

Deckblatt Übersetzung

Daten der Übersetzung:

Court/Gericht:	Bundesgerichtshof
Date of Decision / Datum der Entscheidung:	2016-06-21
Docket Number / Aktenzeichen:	X ZR 41/14
Name of Decision / Name der Entscheidung:	Windscreen II



Arbeitskreis
Patentgerichtswesen
in Deutschland e.V.



Translation

FEDERAL SUPREME COURT

IN THE NAME OF THE PEOPLE

JUDGMENT

XZR 41/14

Pronounced on:
21 June 2016
Hartmann Court Clerk as
Registrar of the Court

In patent nullity action

(...),

Defendant and Appellant

- Counsel: (...);

in cooperation with: (...),

versus

(...),

Plaintiff and Appellee

- Counsel: (...);

in cooperation with: (...) -

Following the oral hearing held on April 21, 2016, the 10th Civil Division of the Federal Supreme Court, sitting with the Presiding Judge Prof. Dr. Meier-Beck, Judge Dr. Bacher, Judge Schuster, Judge Dr. Deichfuß and Judge Dr. Kober-Dehm,

has passed the following judgement:

Following the appeal by the defendant, the judgement pronounced by the 5th Division (Nullity Division) of the Federal Patent Court on February 12, 2014 is amended.

With effect for the Federal Republic of Germany, the European patent EP 1 240 041 is declared null and void within the scope of claims 1 to 10 and 12, to the extent that the latter does not refer back to claim 11, and to the extent that the subject matter of these claims extends beyond the scope of the following version of the claims:

1. Device for connecting a windscreen (1), that is fixedly mounted as it is bonded to a cross member (3) of the bodywork of a motor vehicle, to a water tray (6) contiguous with an edge of the windscreen (1) by means of a profiled piece fixed to the edge of the window (2), characterised in that, the profiled piece is a profiled bead (10) adhering to the windscreen (1) having a lip (11), which is connected smoothly and continuously to the external free main face of the windscreen (1) wherein the lip (11) smoothly merges with the upper side of the water tray (6), and in that the lip (11) has on its bottom side means for

removable connections (12, 13) with the water tray (6), wherein the means for removable connections (12, 13) run along the entire length of the profiled bead (10) parallel to the lower edge of the pane, wherein a groove (12) is formed on the lower side of the lip (11), into which a support (13) is inserted.

2. Device in accordance with claim 1, characterised in that profiled bead (10) on its face towards the cross member (3) encompasses an elastic support lip (15), which is supported on the cross member (3).
3. Device for connecting a windscreen (1), that is fixedly mounted as it is bonded to a cross member (3) of the bodywork of a motor vehicle, to a water tray (6) contiguous with an edge of the windscreen (1) by means of a profiled piece fixed to the edge of the window (2), characterised in that, the profiled piece is a profiled bead (10') adhering to the windscreen (1) having a lip (11'), which is connected smoothly and continuously to the external free main face of the windscreen (1) wherein the lip (11') smoothly merges with the upper side of the water tray (6), and in that the lip (11') has on its bottom side means for removable connections (12', 13') with the water tray (6), wherein the means for removable connections (12', 13') run along the entire length of the profiled bead (10') parallel to the lower edge of the pane, wherein an undercut groove (12') is formed on the lower side of the lip (11'), into which an elongated, harpoon-like pin (13') flexibly engages.
4. Device in accordance with claim 3, characterised in that the profiled piece is a co-extruded profiled bead (10') made of two plastic materials having different hardnesses.
5. Device in accordance with claim 3, characterised in that the profiled piece is a co-extruded profiled bead (10, 15') made of two plastic materials having different hardnesses.
6. Device in accordance with one of the previous claims 3 to 5, characterised in that the profiled bead (10') comprises an elastic foamed profile (15') which rests against the cross member (3).

On the remaining counts, the action is dismissed.

The other parts of the appeal are dismissed.

The costs of the legal dispute are offset against each other.

By law

Facts of the case:

1 The defendant is the proprietor of the European patent 1 240 041 (patent in suit), granted with effect for the Federal Republic of Germany, filed on December 21, 2000, claiming the priority of a previous German application DE 199 61 706 of 21 December 1999 and relating to a device for connecting a vehicle window to an adjacent component. The wording of claim 1, to which the other claims refer, is, in the official language of the proceedings, as follows:

"Dispositif pour l'assemblage d'une vitre de véhicule à montage fixe (1), en particulier d'un pare-brise, avec un composant contigu à une arête de la vitre de véhicule, en particulier un bac à eau (6), au moyen d'une pièce profilée fixée à l'arête de la vitre, caractérisé en ce que la pièce profilée est un cordon profilé (10, 10') adhérant à la vitre de véhicule, qui présente une lèvre (11, 11') se raccordant de façon lisse et continue à la face principale libre extérieure de la vitre de véhicule (1), et en ce que la lèvre (11, 11') présente sur sa face inférieure des moyens pour l'assemblage (12,12', 13, 13') avec le composant (6)."

2 The plaintiff attacked the patent in suit, with the exception of claim 11, on the grounds of lack of patentability.

3 By judgment dated February 15, 2012 the Patent Court declared the patent in suit null and void within the scope requested, on the grounds that its subject matter was anticipated by the prior German application so that the patent in suit was unable to claim its priority as it had not been effectively assigned to the patent proprietor. Following the appeal by the defendant, the Court set aside this decision and remitted the legal dispute to the Patent Court for a new hearing and a new decision (BGH, decision of April 16, 2013 -XZR 49/12, GRUR 2013, 712 - Fahrzeugscheibe).

In the re-opened proceedings of the first instance, the defendant ultimately defended the patent in suit in an amended version, in which claim 1 is worded as follows:

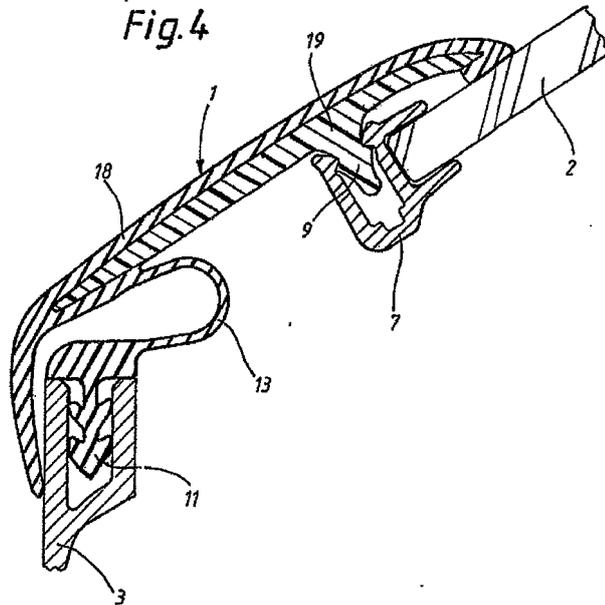
“Device for connecting a windscreen (1), that is fixedly mounted as it is bonded to a cross member (3) of the bodywork of a motor vehicle, to a water tray (6) contiguous with an edge of the windscreen (1) by means of a profiled piece fixed to the edge of the window (2), characterised in that, the profiled piece is a profiled bead (10, 10') adhering to the vehicle window having a lip (11,11') which is connected smoothly and continuously to the external free main face of the windscreen (1) and in that at its underside the lip (11,11') has means of connection (12, 12', 13, 13') with the water tray (6).”

4. Furthermore, as an auxiliary measure, the defendant defended the patent in suit in several amended versions.
5. The Patent Court again declared the patent in suit null and void within the scope requested. The defendant's appeal opposes this decision and defends the patent in suit in the last amended version of its main request, subject to the replacement of the term “windscreen” by the term “vehicle window”. Alternatively, the defendant defends the patent in suit in six other amended versions. The plaintiff opposes this appeal.

Grounds for the decision:

6. I. The patent in suit relates to a device for connecting a vehicle window to an adjacent component.

- 7 1. According to the patent in suit, devices are known from the prior art, in which the space between the lower edge of a windscreen and an element contiguous therewith is bridged by a profiled sealing strip. The German application 37 02 555 (D9), for example, shows a cover plate (1) for bridging a groove between a bonded windshield (2) and a contiguous part of the bodywork (3) as illustrated in Fig. 4, which is reproduced below.



- 8 The cover plate is fixed to the windshield using a U-shaped rail (7) fixed to the lower edge of the windshield. A flexible rib (13) effects a flexible connection between the cover plate and the part of the bodywork (3) and/or the U-shaped rail, enabling any tolerances, expansions of the material or vibrations to be compensated.
- 9 The patent in suit further states that methods are known from the German patent 42 32 554 (D6) and the German application document 43 26 650 (D7), which enable the edge of a glass pane to be provided with a frame or a profiled strip made of a polymer.

An edge profile of this type can also be made or prefabricated by using the injection moulding process and then bonded onto the glass pane and designed in such a way that it forms a continuous surface continuation of the untouched main face of the window glass, i.e., it rests only against the end face of the glass pane and the other main surface.

- 10 As the Patent Court correctly assumed, the patent in suit relates to the technical problem of providing an improved device for connecting a vehicle window to a component which is contiguous with an edge of the vehicle window.
- 11 The plaintiff's opinion that, if the matter is assessed objectively, as is called for, the only technical problem to be solved is to provide a favourable arrangement of the windscreen wipers so that they can be brought to their rest position over the water tray without having to overcome any obstacles, and that aerodynamic aspects need not be considered, narrows the definition of the technical problem in an incorrect manner.
- 12 According to the case law of the Court, it is not admissible to assume without further ado that it was obvious to a person skilled in the art to consider one specific problem only. Seeing that the problems which would have been addressed by a skilled person based on the prior art cannot be determined without a doubt, it would be misguided to assess the question of the suggestions given to the skilled person by the prior art in a first definition of the technical problem. Instead, the technical problem must be worded in a manner which is so general and so neutral that this question is posed exclusively within the context in which it is relevant, namely when assessing the inventive step (BGH, decision of January 13, 2015 - X ZR 41/13, GRUR 2015, 352 no. 17 - Quetiapin).

13 b) In order to solve this problem, the version of claim 1 of the patent in suit as defended in the main request of the second instance proposes a device, whose features can be broken down as follows:

1. Device for connecting a windscreen that is fixedly mounted as it is bonded to a cross member of the bodywork of a motor vehicle, to a water tray contiguous with an edge of the windscreen.
2. The windscreen is connected by means of a profiled piece fixed to the edge of the window.
3. The profiled piece is a profiled bead adhering to the vehicle window.
4. The profiled bead comprises a lip,
 - 4.1. which is connected smoothly and continuously to the external free main face of the windscreen and
 - 4.2. which has at its underside means of connection with the water tray.

14 3. Some of these features require a more detailed explanation.

15 a) A water tray within the meaning of the patent in suit is a device arranged beneath the windscreen which captures and diverts the water flowing from the glass pane, thus ensuring that it does not penetrate into regions of the vehicle located below it, for example into the engine compartment. The claim does not in any way define the material from which the water tray is made.

16 b) The fact that the water tray is adjacent to the edge of the windscreen does not mean that it must be in direct contact with the latter, but only that it is located close to this edge.

If there is a groove between the two, it can be sealed, for example, by the profiled bead adhering to the windscreen.

17 c) Claim 1 does not contain any information concerning the material or size of the lip, but limits itself to the statement that it is a part of the profiled bead which is connected smoothly and continuously to the external free main face of the windscreen.

18 d) In accordance with feature 4.2, the lip has, at its underside, means of connection with the water tray. This expresses the fact that the means of connection with the water tray must not merely be arranged in the lower region of the lip, but on the side of the lip which is directed downwards, i.e., on the side opposite the external free main face of the windscreen. This side need not run parallel to the surface of the ground, but may also be arranged at a certain angle to the ground – depending on the way in which the windscreen is arranged.

19 II. The Patent Court essentially provided the following grounds for its decision:

20 The question disputed between the parties considering the meaning of the phrase "vitre de véhicule à montage fixe" is of no importance. The disclosure of the patent in suit covers both the plaintiff's understanding, according to which a vehicle window to be fixedly mounted, or capable of being fixedly mounted, is meant, and the defendant's understanding, according to which a fixedly mounted vehicle window is referred to. In technical terms, the phrase refers to a vehicle window which is fixed in relation to the bodywork of the vehicle, i.e., it cannot be recessed, shifted, opened up, or similar.

- 21 The subject matter of claim 1 of the patent in accordance with the main request last made is obvious to a person skilled in the field – a mechanical engineer who is specialised in the field of construction and development of motor vehicles, with many years of experience in dealing with problems concerning the connection and transition and the fixed mounting of vehicle windows to the vehicle bodywork – by the prior art, and in particular by the US patent 5 352 010 (D27) in conjunction with the US patent 5 154 028 (D5).
- 22 D27 discloses a device which only differs from the device in accordance with the main request in that the lip does not connect smoothly and continuously to the external free main face of the vehicle window. However, a lip designed in this manner is disclosed in D5. This document refers to the fact that a smooth, continuous connection is favourable for aerodynamic reasons. It is obvious for a skilled person to transfer the smoothly and continuously connecting profiled bead of D5 to the connection arrangement of D7.
- 23 The defendant's objection that the patent in suit does not have the object of achieving an aerodynamic improvement, but instead, merely aims to provide an improved method of arranging the windscreen wipers, is not valid. Contrary to the defendant's opinion, an aerodynamic design is not only necessary with respect to the upper edge of the windscreen, but also with respect to the transitional area between the lower edge of the windscreen and the adjacent element. Moreover, a skilled person will immediately realise that flush-mounting the vehicle window brings advantages with respect to the arrangement of the windscreen wipers.
- 24 Furthermore, the subject matter of claim 1 in the version of the auxiliary requests is not patentable.

- 25 III. The decision pronounced by the Patent Court only partially stands up to the
review made in the appellate proceedings.
- 26 1. The Patent Court has furnished correct grounds for the assumption that the
subject matter of claim 1 in the version of the main request is obvious from the
prior art.
- 27 a) The US patent 5 352 010 (D27) deals with the transitions between panel
assemblies in vehicles in the light of functional aspects, in particular
aerodynamic and aesthetic aspects. D27 also deals with the connection of a
vehicle window to an adjacent element (col. 2, line 6 ff.). Figure 3, which is
reproduced below, illustrates an embodiment in which a gasket (48) is
moulded directly to the windscreen (42), the gasket not only being contiguous
with the surface of the windscreen facing the inside of the vehicle, but also
being contiguous with the outward-facing surface of the windscreen – marked
with the reference numeral 54.

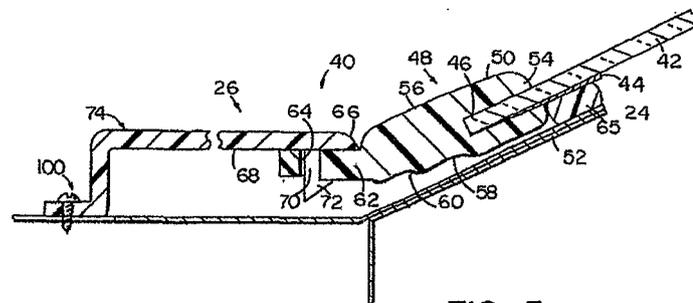
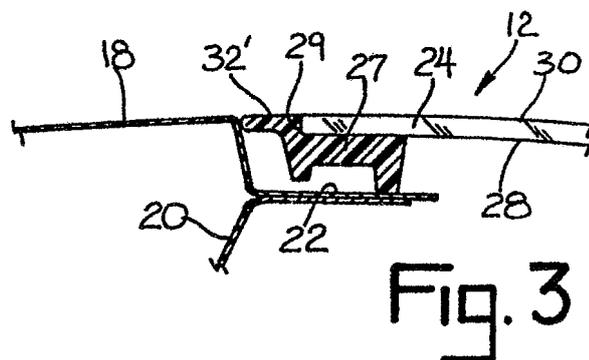


FIG. 3

This gasket has slots or sockets (64) into which a post (70) of the contiguous assembly, a leafscreen or a cowl, engages. The post has a single barb detent (72) which is adjacent to the lower side of the gasket.

29 The Patent Court assumed that thereby, a device is disclosed which anticipates all the features of claim 1 with the exception of feature 4.1. The defendant does not oppose this correct assessment.

30 b) In order to arrive at the subject matter of claim 1 in the version of the main request taking D27 as the starting point, only one modification is necessary, namely that the seal does not surround both surfaces of the windscreen, but is designed in such a way that it is only contiguous with the inner main surface and the perimeter edge of the glass pane, but is connected smoothly and continuously with the external main surface of the glass pane. As the Patent Court further correctly states, the skilled person obtains a suggestion for this in the US patent 5 154 028 (D5). D5 deals with a vehicle window and suggests connecting the latter flush with the outer shell of the vehicle, a solution which is advantageous in terms of both aerodynamics and aesthetics. To do so, connecting means are to be mounted on the glass pane in such a way that they do not surround the external surface of the vehicle window. At the same time, these means should comprise a lip which forms a seal with an adjacent part of the vehicle, essentially located on the same plane. In Figure 3 of D5, which is reproduced below, the glass pane is marked with the reference numeral 30, the connecting means with the reference numeral 27 and the lip with the reference numeral 32':



- 31 c) Contrary to the opinion put forward by the defendant, a skilled person does indeed derive a suggestion from the prior art for transferring a profiled piece mounted to the edge of the glass pane designed in this manner, wherein the lip connects smoothly and continuously with the free external main face of the windscreen, to the design described in D27.
- 32 In D5, a design which makes it possible to mount the vehicle window flush with the shell of the vehicle bodywork is described as having advantages from an aesthetic point of view. Particularly when dealing with the connection to a water tray, it is obvious to a skilled person that a smooth and continuous connection of the lip to the windscreen is suitable for improving the run-off of the water into the water tray.
- 33 Furthermore, both D5 and D27 refer to the fact that a smooth and continuous connection between the lip and the windscreen offers advantages from an aerodynamic point of view. The plaintiff's objection that the aerodynamic aspect is of no importance with respect to the connection of the water tray because the water tray is located underneath the engine hood has no substance. It cannot be derived from claim 1 in the version of the main request that the connection between the lip and the windscreen as described in feature 4.1 is necessarily located underneath the engine hood and therefore not exposed to the airstream. Whether or not this is the case depends on the specific design, and in particular, on the dimensions of the lip. Figure 3 of D27, for example, shows that design in which the transition between the glass pane and the lip is located above the engine hood. Furthermore, a skilled person will definitely consider the aerodynamic aspect with respect to the parts of the windscreen which are located above the engine hood, for example, the upper edge of the windscreen. If he recognises that it is of advantage to connect the profiled piece smoothly and continuously to the external free main face of the glass pane in this region,

he will also consider – with the aim of simplifying the manufacturing process as described, for example, in D6 and D7 – to provide this design over the entire length of the edge of the windscreen and therefore also on the lower edge of the latter.

34 Moreover, the suggestion of connecting the lip smoothly and continuously to the external main face of the windscreen can also be found in the US patent 4 546 986 (D30), which describes a design of this type. In this connection, D30 explains that an arrangement of the seal between the glass pane and the adjacent metal part which is raised above the level of the adjacent surfaces is to be considered unfavourable from an aerodynamic point of view.

35 The defendant's objection that a skilled person would be deterred from providing this type of design by the consideration that a profiled bead with a lip which is connected smoothly and continuously to the external main face of the windscreen would not withstand the loads to which it is subjected during the manufacture of the connection between the glass pane and the water tray, is not valid. Whether or not and to what extent such loads are incurred depends on numerous factors, particularly on the specific design of the connecting means. As is proved, for example by D6 and D7, bonded connections between the glass pane and the profiled bead, which are limited to the edge of the glass pane and a section of a main surface, are regarded in the prior art as being sufficiently stable. Accordingly, it cannot be assumed that a bonded connection between the profiled bead and the windscreen is unsuitable for withstanding the loads incurred during the manufacture of the connection between the water tray and the lip.

36 2. Defence of the patent in suit in the versions of auxiliary requests I to III is admissible. While it is true that the plaintiff did not agree to the defence of the patent in suit in the amended versions, the changes to the request that these represent are pertinent (Sec. 116 Para. 2 No. 1 PatG).

37 a) According to the case law of the Federal Supreme Court, the defence of a patent in amended form asserted for the first time in the appellate instance is usually admissible pursuant to Section 116 Para. 2 PatG if the defendant's amendment takes into account a legal assessment by the

Federal Supreme Court that deviates from the assessment made at first instance, and limits the subject matter of the patent to what, in the opinion of the Patent Court, could already be derived from the version as granted (BGH, judgment of 28 May 2013 - X ZR 21/12, GRUR 2013, 912 no. 57 - Walzstraße). The same is true if in the notification pursuant to Section 83 Para. 1 PatG the Patent Court only touches on individual pleas of the plaintiff and the defendant therefore does not have any reason to file further auxiliary requests in addition to auxiliary requests taking into account the notification given, just as a precaution in view of pleas by the plaintiff on which the Patent Court did not comment in its notification or which it did not deem to be promising (BGH, judgment of 27 May 2014 - - X ZR 2/13, GRUR 2014, 1026 no. 31 - Analog-Digital-Wandler).

38 However, the auxiliary defence of the patent in suit with amended claims at the appellate instance can regularly be seen not pertinent to the case in accordance with Sec. 116 Para. 2 No. 1 PatG if the defendant already had reason to take such action in the first instance in view of its obligation to further a swift conduct of the proceedings (Federal Supreme Court, judgment of 15 December 2015 -XZR 11/13, GRUR, 2016, 365 No. 26 - Telekommunikationsverbindung).

39 In the present circumstances, the defendant cannot be accused of negligent behaviour.

40 The Patent Court expressed the preliminary assessment in its notification pursuant to Sec. 83 para. 1 PatG that the subject matter of claim 1 of the patent is not patentable in the granted version, but that it is patentable in the version of the old auxiliary request, which is now the current main request.

In view of this notification, the defendant changed its old auxiliary request to its new main request. The notification did not, however, give rise to the necessity of further auxiliary requests.

41 After the Patent Court's notification, the plaintiff added several further citations to its submission regarding the lack of patentability of the subject matter of the current main request and explained these in detail. The defendant was not obliged to submit further auxiliary requests as a precaution, as long as the Patent Court did not publicize a change in its preliminary assessment. Therefore, the defendant was not required to react to the plaintiff's further submission as early as within the deadline set according to Sec. 83 Para. 2 PatG by submitting new auxiliary requests. Any other assessment is not to be made, as the defendant might otherwise be in a worse position than if the corresponding submission by the plaintiff had occurred before the qualified notification of the Patent Court.

42 The Patent Court only notified the defendant in the hearing that it had, as a result of the plaintiff's further submission, changed its preliminary assessment expressed in its notification. It was only after receiving this notification that the defendant had reason to check if, and, should that be the case, in which manner, the patent in suit may need to be defended in another, further amended version. Following that, the defendant stated that alternatively it would be willing to defend the patent in suit in several amended versions, but it did not put the versions it would be defending in the current auxiliary requests I to III up for decision at that point in time. However, this does not oppose the pertinence of these requests.

- 43 With the requirements for the admissibility of the limited defence of the patent in suit in an amended version in mind, complex considerations are necessary in the assessment of the question as to whether or not, and, if necessary, in which manner, such a defence is to be considered. In general, this is why the patent proprietor is not charged with neglecting its obligation to further a swift conduct of the proceedings, should it fail to conclude these considerations during the time of the hearing at the Patent Court. This is especially true if - as is the case here - it is not evident from the minutes of the hearing whether or not the Patent Court made it clear on which exact consideration it is basing the change of its preliminary assessment, meaning that it was not immediately apparent to the patent proprietor which limitations could be appropriate to take the court's concerns into account.
- 44 Therefore, the defence of the patent in suit in the versions of auxiliary requests I to III is admissible. Whether or not this is also true for auxiliary requests IV to VI does not require a decision, seeing as the appeal is successful in asserting that the patent in suit is valid according to auxiliary request II.
- 45 b) The subject matter of auxiliary requests I to III does not exceed the content of the originally filed application documents (WO 01/45974).
- 46 aa) The features of auxiliary request I are structured as follows, whereby the changes to the main request are highlighted:
1. Device for connecting a windscreen that is fixedly mounted as it is bonded to a cross member of the bodywork of a motor vehicle, to a water tray contiguous with an edge of the windscreen.
 2. The windscreen is connected by means of a profiled piece fixed to the edge of the window.

3. The profiled piece is a profiled bead adhering to the vehicle window.
4. The profiled bead comprises a lip,
 - 4.1. which is connected smoothly and continuously to the external free main face of the vehicle window,
 - 4.1' **which smoothly connects to the upper side of the water tray,**
 - 4.2. and which comprises means for **removably** coupling to the water tray on the underside.
 - 4.2' **whereby the means for removably coupling extend parallel to the bottom edge of the screen, along the entire length of the profiled bead.**

47 Figures 1 and 2 of WO 10/45974, which correspond to those in the patent in suit, illustrate a lip which smoothly connects to the upper side of the water tray (see also p. 6 line 33 to p. 7 line 2), and it is further specified (p. 5 lines 23 et seq.) that a releasable connection is established between the profiled bead and the adjacent component, and that this connection extends along the entire length of the profiled bead on the lower edge of the windscreen.

48 The fact that the defendant did not take all features of the embodiment in Figure 1 into account in patent claim 1 does not stand against the admissibility of the defence of patent claim 1 in this version. A version of the patent claim which generalizes the original application documents is not to be excluded under all circumstances. Such generalizations are, in fact, admissible, provided that the instructions provided in the original application documents, disclosed by means of an embodiment or in a different manner, appear to the skilled person as a configuration of the general technical teaching of the patent, and that this teaching, to the generality disclosed in the patent, can be directly and unambiguously derived from the original application documents as belonging to the invention filed (Federal Supreme Court, judgment of 17 February 2015 - XZR 161/12, BGHZ204, 199 no. 29 - Wundbehandlungsvorrichtung; judgment of 11 February 2014 -XZR 107/12, BGHZ200, 63 no. 23 - Kommunikationskanal).

In the rulings of the Court, these generalizations have mostly been admitted, if only one or a select few of the features of an embodiment, which were conducive to the success according to the invention when taken together, but also when seen individually, were claimed (BGHZ 200, 63 no. 23 = GRUR 2014, 542 no. 24 - Kommunikationskanal with further references). However, a generalization is most notably inadmissible if it is evident from the original application documents that specific features are indivisibly connected to each other, and the patent claim does not account for these features in their entirety (Federal Supreme Court, order of 11 September 2001 -XZB 18/00, GRUR 2002, 49 - Drehmomentübertragungseinrichtung). In the present case, nothing suggests that this the case.

49 bb) In accordance with auxiliary request II, feature 4.3 is added, in which a groove is formed at the underside of the lip, into which a rib arranged on the water tray is inserted.

50 Even in the original application, it is explained in the description of Figures 1 and 2 that the lip has a groove (*rainure*) on its underside, into which a rib (*netvure*) arranged on the water tray engages (WO 01/45974, p. 7, lines 2 to 4). Therefore, the subject matter of claim 1, even in this further limited version, does not go beyond the contents of the application documents originally submitted.

51 cc) In the version according to auxiliary request III, claim 1 is amended by the addition of the feature that, on the side of the water tray rib facing away from the lip, a support profile is provided, which supports the water tray against the cross member.

A support profile of this type was already described in the original application documents (p. 7, lines 3 to 5).

52 3. Furthermore, in the version in accordance with auxiliary request I. the subject matter of claim 1 is, however, made obvious by the prior art and is therefore not patentable.

53 a) From the prior art documents D2 (Figures 2 to 4), D5 (Figure 3), and D30 (Figure 3), designs were known in which the seal not only connected smoothly to the vehicle window, but also to the surface of the adjacent component. For this reason, a skilled person did not need any inventive step in order to provide a connection of this type for the lip of the profile bead, nor for a connection with a water tray, instead, a design of this type is obvious from the start when he considers the purpose of the water tray, as a smooth transition enables water to run off the glass pane into the water tray more easily.

54 b) Furthermore, means for providing a releasable connection between a glass pane and an adjacent component, of a type which runs along the entire length of the profile bead parallel to the lower edge of the glass pane, were already known in the prior art. Following the summary description of the invention, D27 also deals with a releasable connection of the adjacent parts col. 1, lines 52 to 55: *The two panels comprising the assembly may be detachable from each other and the vehicle to aid in replacement and easy access; see also col. 4, line 59 f.*). In connection with the embodiment already illustrated in Figure 3, which was reproduced above, it is stated that the profile of the gasket (flange 62) has a plurality of slots or sockets (64) which extend through the flange. A skilled person will recognise that these slots, as well as the directly adjacent region of underside of the lip at the opening formed between the slots which retains the barb indent (72) when the post (70) is pushed through it, represent means for connecting the glass pane to the adjacent component.

Even if the fact that the slots extend along the entire length of the profile bead and run along the lower edge of the windscreen is not directly and clearly disclosed in D7, a person skilled in the art will nevertheless at least understand that not merely one slot is provided, but a number of these slots, which extend along a certain length of the profile bead. The defendant's observation that D27 only discloses a plurality of slots and therefore, no continuous elongation of the connecting means, is of no relevance because auxiliary request I is not limited to connecting means which extend continuously over the entire length of the profiled bead.

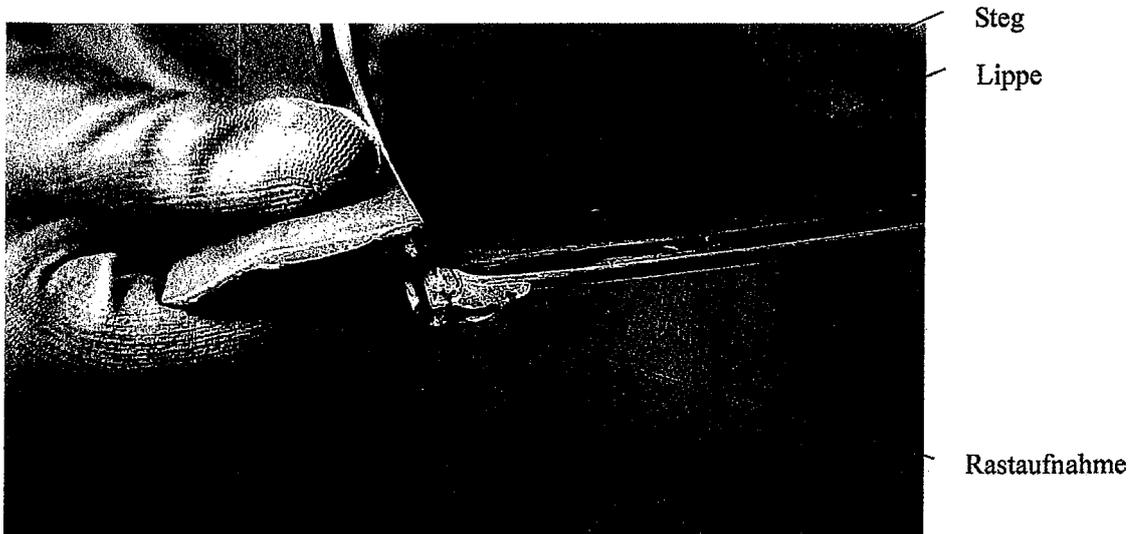
55 c) Accordingly, the combination of features in accordance with auxiliary
request I is made obvious by the prior art,

56 4. However, the appeal is successful in asserting that the subject matter of
claim 1 in the version according to auxiliary request II is patentable.

57 a) Feature 4.3 specifies the means for connecting the lip to the water tray in
that a groove is formed at the underside of the lip, into which a rib arranged on
the water tray is inserted. As we have already explained above, feature 4.2
expresses the fact that the means for connection with the water tray need not
merely be arranged in the lower region of the lip, but on the side of the lip
facing downwards, and hence, opposite to the upper side of the lip, which,
firstly, connects with the free external main face of the windscreen, and
secondly, with the water tray. This side need not run parallel to the surface of
the ground, but may also be arranged at a certain angle to the ground –
depending on the angle of inclination of the windscreen. As regards the
interpretation of feature 4.3, this means that the opening of the groove, with
which the rib arranged on the water tray engages, faces downwards.

58 b) The prior art neither anticipates this version of the subject matter of claim I,
nor does it make this subject matter obvious.

59 aa) There is no need to answer the question concerning whether or not the
two vehicles of the type Audi A6, on which the plaintiff bases its submission
stating that the teaching of the patent in suit has obviously been previously
used, had a windscreen with a cover which overlaps the groove to the
adjacent water tray, as illustrated in the briefs written by the plaintiff on
December 20, 2013 and May 25, 2016. Even if this were in fact to be the case,
it would not mean that the subject matter of claim 1 in accordance with
auxiliary request II was anticipated. It is indeed true that a groove is formed on
the lip shown in these illustrations. However, this groove is not located at the
underside of the lip, but instead, its opening faces upwards – as is shown in
the photograph reproduced below. Accordingly, the rib attached to the cover
of the water tray is inserted into this groove from above. For this reason,
feature 4.3. is certainly not disclosed.



60 bb) Figure 2 of the German application 32 04 351 (D2) indeed shows a
profiled bead for making a seal between the vehicle windscreen

and a contiguous element, which has a groove with which a rib arranged on this component engages.

Although the opening of the groove is located in the lower region of the lip, its opening does not face downwards, but sideways. Hence, it is essentially facing the same way as the windscreen. Similar designs are also shown in the German application document 44 04 348 (D8, Figure 1), the European patent application 163 195 (D16, Figure 2) and the US patent 4 546 986 (D30, Figures 3 and 4).

61 cc) The defendant has not provided any evidence for the fact that a skilled person would be motivated by this prior art to design the lip in such a manner that the opening of the groove is rotated approximately 90°, i.e. that it faces downwards, and the arrangement of the rib attached to the adjacent component, which is meant to engage in this groove, is modified accordingly.

62 5. Accordingly, the defendant's appeal has proved to be well founded inasmuch as it asserts that the subject matter of the patent in suit in the version according to auxiliary request II is patentable, and that therefore, the plaintiff's nullity action should be dismissed within the corresponding scope. The other parts of the defendant's appeal are not successful.

63

IV. The decision as to costs is based on Sec. 121 Para. 2 PatG in conjunction with Sec. 92 Para. 1, Sec. 97 Para. 1 ZPO. The submissions made by the parties do not provide any evidence concerning the relationship between the value of the patent in the version granted and in the version with respect to which the nullity action fails. Accordingly, the costs are offset against each other. An analogous application of Sec. 97, para. 2 ZPO cannot be considered, for the same reasons for which the admission of auxiliary requests I to III is deemed pertinent.

Meier-Beck

Bacher

Schuster

Deichfuß

Kober-Dehm

Previous instance:

Federal Patent Court, decision dated February 12, 2014 - 5 Ni 59/10 (EP) -

Work of reference: ___yes

BGHZ: _____no

BGHR: _____yes

Vehicle window II

PatG Sec. 116 Para. 2

The alternative defence of the patent in suit in the appellate instance on the basis of amended claims may be deemed pertinent, if the Patent Court only informed the defendant for the first time during the oral proceedings of the fact that the Court does no longer maintain its opinion expressed in the notification pursuant to Sec. 83 Para. 1 PatG which was favourable to the defendant.

BGH, judgment of June 21, 2016 - X ZR 41/14 - Federal Patent Court