



FEDERAL COURT OF JUSTICE

ON BEHALF OF THE PEOPLE

JUDGMENT

X ZR 19/12

Pronounced on:
27 August 2013
Wermes
Judicial Inspector as
clerk of the office

in the patent nullity case

Reference book: yes
BGHZ: yes
BGHR: yes

Pedal crank assembly

Patent Law § 117; Code of Civil Procedure § 529 (1) No. 2, § 531 (2), first sentence, Nos. 1 to 3

- a) A new means of attack which is to be derived from technical information newly introduced in the second instance and which is to support the plea is to be admitted in the patent nullity appeal proceedings only under the conditions of Sec. 531 (2), first sentence, Nos. 1 to 3 ZPO, irrespective of whether prior publication and technical content of the counterclaim are not in dispute. The same applies to documents which could prove a technical development leading away from the invention and which could therefore be considered as means of defence of the defendant.
- b) If the plaintiff relies on the fact that a citation was only found by a search carried out after the first instance judgement was issued, the means of attack based on this is only to be admitted under Sec. 531 (2) sentence 1 no. 3 ZPO if the plaintiff demonstrates that the citation could not be found with an appropriately selected search profile in the search carried out for the substantiation of the action for patent nullity.

Federal Supreme Court, judgment of 27 August 2013 - X ZR 19/12 - Federal Patent Court

In response to the oral hearing of August 27, 2013 the X. Civil Senate of the Federal Supreme Court by the presiding judge Prof. Dr. Meier-Beck, the judges Gröning, Dr. Grabinski and Hoffmann as well as the judge Schuster

has ruled:

The appeal against the judgment of the Fifth Senate (Nullity Senate) of the Federal Patent Court pronounced on 9 November 2011 is dismissed at the plaintiff's expense.

By law

Facts of the Case:

1 The defendant is the proprietor of European Patent No 1 342 656, filed on March 7, 2003, claiming priority from a prior American application dated March 8, 2002 and also granted with effect in the Federal Republic of Germany, which relates to a bicycle crank unit and an assembly tool. It comprises 40 claims, the first of which in the language of the proceedings is

1. A bicycle crank arm apparatus comprising:
an axle (59) being adapted to be rotatably supported within a bottom bracket (33) of a bicycle frame, said axle having an axle body (348) with a first end portion (350) and a second end portion (354), wherein the second end portion has an outer peripheral surface and a threaded inner peripheral surface;

an axle bolt (380) having a threaded outer peripheral surface screwed into the threaded inner peripheral surface of the second end portion of the axle (59); a crank arm (60B) having an axle mounting boss (332) defining an opening for receiving the second end portion (354) of the axle therein, wherein the axle mounting boss (332) includes a first fastener for tightening the crank arm mounting boss around the second end portion of the axle (59); and wherein the axle mounting boss (332) is positioned axially inwardly of the axle bolt (380), characterized in that said axle (59) further comprises a projection extending radially outwardly from one of the first and second end portions (350, 354) of the axle body (348), wherein the projection is dimensioned and positioned to be located externally of the bottom bracket (33) so as to abut against a laterally outer side surface of a bicycle crank arm (60A) to prevent the crank arm (60A) from moving axially outwardly.

2 The plaintiff has attacked the patent in dispute to the extent of claims 1 to 25. It claimed that claim 1 goes beyond the content of the original application documents and that the subject-matter of claims 1 to 25 is not patentable because it is not based on an inventive step. In the first instance, the plaintiff relied on the German disclosure documents 100 32 778 (D1) and 23 59 437 (D2) and on the American patent specification 4 201 120 (D3).

3 The defendant has only defended the patent in dispute to a limited extent in the challenged scope. In this context, the Patent Court annulled it in so far as it goes beyond the version of claims 1 to 22 as apparent from the operative part of its judgment of November 9, 2011 and dismissed the remainder of the action. The plaintiff's appeal is directed against this decision

and pursues its first-instance objective. The defendant opposes the appeal.

Grounds of the decision:

- 4 I. 1. The patent in dispute concerns a bicycle crank assembly intended to be mounted in the bottom bracket of the frame. Such assemblies usually comprise a shaft (hereinafter referred to as the 'axle' in the translation of the patent specification) which extends through the bottom bracket support in a supported manner, and two crank arms fixed to the axle for pedals to drive the bicycle via one or more front gears (sprockets) fixed to the crank arm, usually the right-hand crank arm, and sprockets fixed to the rear axle and a drive chain.
- 5 2. The description of the patent in dispute mentions that sprockets and pinions would normally have to be correctly aligned for the unimpaired use of the bicycle. In order to achieve this, a known method of lateral alignment of the axle is to support it rotatably and centred within a tubular member, while being held laterally by bearing assemblies installed at opposite ends of the tubular member. The axle and tubular element are then inserted into the bottom bracket cradle and the required lateral position of the axle is adjusted by screwing adapters, the outer peripheral surfaces of which are threaded, into the bottom bracket cradle at different distances on each side. The patent specification in dispute criticizes that the adapter elements must be long enough to cover the many different lateral positions that can be considered for the axle. As a result, a portion of the threaded

outer circumferential surface of each adaptor is regularly exposed and the threads are therefore often dirty or rusty. In addition, the axle, tubular element and bearing assemblies usually have to be replaced as a unit.

6 3. The patent court has seen the problem, the solution to which the patent in dispute is intended to solve unspokenly - an object is not set out in its description - in the fact that a pedal crank mechanism is to be provided for a bicycle, the components of which, although the axle can be adjusted to different transverse positions, can be positioned in such a way as to be protected from rust and dirt and are largely interchangeable individually. To that end, claim 1 in the version of the contested judgment ('claim 1') protects a bicycle crank arm device which has (in square brackets the outline numbers used by the patent court):

1. An axle (59) **[2]**,
 - 1.1 being adapted in such a way that it can be rotatably supported within a bottom bracket (33) of a bicycle frame **[2.1]**, and
 - 1.2 whose axle body (348) has a first (350) and a second end portion (354) **[2.2]**,
2. a flange (366) **[6]**, which
 - 2.1 *Extending radially outwardly from the first end* portion (350) of the axis body (348) **[6.1]**,
 2. is dimensioned and positioned so that it is outside the bottom bracket (33) **[6.2]**,
 - 2.3 so as to abut against a laterally outer side surface of a (first) bicycle crank arm (60A) to

prevent the crank arm (60A) from moving axially outwardly,
[6.3, 6.4].

3. an axle bolt (380) **[3]**,
 - 3.1 having a threaded outer peripheral surface **[3.1]** and
 - 3.2 which is screwed into the threaded inner peripheral surface (368) of the second end portion (354) of the axle **[3.2]**, which has an outer peripheral surface and is provided with a (counter) thread on its inner peripheral surface (368) **[2.3, 2.4]**,
4. a (second) crank arm (60B) **[4]** with a *mounting boss* (331) **[4.1]**,
 - 4.1 defining an opening (332) for receiving the second end portion (354) of the axle therein, **[4.2]**.
 - 4.2a including a first fastener for tightening the axle mounting boss around the second end portion (354) of the axle **[4.3, 4.4]**, and
 - 4.3 is positioned axially inwardly of the axle bolt (380) *[positioned axially inwardly of the axle bolt]*. **[5]**

7 4. (a) The feature element 'Achsbestigungsauge' (features 4, 4.2), translated as 'axle mounting boss', does not designate, in the relevant terminology of the patent in dispute in the language of the proceedings, the openings in the pedal cranks through which they are fitted to the axle. Instead, they are assigned their own reference marks (308, 332). Neither does this term refer to the radial recess similar to an annular groove on the outer edge of the opening into which the flange is inserted in a version shown. In the original application documents and in the granted version of the patent in dispute, the term "axle mounting boss" rather describes the body of the cranks enclosing

the openings 308 and 332 without radial limitation of the range.

8 (b) The technical meaning of the device protected by Claim 1 becomes apparent in the light of the explanation of its assembly in the description (marginal 23 = marginal 32 of the translation). Axle bolt 380 is intended to adjust the axial position of the crank arm 60B after the axle has first been inserted from outside through opening 308 in the axle mounting eye 304 of the sprocket-side crank arm 60A so that the latter is held axially outwards by the axle flange. Then the axle is pushed through the bottom bracket receptacle and the crank arm 60B is placed on the second end section 354 of the axle with the opening 332 in the axle mounting boss 331. The axle bolt resting on the crank arm 60B is then screwed into the threaded inner peripheral surface 368 of the axle until the desired lateral axle position of the crank arm is reached, in order to now tighten it with the first fastening device (feature 4.2). In the design example presented in marginal 23 of the description, adapter assemblies 124A and 124B are also described in connection with the installation of the sophisticated device. These assemblies include spacers 154A and 154B which serve to define the desired clearance between the crank arms 60A and 60B and the bottom bracket holder (see Figure 2).

9 II. the Patent Court, in so far as it dismissed the action, held that the subject-matter of claim 1 was not inadmissibly extended by the fact that an axle bolt 380 and a first fixing device were provided without including spacers 154A and 154B. According to the original application documents, not only the common use of these components, but also the structure of the pedal group without such spacers could be inferred from the patent claim 1 formulated there.

The further limitation of the granted claim 1 by claiming a flange instead of the originally intended protrusion is also admissible because a flange is an embodiment of a protrusion.

10 The Patent Court essentially justified its assumption that the subject matter of claim 1 is based on an inventive step as follows. The bicycle crank arm device disclosed in D3 does not show a flange in the sense of feature group 2 and no fastening device in the sense of feature 4.2. D3 offers a complete solution for the tasks which the patent in dispute poses (above I 3). On this basis, there was no need to change the arrangement proposed there.

11 Nor does D2 give a sufficiently concrete suggestion for finding the subject-matter of claim 1. The end section of the axle on the sprocket side there could be interpreted as an axle fastening eye integrally moulded onto the axle and in this respect as a flange; however, this was in any case not designed to prevent the crank arm from moving outwards in the axial direction. D2 also did not show any axle bolt and the associated features. From a technical point of view, the one-piece design of the axle and crank arm may be recognised as disadvantageous, but the text suggests that the crank arm should also be attached to the axle on the side of the sprocket wheel by means of splines and a fastening device (Figure 3 of D2, reference mark 15). As far as the aspect of protection against rust and dirt is concerned, D2 encourages the use of the dust cap (Figure 1, reference number 8), but not the use of an axle bolt.

12 D1 also does not lead to the subject-matter of claim 1, as the device disclosed there does not have a fastening device according to feature 4.2 and does not have an axle bolt with feature group 3. If the replacement of the locknut apparent from D1 by an axle bolt for screwing into an internal thread of the axle is assumed to be an obvious measure for a specialist in view of the problem of exposed thread sections exposed to dirt and corrosion, this would nevertheless not result in a fastening device in conformity with the patent for tightening the axle fastening boss around an end section of the axle, and certainly not around that end section which is provided with an internal thread and receives the axle bolt. Such a fastening device does not protect against dirt. Combinations of the three aforementioned opposites also do not lead to the subject-matter of claim 1.

13 III. The attacks of the appeal directed against this assessment are not successful.

14 1) The Patent Court was right to hold that the device protected by claim 1 did not include spacers 154A and 154B, even though such elements were described in the original application documents. According to the case law of the German Federal Supreme Court, the disclosure content of the patent application depends on the entirety of the original application documents, as the appeal correctly points out. This, however, is aimed at the frequently raised objection that the granted patent claims go beyond the subject matter of the claims formulated in the original application documents and clarifies in this context that the disclosure content depends on the entirety of the original application documents and on what is directly and unambiguously evident from them from a technical point of view as belonging to the invention (see Federal Supreme Court, judgment

of December 22, 2009 - X ZR 28/06, GRUR 2010, 513 marginal 29 mwN - Hubgliedertor II). A certain embodiment is also disclosed as belonging to the invention if it is only described in the claims filed with the application documents, but not additionally in the description or there - as claimed here - with certain additional elements, such as the spacers in question here (see, for example, BGH, judgment of July 8, 2010 - Xa ZR 124/07, GRUR 2010, 910 marginal no. 46 – Fälschungssicheres Dokument).

15 2. The plaintiff is also wrong to question the admissibility of the limited defence based on insertions in feature group 2. For this purpose, it can be left open whether the defendant's objection that the plaintiff had accepted the limitation of the patent in dispute in this respect before the patent court and was therefore excluded in the appeal proceedings with attacks against their conformity with the original disclosure, is enforceable from a procedural point of view. In any event, the subject matter of claim 1 is not inadmissibly extended by features of feature group 2.

16 a) The appeal is wrong in its assumption that the skilled person does not regard the flange mentioned in the description and to be taken from the drawings as an essential component of the invention, which he generalises accordingly already when reading the description. The original application documents directly describe the function of the flange to hold the pedal crank 60A in its position axially outwardly of the axle (European patent application 1 342 656 A2, para. 20 ff.: "... A radially outwardly extending flange 366 is disposed at the extreme end portion 350 for abutting against the laterally outer surface of axle mounting boss 308 of crank arm 60A ..."). Nothing else expresses feature group 2. To the extent that the additional description in feature 2.3 that the flange is intended to prevent the crank arm from moving outwards in an axial direction is intended to prevent the

crank arm from moving outwards in a laterally outer surface of a bicycle crank arm, this is merely an additional description of the effect of what is already expressed in feature group 2 as a whole.

17 b) The fact that the flange "extends radially outwardly" is directly consistent with the original application documents ("a radially outwardly extending flange", loc. cit. para. 20). To the extent that the limitedly defended version of claim 1 also states - superfluously - that the flange extends "radially outwardly from the first end section 350", this adoption from the unsuccessful German translation of the patent specification of claim 1 does not add anything additional. The wording in the language of the proceedings, in which the patent in dispute could have been defended in a more limited manner, remains decisive anyway.

18 c) The arrangement of the flange "outside the bottom bracket cradle" (feature 2.2) may not have been expressed literally in the original application documents, but it is apparent from Figure 3 and is, from an expert point of view, for which, according to the undisputed findings of the patent court, a mechanical engineer from a technical college who is involved in the design of pedal crank mechanisms for a bicycle manufacturer or supplier and has several years of professional experience in this field is to be taken as a matter of course from a technical point of view, after the type of device claimed with patent claim 1.

19 d) In so far as the flange, according to the wording of the restricted version of claim 1, comes into contact with an "outer lateral surface of a bicycle crank arm", this does not constitute an inadmissible extension, because the "outer lateral surface of a bicycle crank arm" in the diction of the patent in dispute corresponds to that of the axle fastening eye and, contrary to the plaintiff's view,

no delimitable restriction of the radial extension of the flange can be derived from the latter (above I 4 a).

20 3. The assessment of inventive step by the patent court is not shaken by the appeal and is not legally objectionable in any other way.

21 The prior art cited in the first instance against the patent in dispute does not make the subject-matter of claim 1 appear obvious, if only because neither one of the three documents D1 to D3 by itself nor imaginable combinations of the documents offered a sufficiently concrete suggestion for the device according to the invention, the technical sense of which, as stated above, is in particular that the relative axial position of the pedal crank arm 60B can be determined by means of the bolt 380 which is screwed into a female thread of the axle, in order then to tighten the arm in that position (I 4 b above).

22 With regard to the assessment of documents D1 to D3 for the assessment of novelty and inventive step in detail, the Senate refers to the statements in the contested judgment and states in addition, with regard to the written pleadings and the discussions at the oral proceedings: "The patent court correctly identified the task by interpreting the claim using the description. If, as in the present case, no task has been formulated, the problems mentioned in the description and associated with the known solutions can be considered as indications for the correct interpretation of the patent claim, from the performance result of which in turn the task in the sense of the actually solved technical problem can be derived (Federal Supreme Court, judgement of February 4, 2010 - Xa ZR 36/08, GRUR 2010, 602 marginal no. 27 - Gelenkanordnung). This does not exclude that in the examination of the inventive step other technical problems must also be taken

into account, the solution of which may lead the person skilled in the art to propose or in any case to consider the technical teaching of the invention (judgment of March 11, 2011 - X ZR 72/08, GRUR 2011, 607 marginal 12, 14 – kosmetisches Sonnenschutzmittel III).

23 In order to move from the subject matter of D1 to the subject matter of claim 1, it would not be sufficient to replace the lock nut in the pedal crank device shown in D1 with an axle bolt such as that intended to lock the pedal cranks in D3. Neither in D1 nor in D3 is the axial adjustment function provided for the pin within the solution of the patent in dispute. Therefore, it is not apparent what, without retrospective consideration, should have been the technical reason to modify D1 in this respect. Furthermore, from a technical point of view, there would be no reason to replace the attachment of crank arm 14 in D1, which corresponds to the pedal crank arm 60B of the patent in dispute, by the attachment shown in D2, which the patent in dispute seems to take up only when considering feature 4.2 in isolation. The reason is that the chain drive system to the rear wheel, which is the actual subject matter of D1, entails, as can be seen from the figures, that chain wheels are fitted on both sides of the frame tubes, so that there is no room, from a technical and constructional point of view, for tightening a pedal crank corresponding to crank arm 60B, closing a gap between two fixing lugs 337 and 338 (see Figures 6 and 7 of the patent in dispute), even if this document is used for the assembly of bicycle crank units in a technical sense. The excitation content of D1 therefore in any case does not go beyond the attachment and mounting of crank arm 60A used in the patent in suit.

24 4. There is no need to decide to what extent the appeal is a new plea within the meaning of Sec. 117 Patent Law in conjunction with Sec. 531 (1) Patent Law. 2, first sentence, ZPO, to the extent that the plaintiff, for the combination of a

pedal crank device according to D1 with an attachment of the crank arm corresponding to the pedal crank arm 60B of the patent in dispute, which in its opinion is obvious, as shown in D2, also relies for the first time in the grounds of appeal on British patent specification 549 498 (D8) as an alternative to D2, refers to US patent 4 406 504 (D4), Japanese disclosure document Hei 8-258779 (D5), European patent specification 887 207 (translation = D6) and - as a general rule - to other documents (D9 - D14) in which clamping mechanisms for bicycle cranks with tangential screws are described. For the plaintiff does not derive anything from this which goes beyond D2.

25 5. In so far as the plaintiff relies for the first time in the statement setting out the grounds of appeal on the Japanese notice of disclosure Sho 63-133488 (D7) and in the statement of February 28, 2003, lodged after the expiry of the time-limit for filing the statement setting out the grounds of appeal If the plaintiff bases an independent attack on this document, which in combination with the citation D1 suggests the subject-matter of the patent in dispute, the scope of examination of the Court of Appeal pursuant to Sec. 117 Patent Law in conjunction with the correspondingly applicable provisions of Sec. 529 (1), No. 2, Sec. 531 (2), first sentence, Nos. 1 to 3 ZPO does not extend to this.

26 (a) Despite the information given to it immediately after receipt of the statement of grounds of appeal, the plaintiff did not, even at the hearing before the Senate, put forward any argument on the basis of which the new plea could be admitted under those provisions.

27 It does not concern a point of view which the patent court would have recognisably overlooked or considered irrelevant (Sec. 531 (2), first sentence, No. 1 ZPO), nor does the appeal allege a procedural defect, in particular in the form of an insufficient indication under Sec. 83 (1) Patent Law (Sec. 531 (2), first sentence, No. 2 ZPO). Admission would therefore only be possible if the failure to

assert the claim at first instance was not due to negligence on the part of the plaintiff or its representatives (Paragraph 531(2), first sentence, point 3 of the ZPO).

28 In this regard, the plaintiff has indicated that several legal disputes are pending between the parties, including several patent infringement actions brought by the defendants and some European opposition proceedings pending against the plaintiffs' rights. Most recently, the defendant brought a new infringement action based on European patent 2 202 141. This patent was opposed on May 31, 2012 and in preparation for this opposition a comprehensive prior art search was carried out which revealed the prior art introduced in the appeal proceedings.

29 b) This reasoning is unsuitable to exclude a negligent conduct of the case, because of the fact that no less than five of the citations mentioned for the first time in the grounds of appeal, namely the British patent specification 549 498 (D8), the German patent specification 61 009 (D11) and the US patent specifications 4 728 218, 4 704 919 and 5 010 785 (D12 to D14) are already listed on the cover sheet of the patent specification as citations and D8 is also dealt with in the description of the patent in dispute. In the claimed lump sum, therefore, the assertion that only a renewed search enabled the plaintiff to introduce further prior art into the patent nullity proceedings cannot be true.

30 c) Moreover, the lack of negligence cannot be justified by the fact that the search which brought to light the newly introduced prior art was carried out only in the appellate instance. Rather, it must be explained why this search was not (yet) carried out even if the proceedings had been conducted carefully at first instance. Such a statement is not made here, nor

does it follow from the plaintiff's further submissions at the hearing.

31 On the one hand, it relied in addition on the fact that the subsequently introduced documents could only have been identified by a broader search than that carried out for the proceedings at first instance, which would have been correspondingly more extensive. With regard to D7, which occupies a prominent position in the plaintiff's submissions at the second instance and whose admission, according to the foregoing, is subject only to examination, this is not valid without further explanation - not provided by the plaintiff - if only because the document belongs to the same group of the same subclass of the international patent classification as the patent in dispute (B62M 3/00). Furthermore, the demonstration of lack of negligence in the determination of the prior art relevant for the substantiation of the attack on the claim presupposes that the plaintiff specifically states how he created the search profile of his search at first instance, why he chose such a profile and not the one that led to the determination of the prior art newly cited at second instance, and that in the search profile chosen the attack on the patentability of the subject-matter of the patent at issue at second instance could not be carried out at first instance. Only such a statement - missing in the case in dispute - enables the defendant to comment on the question whether the first instance search was conducted with due care and enables the Federal Supreme Court to examine whether the requirements of § 531 (2) sentence 1 no. 3 ZPO for the admission of the new submission are met. According to § 112.3 No. 2 letter c Patent Law, the facts on the basis of which new means of attack and defence are to be admitted under Sec. 117 Patent Law therefore also belong to the grounds of appeal, which must already be contained in the statement of grounds of appeal if they are to bear the admissibility of the appeal. It was the declared regulatory objective of the reform legislator to transform the nullity appeal

procedure into an instrument of error control and correction (Explanatory Memorandum to the Draft for Simplification and Modernisation of Patent Law, BIPMZ 2009, 307, 316). The reformed Patent Act is based on the legislative commitment to a patent nullity procedure in which the matter in dispute is in principle conclusively determined in the first instance and which can only be extended later under the conditions of a corresponding application of Sections 529 to 531 ZPO. It would be incompatible with this objective to allow a patent search effort which is subject to subjective expediency and which in principle distinguishes between the two instances of the nullity proceedings.

32 Second, as regards the Japanese origin of D7, to the extent that the plaintiff pointed out that Japanese documents were only entered into relevant databases from 2006 onwards and even that this was not retroactive, the defendant convincingly points out that, in view of the defendant's market position in the manufacture of bicycle components, the plaintiff had increased reason to extend its search to Japanese documents. Moreover, even from this point of view, the plaintiff has not explained why it was able to present the D7 citation, published before 2006 (1988), on appeal but not at first instance.

d) Contrary to what the plaintiff seems to think, the fact that the Patent Court, in its reference under Paragraph 83(1) of the Patent Law, did not, as in this case, set a time-limit for supplementing its submissions is not sufficient to demonstrate lack of negligence. The order of the chairman, in which the patent court pointed out to the plaintiff that the attacks made by her based on the counter-arguments D1 to D3 could presumably not substantiate an obviousness of the subject-matter of the patent in dispute, gave her reason to examine whether an addition to the pleading was possible

and necessary. The patent court's waiver of the setting of a time limit provided for in Sec. 83 (2) Patent Law favored the plaintiff to the extent that it was allowed to introduce objections objectively related to the reference granted, without being bound to a set time limit, into the first instance proceedings until the end of the oral proceedings without having to fear rejection under Sec. 83 (4), first sentence, Patent Law. However, the failure of the patent court to set a time limit does not provide a means to make up for the complete failure to do so in the first instance in the appeal instance outside the framework of the corresponding provisions of Sec. 531 (2), first sentence, nos. 1 to 3 ZPO.

34 e) Contrary to the plaintiff's view, the new plea based on D7 is also not admissible on the ground that the public availability of the document before the priority date and the technical information content to be inferred from it are undisputed.

aa) According to the case-law of the Federal Court of Justice, the concept of new means of attack and defence in civil proceedings only covers disputed submissions and therefore requiring evidence (Federal Court of Justice, ruling of November 18, 2004 IX ZR 229/03, BGHZ 161, 138, 142; order of June 23, 2008 GSZ 1/08, BGHZ 177, 212 para. 10). The Federal Court of Justice pointed out in particular in support of its reasoning that the purpose of the civil proceedings would be contradicted by an interpretation of the provision according to which the court would have to decide on a wrong factual basis presented by neither party (BGHZ 161, 138, 143). However, these considerations cannot be applied to the introduction of new prior art in patent nullity proceedings, the particularities of which were taken into account by the legislator of the Patent Law Modernisation Act in Sec. 117 PatG by ordering a merely corresponding application of Sec. 531 (2)

(see the explanatory memorandum of the draft bill of the Federal Government, BT-Drucks. 16/11339, p. 24; Gröning, GRUR 2012, 996, 998 et seq.

bb) The patentability of the subject-matter of the patent in dispute is determined by whether the prior art anticipates the technical teaching protected or provides sufficient inspiration to the person skilled in the art to modify or further develop known technical solutions to this technical teaching. The state of the art consists of a regularly unmanageable number of publications and other objects, from which building blocks can be derived for the plaintiff of the patent nullity proceedings to demonstrate that and to what extent the subject matter of the patent in dispute was detrimental to novelty or to the person skilled in the art. Apart from the rather rare cases in which relevant elements of the prior art consist of an obvious prior use claimed by the plaintiff or the point in time when a certain technical teaching has been made available to the public is in dispute, the prior art discussed in the litigation essentially consists of officially published patent documents or other publications of a fixed date and is therefore usually undisputed as such. However, the prior art, which is typically as unlimited as it is unmanageable, only becomes a means of attack when the plaintiff explains what specific contribution which components of which counter-objection are to make to the claimed lack of patentability (BGH, decision of August 28, 2012 - X ZR 99/11, BGHZ 194, 290 marginal no. 36 - vehicle alternator). Although patentability is ultimately determined by the legal conclusions to be drawn from the (potentially) relevant contributions to the assessment of novelty or inventive step, the patent court is neither obliged nor even entitled to determine on its own initiative what these relevant contributions might be. Otherwise, the plaintiff could confine himself to submitting a large number of citations or even to listing them and leave it to

the patent court to evaluate their content and to examine whether and to what extent this gives rise to indications of lack of patentability. However, this would mean that the patent court would fail in its task of impartially weighing whether the statement of claim justifies the petition and would put itself in the role of an assistant to the petitioner; however, the principle of official investigation does not provide a basis for this either. This makes it clear that in patent nullity proceedings the indisputable affiliation of a certain citation to the prior art cannot be a suitable criterion for the qualification as (new) means of attack. Rather, the means of attack is the plaintiff's statement which is intended to justify the claim on the basis of certain technical information which the person skilled in the art can take from a certain citation or citations. The same applies to citations which could prove a technical development leading away from the invention and therefore could be considered as a means of defence of the defendant.

37 (cc) After that date, it is no longer relevant that the plaintiff did not produce a translation from Japanese into German of the descriptive part of the D7 citation from the Japanese language, even within the time-limit, which could establish an indisputable content of the technical information provided by the citation and would have enabled the Senate to assess the disclosure content of the document.

38 IV. The decision on costs is based on Sec. 121 (2), second sentence,
Patent Law in conjunction with Sec. 97 (1) ZPO.

Meier-Beck

Gröning

Judge at the Federal Supreme Court
Dr. Grabinski can't sign, off on vacation.

Meier-Beck

Hoffmann

Schuster

Lower court:

Federal Patent Court, decision of 09.11.2011 - 5 Ni 36/10 (EP) -