified method can be used not only for the manufacture of capacitor components, but also for the manufacture of any electronic components. Therefore, the skilled person would also consider it for the production of an opto-component. For this purpose, he adapts the process according to features 2b and 3 [C and D]. The design provided therein is usual for light emitting diodes, which is evident, for example, from the Japanese design 744802 (NK2).

23 The same applied to the subject matter of the patent in suit in the version defended by auxiliary request 1. The additional features provided for according to this request represent usual measures for light-emitting diodes, which is apparent, for example, from the Japanese published applications Shō 55-105388 (NK8) and Shō 63-300578 (NK9) as well as the German published application 23 09 586 (NK10).

24 In contrast, the subject matter of the patent in suit as defended by auxiliary request 2 was based on inventive step. NK3 and NK9 did not contain any information on the choice of material. NK8 and NK10 disclosed epoxy resin as the material for the base body and thus a thermosetting plastic. The thermoplastic materials provided instead according to auxiliary claim 2 were not to be regarded as an alternative without further ado from the point of view of the skilled person because they could only withstand thermal stress to a limited extent.

25 III. This assessment withstands the appeals of both parties.

26 1. The Patent Court rightly did not consider the parent application published under number 400 176 (NK1) to be state of the art.

27 The Senate has so far left open whether and under which conditions formal or substantive errors of a divisional application lead to the fact that in

nullity proceedings it is not subject to the time limit laid down in Art. 76(1) sentence 2 EPC (for German patents: Sec. 39(1) sentence 4 Patent Act) and whether this may have the consequence that the parent application referred to must be counted as state of the art in the event of its publication (Federal Court of Justice, order of 30 September 2002 - X ZB 18/01, BGHZ 152, 172, 176 et seq. = GRUR 2003, 47, 48 - Sammelhefter).

28 This question also does not require a decision in the case in dispute. The divisional application filed by the defendant has in any case become effective by the fact that a possible procedural error was subsequently corrected.

29 a) According to the decision practice of the European Patent Office, only the applicant has the right to divide an application. Art. 76 EPC does not expressly provide for this. However, the provision serves to implement Art. 4G of the Paris Convention for the Protection of Industrial Property and must therefore be interpreted in the light of this provision (EPO OJ 2005, 88 marginal no. 2.4 - divisional application / The Trustees of Dartmouth College).

30 Whether it follows from this that, in the case of a transfer of rights, a divisional application may only be filed by the new right holder in accordance with the general provision in Rule 22(3) Implementing Regulations to the Convention on the Grant of European Patents (in the version still relevant here: Rule 20(3) Implementing Regulations to the Convention on the Grant of European Patents old version) if the new right holder has proved the transfer of rights by submitting documents, can be left open. If these requirements are not yet met when a divisional application is filed by the substantive right holder, this only constitutes a formal error of law which, in any case, is no longer relevant in the present context in accordance with the spirit and purpose of Art. 76 EPC if the requirements resulting from Rule 22(3) Implementing Regulations to the Convention on the Grant of European Patents were met at a later date and a divisional application was still admissible at that date.

31 Art. 76 EPC does not provide for a time limit for filing a divisional application - unlike, for example, Art. 87(1) EPC for claiming a priority right. According to Rule 36(1) Implementing Regulations to the Convention on the Grant of European Patents in the version applicable until 31 March 2010 and

again since 1 January 2014, a divisional application is admissible as long as the parent application is pending. Within this time frame, a divisional application may be replaced by a new divisional application. However, at least in connection with the question of the seniority of a divisional application in nullity proceedings against a patent granted on it, it cannot make any difference whether the applicant corrects a formal error by filing a new, error-free divisional application with the same content or by correcting individual points of the divisional application already pending. In either case, he has made it sufficiently clear within the period provided for by the Convention and the Implementing Regulations that he claims the seniority of the parent application for the divisional application.

32 b) Against this background, the Patent Court correctly concluded that the divisional application on which the patent in suit is based has the seniority of the parent application. A possible infringement of Rule 20(3) Implementing Regulations to the Convention on the Grant of European Patents old version was remedied in the case in dispute by the request for correction of the applicant of the divisional application filed on 12 May 2000.

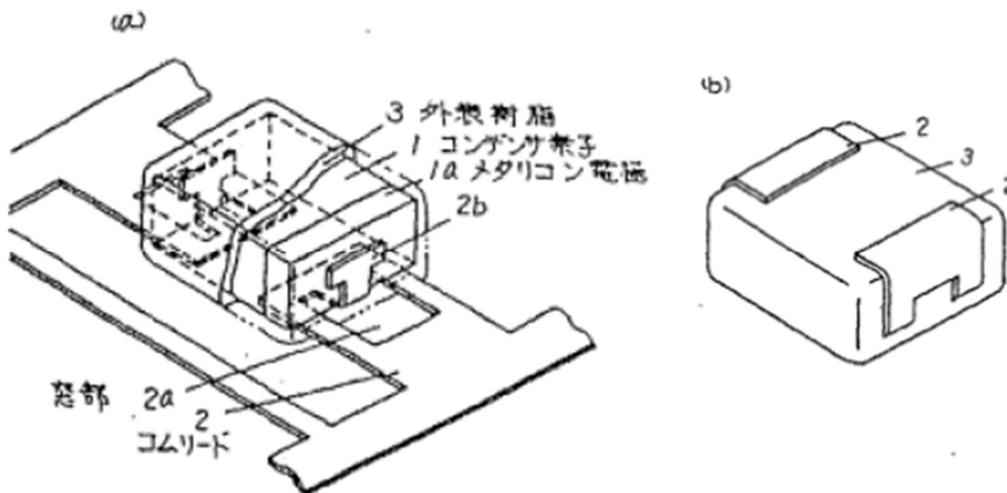
33 It can be left open whether the European Patent Office was correct in granting this request and whether this decision is subject to substantive review in nullity proceedings. In any case, it is sufficiently clear from the letter that the applicant entered in the register wishes to have the divisional application accepted as originating from him. Consequently, the divisional application met the requirements of Rule 20(3) Implementing Regulations to the Convention on the Grant of European Patents old version, from that time on - when the parent application was still pending.

34 2. The Patent Court correctly concluded that the subject matter of claim 1 as granted was suggested to the skilled person by citations NK3 and NK2.

35 a) The Patent Court correctly decided that in NK3 a process with feature 2 [B] and feature group 4 [features E, F and G] is disclosed.

36 aa) Contrary to the view of the defendant, NK3 not only deals with a

surface-mountable component, but also with essential process steps for manufacturing such a component. In the description of Figure 1a (also cited by the defendant in another context) it is stated that upwardly projecting parts (2b) of a comb electrode (2) are welded onto a metal ion electrode (1a). This is followed by a coating of resin with a thickness of 0.5 mm. The comb electrode is then cut at predetermined points and a bending process is carried out to obtain the capacitor shown in Figure 1b (NK3a p. 2 below).



37 bb) As also the defendant does not doubt, the comb electrode (2) disclosed in NK3 corresponds to the lead frame provided for in feature 2 [B] of the patent in suit. It has two electrical connections which are arranged and designed in the manner defined in feature group 4 [features E, F and G].

38 cc) Contrary to the view of the defendant, the enclosure (3) disclosed in NK3 constitutes a basic body within the meaning of feature 2 [B].

39 It is true that the description of NK3 does not contain any information on the stability of the envelope. However, it follows from the context that the enclosure must be sufficiently stable to hold the components arranged in it. Thus the envelope disclosed in NK3 is to be regarded as "solid" in the same sense as the basic body provided for in feature 2 [B]. In which way the required stability can be achieved is left to the skilled person - as in the description of the patent in suit.

40 b) Likewise, the Patent Court correctly came to the conclusion that

the skilled person had reason to consider the method disclosed in NK3 for the manufacture of an opto-component, such as is disclosed in NK2.

41 aa) Contrary to the view of the defendant, the skilled person entrusted with the task of the patent in suit had reason to use NK3 as a starting point.

42 (1) According to the case law of the Senate, the choice of a starting point for the solution of a technical problem requires justification.

43 The classification of a certain starting point - which is at best possible from a retrospective perspective - as the "closest" state of the art is neither sufficient (Federal Court of Justice, judgment of 16 December 2008 - X ZR 89/07, BGHZ 179, 168 = GRUR 2009, 382 marginal no. 51 - Olanzapin) nor necessary (Federal Court of Justice, judgment of 18 June 2009 - Xa ZR 138/05, GRUR 2009, 1039 marginal no. 20 - Fischbissanzeiger). Rather, concrete circumstances are required which gave the skilled person at the time of priority cause to take a certain citation or prior use as a starting point for his considerations. This justification usually lies in the effort of the skilled person to find a better or different solution for a certain purpose than the state of the art provides (BGHZ 179, 168 = GRUR 2009, 382 marginal no. 51 - Olanzapin).

44 (2) This requirement is not lacking in the case in dispute with regard to NK3 because this citation discloses a capacitor whereas NK2 concerns an opto-component.

45 It can be left open whether NK2 could possibly be regarded as "closer" state of the art compared to NK3 from a retrospective point of view due to this circumstance. Even if this were to be affirmed, it would not follow from this that NK3 or other citations could be ruled out as a possible starting point.

46 If several alternatives come into consideration for the skilled person to solve a problem, several of them may be obvious. In this context, it is generally irrelevant which of the alternative solutions the skilled person would consider first (Federal Court of Justice, judgment of 16 February 2016 X ZR 5/14, GRUR 2016, 1023 marginal no. 36 - Anrufoutingverfahren). Accordingly, it is basically irrelevant for the question whether a certain starting point was obvious to the skilled person whether other starting points could possibly be considered as

even closer.

47 (3) Against this background, the Patent Court correctly came to the conclusion that the skilled person had reason to use NK3 as a starting point for his considerations.

48 For this purpose, the indication contained in the description NK3 that the invention disclosed therein is not only applicable to the capacitor shown as an example of an embodiment, but to any electronic component, may not be sufficient in itself. However, the advantages envisaged in NK3 - in particular the possibility of achieving higher reliability at lower manufacturing costs (NK3C p. 2) - largely coincide with the problem definition of the patent in suit. Moreover, the solution proposed in NK3 does not reveal any specific connection with the function of the electronic component. Rather, it concerns aspects that arise in a comparable manner in a large number of electronic components that can be mounted on the surface. In view of all this, the skilled person had reason to consider the question of whether the solution disclosed in NK3 can also be used for the production of surface mountable opto-components.

49 bb) The process disclosed in NK3 cannot be adopted unchanged for the manufacture of opto-components. However, sufficient suggestions for the question as to which measures can be considered for the adaptation required in this respect resulted for the skilled person from known opto-components, such as those shown in NK2.

50 (1) In NK2, a surface-mountable opto-component is shown in various views.



51 Thus, a surface-mountable opto-component is disclosed which has the features 1 to 4c [features A to F as well as a part of feature G] and whose structure with respect to the features 2, 4a, 4b and 4c [features B, C, E and F

as well as a part of feature G] relating to the mountability on the surface corresponds to that of the component disclosed in NK3.

52 (2) This resulted in a confirmation for the skilled person of the suggestion contained in NK3 that the structure disclosed there could also be used for components other than capacitors, and a concretization of this suggestion to the effect that this applies in particular to opto-components.

53 (3) As a starting point for the implementation of this suggestion, both the device disclosed in NK2 and the device disclosed in NK3 were considered by the skilled person.

54 NK2 may have been of particular interest to the skilled person entrusted with the task of the patent in suit, because an opto-component is already disclosed there. On the other hand, the skilled person could not obtain from NK2 any more detailed information on the function and on the advantages and disadvantages of the solution claimed there only as a design. From NK3 such information emerged including the indication - confirmed by NK2 - that this can also be used for opto-components. This not only gave the skilled person reason to adopt the component disclosed in NK2 essentially unchanged. Rather, it was also obvious to take the solution disclosed in NK3 as a starting point and transfer it to an opto-component.

55 (4) Based on the solution disclosed in NK3, it was obvious to adopt the design of the electrical connections disclosed there unchanged - i.e. including feature 4d.

56 The electrical connections of the components disclosed in NK2 and NK3 differ essentially only in that in NK2 the transitions from the narrow to the wide areas - in deviation from feature 4d - are not formed on the sides of the component but on its bottom. Neither NK2 nor NK3 gave any clear indication of the advantages and disadvantages resulting from this difference.

57 In view of this, there may have been no reason for the skilled person to change the solutions described in NK2 and NK3 precisely in this point of detail. However, it follows from this and from the fact that for the skilled person both citations came into consideration as a starting point that for the skilled person

both designs were obvious. Based on the solution disclosed in NK2, there may have been reason to leave the transitions from the narrow to the wider areas at the bottom of the component. Based on NK3, however, there was reason to arrange the transitions on the sides of the construction element.

58 3. With regard to the subject matter of claim 7, there is no deviating assessment, as both parties assume. The device protected therein is not patentable for the same reasons as the process protected in patent claim 1.

59 4. Nothing else applies to the subject matter of patent claim 1 in the version defended by auxiliary request 1.

60 It can be left open whether the replacement of the term "basic body" by "solid basic body" as provided for in this auxiliary request leads to a substantive change. As has already been explained above, the attribute "massive" can in any case be taken to mean no more than that the basic body must be sufficiently stable in order to fulfill its function. This attribute is also disclosed in NK3.

61 5. The subject matter of patent claim 1 in the version of the appealed judgment, however, proves to be patentable on the basis of the citations to be used for this purpose.

62 a) The Patent Court rightly came to the conclusion that the use of thermoplastic material for the manufacture of the base body as provided for in this version was not suggested to the skilled person by the citations to be assessed at first instance.

63 aa) Of these citations, only NK8 contains more detailed references to the material used.

64 In NK8, the base body is made of epoxy resin. According to the unchallenged findings of the Patent Court, this is a thermosetting material. Thus, there is no suggestion for the use of a thermoplastic material.

65 The fact that in NK8 the interior space in which the light emitting diode is arranged is filled with a thermoplastic material, namely acrylic resin, does not lead to a different assessment, contrary to the opinion of the plaintiff. The fact that materials with different properties are used for the two components of the

opto-electronic part even tends to argue against these materials being interchangeable at will.

66 bb) Contrary to the plaintiff's view, the use of thermoplastic instead of thermoset material is not suggested simply because there are only these two types of plastics.

67 As the plaintiff also does not dispute, thermoplastic and thermoset materials are not interchangeable at will. Rather, whether they are suitable for a particular application depends on which material properties are required in the specific context. Consequently, it requires a suggestion for the skilled person to make the base body of the component manufactured according to the protected process from thermoplastic material.

68 The documents on general technical knowledge (SB1 to SB3) submitted as a supplement at second instance do not provide any further information. There, only general properties of certain plastics are described, but not their suitability for the manufacture of a base body for an opto-component.

69 cc) Contrary to the opinion of the plaintiff, the fact that the base bodies in NK8 are manufactured by casting and in NK9 by injection molding also does not lead to a different assessment.

70 As the plaintiff also does not doubt, thermoset materials can also be processed by injection molding. The fact that injection molding of thermoplastic material is generally more cost-effective at most gives reason to consider this alternative if it can be expected that this material is suitable for the specific application. There are no indications in this respect from NK8 and NK9 for the reasons already stated.

71 b) The US patent specifications 4 781 960 (SB4) and 4 032 963 (SB5), which were additionally submitted in the second instance, are not to be taken into account pursuant to Sec. 117 Patent Act and Sec. 531(2) Code of Civil Procedure.

72 aa) Contrary to the plaintiff's view, the two citations and the plaintiff's arguments relating thereto do not merely represent a deepening and

concretization of the first instance submission.

73 In the first instance, the plaintiff essentially argued that for the skilled person there was already a suggestion to use thermoplastic material on the basis of his general technical knowledge of the properties of thermoplastic and thermoset plastics. In its submission relating to SB4 and SB5, on the other hand, it asserts that thermoplastics had already been used in the state of the art for the purpose at issue here. In doing so, it presents a new point of view (see Federal Court of Justice, judgment of 28 August 2012 X ZR 99/11, BGHZ 194, 290 marginal no. 36 = GRUR 2012, 1236 Fahrzeugwechselstromgenerator).

74 bb) The plaintiff already had cause at first instance to submit citations from which a suggestion for the use of a thermoplastic material for the production of a basic body within the meaning of feature 2 [B] was apparent.

75 From the Patent Court's indication, issued pursuant to Sec. 83(1) Patent Act, according to which, inter alia, the feature provided for in patent claim 6 - the manufacture of the base body from thermoplastic material - was not likely to be known from the documents submitted, it was clear to the plaintiff that the Patent Court regarded the subject matter of this claim as potentially patentable in any case. The plaintiff was therefore obliged to make additional submissions within the time limit set. It also reacted and submitted supplementary submissions in the form of citations NK8 to NK10.

76 With careful conduct of the proceedings, the plaintiff could and should have recognized that this submission was not sufficient for the denial of patentability. It was not clear from the reference of the Patent Court in detail which aspects could be of importance in this respect. However, it was not necessary to provide such information, because it is the plaintiff's task to show the reasons for which patentability is to be denied. Moreover, from the indication given that the feature in question was "not known" from the submitted citations, the plaintiff had to assume that its request would only have a chance of success if it showed citations in which the use of thermoplastic material for the purpose in question is disclosed or which at least contain a concrete suggestion for this. The plaintiff does not show that it would not have been able to find citations SB4 and 5 if it had conducted a careful search in this regard.

77 IV. The decision on costs is based on Sec. 121(2) Patent Act as well as Sec. 92(1) and Sec. 97(1) Code of Civil Procedure.

78 Contrary to the assessment of the Patent Court, the Senate is not able to recognize that one of the two parties has predominantly prevailed. A predominant victory of the plaintiff cannot be derived from the fact that the defendant was only successful with its second auxiliary request. Rather, the decisive factor is the extent to which the subject matter of the patent in suit has been restricted by the partial declaration of nullity. In this respect, the Senate is unable to recognize any preponderance in favor of one or the other party. Therefore, it seems appropriate to set off the costs for both instances against each other.

Meier-Beck

Bacher

Grabinski

Hoffmann

Deichfuß

Previous instance:

Federal Patent Court, judgment of 05 August 2014 – 2 Ni 34/12 (EP) –