Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2014-11-25
Docket Number / Aktenzeichen:	X ZR 119/09
Name of Decision / Name der Entscheidung:	Grinding product

FEDERAL COURT OF JUSTICE

IN THE NAME OF THE PEOPLE

DECISION

X ZR 119/09

Announced on:
November 25, 2014
Wermes
Judicial Inspector
as registrar
of the Court

in the patent nullity proceedings

Reference work: yes

BGHZ: no *(decisions of the Federal Court of Justice in civil matters)*

BGHR: yes *(jurisprudence of the Federal Court of Justice)*

Grinding product

PatG (Patent Act) § 21 para 1 no. 3; EPC Art. 138 para 1 lit. c; IntPatÜGbkG (*statute on the international convention dated November 27, 1963 regarding the standardization of certain terms of the substantive law of patents of invention*) Art. II § 6 para 1 no. 3

a) If features of an embodiment which promote the success achieved by the invention, together or each on its own, serve the more detailed configuration of the claimed invention, it is principally admissible to restrict the patent by including individual or all these features into the patent claim. The claimed combination, however, must present the technical teaching in its entirety which can be derived by the person skilled from the documents as originally filed as being a possible embodiment of the invention.

b) If the person skilled in the art can derive from an embodiment which is not described in more detail in this respect that an effect aimed by the invention (here: an open and flexible structure of a knitted cloth) is achieved by a certain combination of two technical measures (here: combination of tricot knitting and satin weaves in a specific arrangement), it is thereby not necessarily disclosed that the same applies for any other combination of these two measures, as well.

Federal Court of Justice, BGH, judgment dated November 25. 2014 – X ZR 119/09 – Federal Patent Court.

The X. Civil Chamber of the Federal Court of Justice subsequent to the oral proceedings held on November 25, 2014 through the Presiding Judge Prof. Dr. Meier-Beck, the Judges Dr. Grabinski, Dr. Bacher, and Hoffmann as well as the female Judge Schuster

has ruled:

Subsequent to the appeal of the defendant, the judgment of the 2nd Senate (Nullity Senate) of the Federal Patent Court announced on May 14, 2009 shall be amended.

The European Patent no. 779 851 is declared to be invalid with effect in the Federal Republic of Germany insofar as its subject matter goes beyond the following version of its – now single – patent claim:

> A grinding product comprising: a cloth of knitted threads (1); thread parts, such as loops (3), situated on one surface of the cloth and projecting from the cloth; and a grinding agent (4) applied as separate agglomerates at least to the other essentially even surface of the cloth, characterized in that the cloth has a structure permeable for the dust produced during grinding or the projecting thread parts are loops (3) of threads (1), which are contained in the cloth or has loops of fibers (2) of such threads, and the projecting thread parts form such a gap between the cloth and a carrier surface on which the cloth may be fixed by means of the projecting threads such that the dust produced during grinding may be removed along the gap.

In addition, the claim is dismissed.

The further appeal is rejected.

The costs of the legal dispute shall be offset against each other.

By law

Facts of the Case:

1 The defendant is owner of the European patent no 779 851 (patent in dispute) granted with effect in the Federal Republic of Germany which had been filed on September 5, 1995 by claiming priority of two Finnish applications dated September 6, 1994 and October 28, 1994 and which relates to a grinding product as well as to a method for its production. Patent claim 1 reads in the language of proceedings:

> A grinding product comprising: a cloth of woven or knitted threads (1); thread parts, such as loops (3) or thread ends (5), situated on one surface of the cloth and projecting from the cloth; and a grinding agent applied as separate agglomerates (4) to that surface of the grinding product which comprises projecting thread parts (3, 5), at least to the projecting thread parts (3, 5), characterized in that the projecting thread parts comprise loops (3) or ends (5) of threads (1) of the cloth.

2 The plaintiff has claimed that the subject matter of the patent in dispute is not patentable. The defendant has defended the patent in dispute in the first instance in an amended version with a Main Request and six Auxiliary Requests.

3 The Patent Court has declared the patent being invalid. With her appeal, the defendant defends the patent in dispute once again in an amended version with a Main Request and five Auxiliary Requests. The plaintiff opposes the appeal.

4 On behalf of the Senate, Dr.-Ing. H.

has provided an expert opinion in written which he has explained and supplemented in the first date of oral proceedings. Subsequent thereto, Ms. E.

on behalf of the Senate has made a German translation of both priority documents and has provided written explanations on the meaning of some terms used therein. Prof. Dr.-Ing. Ü.

on behalf of the Senate has provided an expert opinion in written regarding several questions from the sector of textile engineering and has explained and supplemented the same during the second date of oral proceedings.

Grounds of Decision:

5 The admissible appeal is justified only with respect to a part of the patent in dispute.

6 I. The patent in dispute relates to a grinding product

7 1. According to the explanations in the patent description in dispute, the grinding effect of such products is mainly reduced due to the fact that the grinding dust is clogging the product. In order to counteract this, there have been suggested various measures, for example varying of the grain density, providing different types of binding agents, a dust-repellent surface or affixing perforations in order to be able to suck the dust at specific points. These measures, however, had turned out being insufficient.

8 Against this background, the patent in dispute relates to the technical problem to provide a grinding product that enables a considerably longer service life than the known products.

9 2. In order to solve this problem, the patent in dispute suggests with the version of the patent claims defended in the second instance two grinding products, the features of which may be structured as follows:

10 a) According to patent claim 1, the grinding product comprises:

1. a cloth
   - 1.1 of knitted threads (1),
   - 1.2 that is a warp knitted fabric with a combined knit,
     - 1.2.1 wherein in all knit fabrics of the warp knitted fabric, stitches comprise alternately a thread connection to a knitted stitch of the adjacent knit fabric of the one side and to a knitted stitch of the adjacent knit fabric on the other side,
   - 1.3 comprising an open structure which is permeable for the dust generated during the grinding process
2. thread parts, such as loops (3),
   - 2.1 situated on one surface of the cloth,
   - 2.2 projecting from the cloth, and
   - 2.3 consisting of loops (3) of the threads (1) of the cloth;

3. a grinding agent applied as separate agglomerates (4) to that surface of the grinding product which comprises projecting thread parts (3, 5);
   3.1 at least attached to the projecting thread parts;
4. a liquid-absorbing foam plastic layer (11),
   4.1 attached to that surface of the cloth that is free of grinding material.

11 b) According to patent claim 3, the grinding product comprises:

1. a cloth
   1.1 of woven or knitted threads (1),
   1.2 comprising a structure permeable for the dust generated during grinding;
2. thread parts, such as loops (3),
2.1 situated on one surface of the cloth and
2.2 projecting from the cloth,
   2.2.1 wherein the projecting thread parts comprise loops (3) of threads (1) which are contained in the cloth, or loops of fibers (2) of such threads, and
   2.2.2 form a gap between the cloth and a carrier surface on which the cloth may be fixed by means of projecting thread parts such that the dust produced during grinding can be removed along this gap;
3. a grinding agent that is applied in the form of separate agglomerates (4) at least to the other even surface of the cloth.

12 c) The products protected according to both patent claims in particular differ from each other due to the fact that the grinding agent regarding the first product is fixed on the side comprising the projecting thread parts, whereas regarding the second product it is fixed on the side which is substantially even. The first patent claim further contains more detailed determinations of the structure of the knit fabric and provides that on the side of the cloth being opposite to the grinding agent, there is fixed a liquid-absorbing foam plastic layer.

13 II. The Patent Court substantially has grounded its decision as follows:

14 The subject matter of the patent in dispute in the version as defended by the first instance Main Request and the first instance Auxiliary Requests 1 and 3 is obvious by the

prior art for the person skilled in the art, a graduate engineer having a polytechnic degree specialized in mechanical engineering and having experience for many years in developing grinding products. From the US patent specification no. 2 996 368 (NK9), a grinding product with all features of the preamble of patent claim 1 has been known. This product comprises an open structure and projecting thread parts since these features more or less apply to all woven or knitted fabrics. The core idea of the patent in dispute, to provide the grinding product with a largely open structure for an improved removal of the grinding dust, furthermore, is suggested by the further prior art. Thus, from the US patent specification 2 984 052 (NK6), grinding products are disclosed comprising an open-mesh textile basic layer and a plurality of protrusions or knots. The person skilled in the art easily derives therefrom that regarding textile-based grinding materials, the resistance against the clogging effect of the grinding dust may be improved if the basis of a cloth fabric itself is designed with a possibly open-mesh structure.

15 The embodiment provided according to the first instance Auxiliary Request 4 according to which the agglomerates would be affixed on the essentially even surface, enables to use the projecting thread parts on the other side as a kind of Velcro fastening. This principle has already been known by technologically related grinding products which is verified by the German publication no. 1 577 588 (NK4). The utilization provided according to the first instance Auxiliary Request 6 of such a grinding product for grinding during sucking the dust along a gap between grinding product and carrier surface does not show a further technical surplus.

16 The subject matter of the patent in dispute in the versions as defended by the first instance Auxiliary Requests 2 and 5 goes beyond the content of the originally filed documents. The feature provided in these versions that the cloth consists of a knit fabric with a combined knit from satin weaves and tricot knitting stitches at most may be derivable from Figure 2 of the application documents. In the description, it is neither explicitly mentioned nor implicitly disclosed as belonging to the invention.

17 III. This evaluation only holds out against the examination in the appeal proceedings with regard to the version of the patent in dispute as defended in the second instance by the Main Request and Auxiliary Request 1 but not with regard to the version as defended by Auxiliary Request 2.

18 1. The defense of the patent in dispute in the version according to the second instance Main Request is inadmissible. The subject matter of patent claim 1 in this version

goes beyond the content of the documents as originally filed. The features 1.2 and 1.2.1 provided therein according to which the cloth consists of a knit fabric with a combined knit with a thread connection to respectively adjacent knitted stitches are not disclosed as belonging to the invention.

19 a) According to established case law of the Federal Court of Justice, only what is unambiguously and clearly derivable from the originally filed documents belongs to the disclosure of a patent application as belonging to the invention as applied, however, not the further finding which may be achieved by the person skilled in the art due to his general knowledge or by amending the disclosed teaching. An inadmissible extension is available if the subject matter of the patent is obvious for the person skilled in the art only due to his own ideas borne by his expert knowledge after he has recognized the original documents (cf. only BGH (Federal Court of Justice), judgment dated April 9, 2013 – X ZR 130/11, GRUR 2013, 809 recital 11 – Verschlüsselungsverfahren (*encryption procedure*). As a rule, generalizations are harmless if an embodiment of the invention described in the application is represented for the person skilled in the art as being an embodiment of the more general technical teachings described in the claim and if this teaching in the claimed generality is already obvious for him from the application – be it in form of a claim formulated in the application, be it according to the general context of the documents – as belonging to the invention as applied (BGH (Federal Court of Justice), judgment dated February 11, 2014 – X ZR 107/12, BGHZ (*decision in civil matters*) 200, 63 = GRUR 2014, 542 recital 24 – Kommunikationskanal (*communication channel*)).

20 b) From the application of the patent in dispute, it cannot be derived sufficiently certain that a knit fabric with a combined knit of the type as determined in feature 1.2.1 belongs to the subject matter of the invention.

21 A combined knit is not explicitly disclosed in the application. In the specification, it is only explained that the grinding product comprises a cloth of woven or knitted threads (e.g. on page 1, line 4, page 3, line 19; page 4, line 10). In addition, it is outlined that the term “knitted cloth” also comprises a crocheted cloth or the like (page 14, line 7 et seq.). In contrast thereto, more detailed indications regarding the structure of the knit fabric cannot be found. A knit fabric with a combination from satin weaves and tricot knitting stitches can at best be recognized in Figures 2 and 9. Even if it was derivable from these Figures that the precise embodiment shown there is claimed as belonging to the invention, it would, however, not become sufficiently clear that this should also be valid for other types of a combined knit, in particular by including other knitted stitch types (e.g. velveteen, atlas or rib knitted

stitches), insofar as the same only shows the thread connections provided in feature 1.2.1. For the person skilled in the art who recognizes by means of the Figures a combination from satin weaves and tricot knitting stitches, it might indeed be obvious that this is a combined knit in the sense of the features 1.2 and 1.2.1. However, due to lacking corresponding indications, for the person skilled, it is not derivable that for the configuration of a cloth according to the invention, it precisely depends on the fact to combine several knitted stitch types in this manner whereas the precise mesh type is irrelevant.

22 2. Inadmissible as well is the defense of the patent in dispute in the version according to the second instance Auxiliary Request 1.

23 a) According to this Auxiliary Request, feature 1.2.1 is supposed to be supplemented insofar as the combined knit is structured from satin weaves and tricot knitting stitches.

24 b) With this concretion, the claimed subject matter in the documents as originally filed is not disclosed directly and unambiguously as belonging to the invention.

25 In this respect, it is irrelevant whether in Figures 2 and 9 of the application the knit fabric comprising a concurrent satin weaves/tricot knitting combination is directly and unambiguously disclosed as belonging to the invention. Even if this question might be affirmed, this would at best apply to the mentioned kind of knit, in which the satin weaves are arranged on the front side and the tricot knitting stitches on the rear side. Feature 1.2.1 in the version of Auxiliary Request 1, however, what is not questioned by the defendant, is not limited to this kind of knit. It rather comprises every combination of tricot knitting stitches and satin weaves and, thus, also the tricot knitting/satin weaves in which the tricot knitting stitches are arranged on the front side and the satin weaves on the rear side. At least, by this generalization, feature 1.2.1 is not disclosed in the documents as originally filed as belonging to the invention.

26 aa) According to the jurisprudence of the Senate, however, it is not generally inadmissible to include only individual features of several features into the patent claim (cf. only Federal Court of Justice (BGH), judgment dated February 11, 2014 – X ZR 107/12, BGHZ 200, 63 = GRUR 2014, 542 recital 24 – Kommunikationskanal (*communication channel*)).

27 If features of an embodiment promoting jointly but also each on their own are provided as a basis for a more detailed configuration of the claimed invention, it is principally admissible to restrict the patent by incorporating individual or all of these features into the patent claim (Federal Court of Justice (BGH), judgment dated January 23, 1990 – X ZB 9/89, BGHZ 110, 123, 126 – Spleißkammer (*splicing chamber*); Federal Court of Justice (BGH), judgment dated August 30, 2011 – X ZR 12/10, recital 30). In this context, as well, the claimed combination, however, has to represent a technical teaching in its entirety which can be derived by the person skilled in the art from the documents as originally filed as being a

possible embodiment of the invention (Federal Court of Justice (BGH), decision dated September 11, 2001 – X ZB 18/00, GRUR 2002, 49 – Drehmomentübertragungseinrichtung (*torque transmission device*)).

28 bb) This prerequisite is not available in the dispute.

29 As the judicial expert Prof. Dr.-Ing. Ü. has explained, for the person skilled in the art who is familiar with issues relating to the textile sector, from Figure 2 of the application it can be derived that the grinding product reproduced consists of a knit fabric in a satin weaves/tricot knitting combination. This embodiment, in fact, does not offer a secure guarantee for the fact that the cloth comprises the characteristics desired according to the description, in particular, an open and flexible structure. At least, the attachment of satin weaves on the front side of a basic structure consisting of tricot knitting stitches, however, leads to the formation of relatively large loops which tend to promote the incidence of these effects. Thus, for a person skilled in the art who is familiar to issues relating to the textile sector it may be disclosed that the shown satin weaves/tricot knitting stitches serve to effect the success aimed by the invention. From this, however, it does not result that the same applies for every other combination from tricot knitting and satin weaves, in particular for a combination of tricot knitting stitches/satin weaves.

30 As the judicial expert Prof. Dr.-Ing. Ü. has explained, also numerous other knit fabric combinations can be considered for the realization of the success aimed by the patent in dispute. Whether they are in fact suitable for effectuating this success, cannot be assessed sufficiently certain by abstract considerations. For the person skilled in the art who by means of the examples shown in Figures 2 and 9 sought for ways to execute the invention, it could not be derived directly and unambiguously from the circumstance that a combination of satin weaves and tricot knitting was represented being suitable that the same also applies for all other combinations from tricot knitting stitches and satin weaves. In the light of the explanations of the judicial expert Prof. Dr.-Ing. Ü., in view of a tricot knitting / satin weaves-combination, there would have been doubts already due to the fact that the arrangement of the loops on the rear side of the knit fabric tends to be rather less appropriate for achieving the effects aimed by the invention. From this, it in fact does not arise that such a knit fabric combination would generally be inappropriate. However, against this background, it cannot be derived directly and unambiguously from the application that it already is sufficient for the embodiment according to the invention to combine tricot knitting stitches and satin weaves with each other, whereas the precise arrangement of both knit fabric types is irrelevant.

31 3. If a version of patent claim 1 limited to a knit fabric with a satin weaves/tricot knitting-combination was admissible, would not be subject to a decision. The defendant explicitly clarified in the oral proceedings that she does not defend such a version.

32 4. The subject matter of the (single) patent claim defended by Auxiliary Request 2 – the wording of which is identical to the wording of patent claim 3 of the version defended by the Main Request – is patentable.

33 a) The German utility model no. 295 05 847.1 (NK42) published on July 27, 1995 does not belong to the prior art. The patent in dispute namely claims justly the priority of the Finnish application no. 944 090 filed on September 6, 1994 (in Swedish language).

34 aa) As demonstrated by the interpreter E. charged by the Senate, the term “sticka” comprises the term “to knit” as well as the term “to weave”. The Swedish terminology, thus, corresponds to the English one which, as explained by the judicial expert Prof. Dr.-Ing. Ü. uses for both production manners the term “knitting” and distinguishes between “weft knitting” and “warp knitting” – by deviating discrimination in detail.

35 bb) Against this background, in fact, from the description of both priority documents, in which the individual sub-types are not differentiated in more detail, the configuration of the cloth as being a warp knitted fabric from tricot knitting stitches and satin weaves which are determined in more detail cannot be derived directly and unambiguously. The priority document no. 944 090, however, already contains Figures 2 and 9 represented in the patent in dispute and its application in which a knitted cloth is shown.

36 In the description of the priority document, however, - as well as in the description of the patent in dispute and the application – it is not differentiated in more detail between knitting and weaving. All these production types are rather presented as being principally appropriate. From this, for the person skilled in the art it, however, occurred sufficiently certain that at any case all production types recognizable from the embodiments – irrespective of the precise configuration of the stitches or other details – are claimed as belonging to the invention. Therefore, the defendant was free to limit the subject matter of the invention to one of these production types.

37 cc) As already observed by the Senate in its evidence order dated June 18, 2013, the person skilled in the art, being a graduate engineer of mechanical engineering with experience for many years in developing grinding products, was motivated to consult a

person skilled in the art who is familiar to issues of the textile sector for configuring the cloth claimed by the invention. This correspondingly applies for the subject matter of the priority document.

38 Deviating from the plaintiff's opinion, this is not opposed by the fact that in the description of the cited documents, details of the production type are not considered. It is rather decisive that the characteristics of the cloth according to the claimed invention is given a central importance. A person skilled in the art who wishes to execute the claimed invention is therefore required to seek for suitable fabrics. If he due to his education in the field of mechanical engineering does not have sufficient knowledge to derive more details from the priority document, he is motivated to consult a textile engineer for assessing these issues.

39 b) As observed in detail by the Senate already in its evidence order dated June 18, 2013, the subject matter of patent claim 1 in the version as defended by Auxiliary Request 2 is neither disclosed nor rendered obvious by the other citations, in particular by the US patent specification no. 2 984 052 (NK6) and the German publication no. 1 577 588 (NK4). To this, no new findings occurred in the second oral proceedings.

40 IV. The cost decision is based on § 121 para 2 PatG (Patent Act) and § 92 para 1 ZPO (Code of Civil Procedure).

Meier Beck Grabinski Bacher

Hoffmann Schuster

Court of lower instance.
Federal Patent Court, decision dated May 14, 2009 – 2 Ni 21/07 (EU) -