



# FEDERAL PATENT COURT

## ON BEHALF OF THE PEOPLE JUDGMENT

1 Ni 23/19 (EP)  
(file number)

In the patent nullity case

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against

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**concerning the European patent EP 2 333 198 (**  
**DE 50 2010 011 594)**

the 1st Senate (nullity Senate) of the Federal Patent Court on December 14, 2021, by President Dr. Hock and Judges Heimen, Dipl.-Phys. Univ. Dr.-Ing. Geier, Dipl.-Ing. Univ. Peters and Dipl.-Ing. Univ. Sexlinger

found in favor

- I. European patent EP 2 333 198 is declared invalid with effect for the territory of the Federal Republic of Germany to the extent of claims 1 to 11 and 19 and 20.
- II. The defendant shall bear the costs of the proceedings.
- III. The judgment is provisionally enforceable against security in the amount of 120% of the respective amount to be enforced.
- IV. The amount in dispute is set at 312,500 euros.

## **Facts**

The defendant is the registered proprietor of European patent EP 2 333 198 (DE 50 2010 011 594) filed on November 11, 2010, which claims the priority of European prior application EP 09177907 filed on December 3, 2009. The grant of the patent in suit, entitled "Device and method for blowing blow-in insulation material into insulation chambers", was published on May 4, 2016, and as amended comprises a total of 22 claims, a device claim 1 and claims 2 to 18 which are at least indirectly related back to it, and a method claim 19 and claims 20 to 22 which are at least indirectly related back to it.

The plaintiff seeks a partial declaration of invalidity to the extent of claims 1 to 11 as well as 19 and 20. With respect to device claim 1 and process claim 19, the nullity plaintiff invokes the ground of lack of patentability, namely lack of novelty and lack of inventive step. It also asserts the ground of invalidity of lack of patentability against the challenged subclaims.

For the wording of the claims, reference is made to the patent in suit EP 2 333 198 B1.

The plaintiff requests,

to declare European patent EP 2 333 198 invalid to the extent of claims 1 to 11 and 19 and 20 with effect for the territory of the Federal Republic of Germany.

The defendant initially opposed the complaint and defended the patent in suit as granted and with several auxiliary requests in amended form. In a writ dated October 18, 2021, the defendant stated that it acknowledged the claims and requested that the hearing on October 21, 2021, be set aside. The plaintiff has also expressed its consent to a decision by written procedure.

For further details of the facts and the dispute, reference is made to the writs exchanged between the parties together with the Exhibits.

## **R e a s o n s   f o r   d e c i s i o n**

### **I.**

After the defendant requested the cancellation of the date for oral proceedings and the plaintiff also agreed to a decision in written proceedings, the Senate could decide without oral proceedings, Sec. 82 (3) Patent Law.

The complaint asserting the ground for invalidity of lack of patentability under Article II, Sec. 6(1)(1) IntPatÜG, Article 138(1)(a) EPC in conjunction with Articles 54, 56 EPC is admissible. It is also well founded. The patent in suit is therefore to be declared partially invalid to the extent stated.

According to established case law, the defendant's declaration to acknowledge the claim and thus to no longer defend the patent in suit to the contested extent constitutes an effective limitation of the subject matter of the patent invalidity proceedings. Since the patent in suit is no longer defended to the contested extent, it must be declared partially invalid without further examination of the merits (established case law: see Federal

Supreme Court (BGH) GRUR 2007, 404 - Carvedilol II; Federal Supreme Court (BGH) GRUR 1996, 857 - Rauchgasklappe; Federal Supreme Court (BGH) GRUR 2010, 137 - Oxaliplatin with further references; Federal Supreme Court (BGH) judgment of April 19, 2021 - 7 Ni 60/19 (EP); Schulte/Voit, PatG 10th edition, Section 81, marginal no. 128).

The determination of the amount in dispute is based on the information provided by the parties on the amount in dispute in the infringement proceedings (Düsseldorf District Court 4c O 63/19, EUR 250,000.00) plus a surcharge of 25 percent with regard to the fair market value of the patent (see Federal Supreme Court (BGH) GRUR 2011, 757 - Invalidity amount in dispute).

## II.

The decision on costs is based on Sec. 84 (2) Patent Law in conjunction with Sec. 91 ZPO. § SEC. 91 CODE OF CIVIL PROCEDURE (ZPO). The conditions under which, within the framework of a decision on equity, the costs are to be borne by the plaintiff, because the unsuccessful party did not defend the patent and also did not give rise to the complaint, are not present here. The defendant did not make a declaration equivalent to an acknowledgement under the legal concept of Section 93 Code of Civil Procedure (ZPO) immediately, but only at an advanced stage of the proceedings (see Federal Supreme Court (BGH) GRUR 2013, 1282 - Druckdatenübertragungsverfahren).

## III.

The decision on provisional enforceability follows from Sec. 99 (1) Patent Act in conjunction with Sec. 709 first and second sentences of the Code of Civil Procedure (ZPO).

**IV.**  
**Remedies**

This judgment is subject to appeal.

The appeal must be filed in writing or in electronic form with the Federal Supreme Court, Herrenstr. 45 a, 76133 Karlsruhe, Germany, by a lawyer or patent attorney admitted to practice in the Federal Republic of Germany, within one month after service of the judgment in full, but no later than within one month after the expiration of five months after delivery.

Dr. Hock

Heimen

Dr. Geier

Peters

Sexlinger

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