



FEDERAL SUPREME COURT

DECISION

X ZB 12/20

of

September 12, 2023

in the legal appeal proceedings

Reference book: yes

BGHZ: no

BGHR: yes

Table-top grill

German Utility Model Act (GebrMG) Section 15

- a) In utility model cancellation proceedings, the limited defense of a claim attacked with a partial cancellation request by combining it with a sub-claim not attacked in this respect or with one of several variants of a sub-claim not attacked in this respect is also inadmissible (supplement to Federal Supreme Court BGH, judgment of March 1, 2017 - X ZR 10/15, GRUR 2017, 604 para. 33 - Ankopplungssystem; judgment of June 13, 2023 - X ZR 47/21, GRUR 2023, 1274 para. 150 - Anschlussklemme).
- b) On the other hand, there is an interest in legal protection if the claim attacked is only supplemented by some of the features of a sub-claim not attacked (confirmation of Federal Supreme Court (BGH), judgment of June 13, 2023 - X ZR 47/21, GRUR 2023, 1274 para. 151 - Anschlussklemme).

German Utility Model Act (GebrMG) Section 17 para. 4 sentence 1; German Patent Law (PatG) Section 84 para. 2 sentence 2; Code of Civil Procedure (ZPO) Section 93

- a) As a rule, there is no reason to file a cancellation request if the utility model owner has already filed amended requests before the proceedings are initiated and has declared that the request for protection is limited to the new claims (supplement to Federal Supreme Court BGH, judgment of June 27, 2023 - X ZR 59/21, para. 149 - Anzeigemonitor).
- b) If the claimant requests a cancellation of the utility model to a greater extent after submitting such a declaration and if this request is successful, the application of Section 93 Code of Civil Procedure (ZPO) in favor of the respondent is generally not considered.

Federal Supreme Court (BGH), decision of September 12, 2023 - X ZB 12/20 - Federal Patent Court

ECLI:EN:FEDERAL SUPREME COURT (BGH):2023:120923BXZB12.20.0

The X. Civil Senate of the Federal Supreme Court on September 12, 2023 by the presiding judge Dr. Bacher, the judge Dr. Deichfuß, the judges Dr. Kober-Dehm and Dr. Marx and the judge Dr. Crummenerl

ruled as follows:

The legal appeal against the decision of the 35th Senate (Utility Model Appeal Senate) of the Federal Patent Court of October 12, 2020 is dismissed at the expense of the respondent.

The value of the subject matter of the legal appeal proceedings is set at EUR 150,000.

Reasons:

1 A. The respondent is the owner of the utility model 20 2014 010 338
(disputed utility model), which was branched off from the patent application
10 2014 213 770.5 of July 15, 2014 and relates to a grill and a charcoal chamber.

2 Claim 1, to which thirteen further claims are related back, reads:

Grill having a housing (1), a carrier bowl (3) which is arranged inside the housing
(1) with spacing from the housing (1) at all sides, a substantially cylindrical
charcoal chamber (20) which stands in the carrier bowl (3) and which has a cover
(24), a cooking grid which is arranged above the charcoal chamber (20) and an
air supply device which from below the carrier bowl (3) produces an air flow
directed into the charcoal chamber (20), characterized in that the cylindrical wall
(23) of the charcoal chamber (20) is produced from high-grade sheet steel and in
that the high-grade sheet steel is slotted, perforated or stretched.

3 Claim 15 protects a charcoal chamber with corresponding features.

4 The respondent has issued a warning to the claimant and a customer on the
basis of claims 1, 6 to 10 and 12 and 15 for infringement of the property right. The
claimant requested the respondent, setting a deadline, to refrain from enforcing
rights arising from the utility model in dispute and announced a partial cancellation
request. The respondent filed amended claims 1 to 8 with the Patent Office within
the set deadline, declaring that it would only assert rights from the disputed utility
model in the past and future to the extent of the amended claims.

5 The claimant has applied to the Patent Office to cancel the property right to
the extent of the claims listed in the warning letter due to lack of protectability. At
the oral hearing, it also requested the cancellation of the amended

claims with the exception of claims 4 to 7 and additionally asserted that the subject matter of amended claim 1 went beyond the content of the documents originally filed.

6 The respondent has defended the utility model in suit to the extent of the amended claims, with the proviso that the word "the" is inserted before the word "features" in claim 8.

7 The Patent Office canceled the utility model in dispute insofar as it goes beyond the subject matter of the defended version and rejected the request for cancellation in all other respects. It imposed one fifth of the costs of the proceedings on the claimant and four fifths on the respondent.

8 With the appeal directed against this, the claimant pursued its first-instance requests in full. The defendant countered this with its request at first instance and eight auxiliary requests. With its own appeal, it requested that the claimant be ordered to pay the entire costs of the proceedings.

9 The Patent Court canceled the utility model in dispute to the extent of the claims attacked 1, 6 to 10, 12 and 15 and ordered the respondent to pay the costs of the proceedings.

10 With its legal appeal proceedings admitted by the Patent Court, the respondent continues to pursue its requests from the appeal instance. The claimant opposes the appeal.

11 B. The legal appeal proceedings, which is admissible by virtue of admission and also admissible in other respects, is unfounded.

12 I. The contested utility model concerns a grill and a charcoal chamber.

13 1. The statement of use in dispute is based on the example of a charcoal
grill known from European patent specification 1 838 187 (D4).

14 This grill has a charcoal chamber with a screen-like cover inside a housing.
The charcoal bowl is equipped with a closed wall and is supplied with combustion
air from below via a central, conical bulge and a perforation arranged therein
(para. 3).

15 The charcoal chamber is essentially only suitable for upward heat radiation,
namely through a covering flame screen. Due to the bowl-shaped design of the
charcoal chamber, it essentially reflects the heat radiation upwards, which
considerably reduces the effective surface area. In addition, the filigree design of
the flame screen means that there is a risk of it breaking or becoming brittle after
several heating cycles (para. 4).

16 2. Against this background, the utility model in dispute concerns the
technical problem of designing the charcoal chamber in such a way that it can
withstand constant use at high temperatures and radiates heat as unhindered as
possible.

17 3. For the solution, the contested utility model in the version of claim 1
defended by the main request proposes a table-top grill, the features of which can
be organized as follows (changes from the registered version are highlighted):

Table-top grill having

1. a housing (1),
2. a carrier bowl (2) which is arranged inside the housing
(1) with spacing from the housing (1) at all sides,
3. a substantially cylindrical charcoal chamber (20) which stands in
the carrier bowl (2) which has
 - 3.1 a cover (24),

3.2 a cylindrical wall (23) made of a slotted, ~~perforated or stretched~~ high-grade sheet steel,

3.2.1 wherein the slots deviate from an axial alignment,

4. a cooking grid which is arranged above the charcoal chamber (20) and

5. an air supply device which from below the carrier bowl (2) produces an air flow which is directed into the charcoal chamber (20).

18 II. The Patent Court essentially gave the following reasons for its decision:

19 Despite the filing of newly formulated claims and a declaration of limitation by the respondent, the claimant admissibly directed its request for cancellation against the registered claims 1, 6 to 10 and 15.

20 The other registered claims had not become the subject matter of the proceedings. Insofar as the claimant objected to the subsequently filed version of the claims with the exception of claims 4, 5, 6 and 7, it merely expressed that it did not consider the claim for cancellation asserted by it to be fulfilled even to the extent of the subsequently filed claims.

21 Insofar as the word "cylindrical" has been omitted from the characterizing part of the subsequently filed claim 1, this does not constitute an impermissible extension.

22 The registered claims 6 to 10 and 12 were to be deleted without further substantive examination because their subject matter was no longer contained in the subsequently filed claims. This applies to the registered claims 1 and 15 only to the extent that they go beyond the subsequently filed claims 1 and 8.

23 The subject matter of the subsequently filed claim 1 in the version defended by the main request and the auxiliary requests 1 to 3 is new, but is not based on an inventive step. It was obvious to the skilled person, a university graduate in mechanical engineering or with a corresponding academic degree with several years of experience in the field of development and construction of grills of any kind, from a synopsis of the international application WO 2014/094745 (AS1a) with the Japanese application 2001304553 (AS27, translation AS27a).

24 The auxiliary requests 4 and 5 are inadmissible as they contain a combination of claim 1 with the features of the unchallenged claim 4. In this respect, the legal situation and interests are to be assessed no differently than in patent nullity proceedings, in which the limited defense of the patent by a combination of a challenged claim with an unchallenged sub-claim or with one of several variants of an unchallenged sub-claim is also inadmissible.

25 For the subject matter of the subsequently filed claim 8 according to the main and auxiliary requests, there is no deviating assessment.

26 The subsequent filing of amended claims does not justify imposing costs on
the claimant in accordance with Section 93 Code of Civil Procedure (ZPO).
Rather, it is appropriate to make the decision on costs according to the extent to
which the respondent was able to successfully defend the attacked registered
claims with the subsequently filed claims.

27 III. This assessment withstands legal scrutiny as a result.

28 1. The Patent Court rightly assumed the lack of protectability of claim 1 in
the defended version.

29 a) The Patent Court's assumption that AS1a discloses all features of the
version of claim 1 defended by the main request, with the exception of feature
group 3.2, is not attacked by the legal appeal proceedings, which is admissible by
virtue of admission and also admissible in other and does not reveal an error of
law.

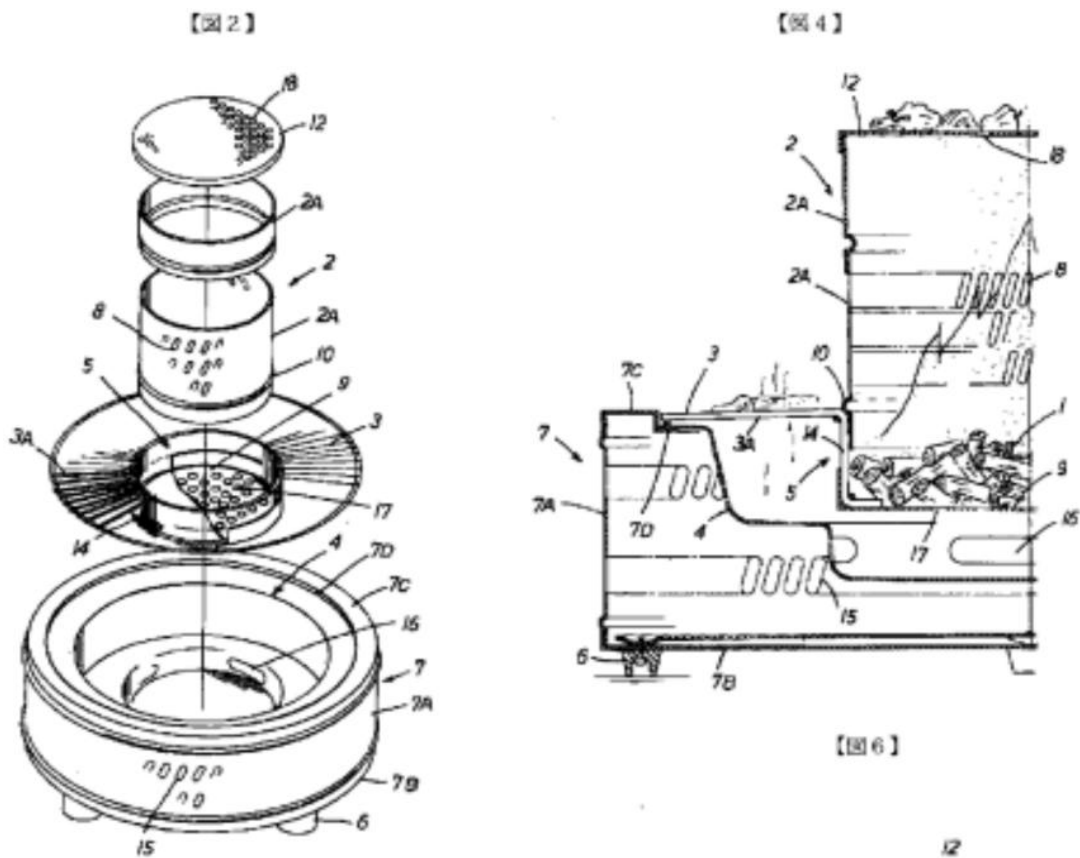
30 b) The legal appeal proceedings, which is admissible by virtue of
admission and also admissible in other unsuccessfully attacks the Patent Court's
assumption that, on the basis of AS1a, it was obvious to replace the previously
known stainless steel screen with a much more solid stainless steel wall with slots
deviating from an axial direction, as disclosed in AS27.

31 aa) As the Patent Court correctly stated and as the legal appeal
proceedings, which is admissible by virtue of admission and also admissible in
other does not call into question, AS1a contains the indication that flame screens
of a charcoal chamber can break and become brittle after several heating cycles
due to their filigree design.

32 The fine-mesh sieve made of stainless steel proposed in AS1a (p. 4 lines 26-
30, p. 11 lines 7-8, p. 13 lines 4-5) is, according to the explanations in AS1a,
suitable for sufficiently long use (p. 4 lines 28-30). Nevertheless, the Patent Court
rightly assumed that there was reason to look for ways to further increase the
service life of the charcoal chamber disclosed in AS1a.

33 bb) The Patent Court also rightly decided that, against this background, an
embodiment according to feature group 3.2 was suggested by AS27.

34 (1) As can be seen from Figures 2 and 4 reproduced below, AS27
discloses a table grill with a carrier bowl (4) arranged in a housing (7), which
carries a grid (3).



35 A charcoal chamber (2) formed from two cylindrical wall elements (2A) that
can be plugged onto or into one another is arranged in the center of the grill grate.
The lower wall element is provided above the cooking grid (3) with a large number
of slots (8) in the form of elongated holes, which are formed in several rows along
the circumference of the wall and are inclined relative to the cylinder axis.

36 The charcoal chamber (2) can be filled with charcoal beyond the height of the
cooking grid (3) so that the food is heated from below and above (AS27a

para. 26). The slots (8) and the tubular wall surface transfer sufficient radiant heat from the charcoal radially outwards to the food to be grilled (para. 35).

37 (2) The Patent Court did not err in law in deciding that it was obvious to replace the screen of AS1a by the more stable and robust wooden chamber wall disclosed in AS27

38 (a) Contrary to the opinion of the legal appeal proceedings, AS27 also suggested arranging the slots in a way that deviated from the axial orientation (feature 3.2.1).

39 As the legal appeal proceedings do not fail to recognize, the slots shown in Figures 2 and 4 are not arranged axially. Like the utility model in dispute, AS27 does not contain any explicit information as to why such an arrangement is more advantageous than an axial arrangement. However, even without such information, there was reason to adopt the arrangement shown as an example in the figures in order to keep the adaptation effort as low as possible.

40 (b) Contrary to what the legal appeal proceedings assert, the Patent Court's denial of protectability does not prove to be erroneous in law because the slots (8) shown in AS27 are located exclusively above the cooking grid (3).

41 As already explained above, the charcoal chamber (2) can be filled with charcoal up to above the cooking grid (3) according to the description of AS27 (AS27a para. 26). The Patent Court did not err in law in deducing from this that the part of the cylinder provided with the slots can also be filled with charcoal. From this, it correctly concluded that there was reason to consider the design of the charcoal chamber with slots also for a grill in which, as shown in AS1a, the charcoal chamber is only arranged below the cooking grid.

42 2. The fact that, on this basis, the Patent Court also assessed the subject-matter of claim 1 in the version of auxiliary requests 1 to 3 as suggested by the combination of AS1a with AS27 is not challenged separately by the appeal on points of law. In this respect, no error of law can be identified.

43 3. There is no deviating assessment for the protection claim 8 concerning the charcoal chamber in the version according to the main request and the auxiliary requests 1 to 3.

44 4 With regard to auxiliary requests 4 and 5, the Patent Court's decision proves to be correct in the end.

45 a) Contrary to the opinion of the Patent Court, there is sufficient interest in legal protection for these auxiliary requests.

46 aa) In patent nullity proceedings, according to the case law of the Federal Supreme Court, the limited defense of a patent claim challenged with a partial nullity action by combining it with a sub-claim that is not challenged in this respect or with one of several variants of a sub-claim that is not challenged in this respect is inadmissible (Federal Supreme Court). March 2017 - X ZR 10/15, GRUR 2017, 604 para. 33 - Ankopplungssystem; judgment of June 13, 2023 - X ZR 47/21, GRUR 2023, 1274 para. 150 - Anschlussklemme).

47 bb) Nothing else applies to the limited defense of a utility model challenged with a partial cancellation request.

48 (1) By combining the features of a challenged claim with those of a sub-
claim not challenged by the request for cancellation, subject-matter which is not
challenged by the request for cancellation would be put up for review. However,
the possibility of defending the utility model in a limited manner serves solely as a
defense against the attack, but not to review its protectability in other respects.

49 (2) The fact that the Utility Model Act, unlike the Patent Act (Section 64),
does not contain any provision on a limitation procedure does not justify a different
assessment, contrary to the opinion of the appellant.

50 The limitation procedure under Sec. 64 Patent Act has no direct legal
connection with the possibility of only partially challenging a patent in a nullity
action and the possibility of defending a challenged patent in a limited version. If
the patent owner defends the patent attacked in a nullity action only with an
amended version of the claims and the patent proves to be legally valid in this
version, this has the same effects as a limitation under Sec. 64 PatG. However,
the inadmissibility of a defense with an unchallenged version is not based on the
possibility of such proceedings, but on the fact that the subject matter of the nullity
proceedings is determined by the plaintiff. In this respect, utility model
cancellation proceedings are no different.

51 cc) Contrary to the opinion of the Patent Court, however, auxiliary requests
4 and 5 are admissible if this standard is applied.

52 (1) According to auxiliary request 4, the version of claim 1 defended by the
main request is to be supplemented by the following features:

3.2.2 [wherein slots] are configured to be precisely so
wide that it is sufficient for optimum heat radiation,
wherein they must be so narrow that their neither
embers nor flying sparks reach the outer side
through the slots,

3.2.3 and have a width in the range from 1 to 3 mm.

53 After auxiliary request 5, the word "cylindrical" should be inserted before the
word "wall" in feature 3.2.

54 (2) The version thus defended does not contain all the features of
unchallenged claim 4.

55 Claim 4 itself only provides for feature 3.2.3 as an additional feature.
However, it is not directly related back to claim 1, but only to claims 2 and 3, and
thus only protects embodiments which additionally have the supplementary
features of at least one of these claims. Both claim 2 and claim 3 provide for axial
slots.

56 However, feature 3.2.1, which is also provided for in auxiliary requests 4 and
5, expressly excludes such an embodiment. These auxiliary requests therefore
concern subject-matter which differs from that of registered claim 4.

57 b) Contrary to the view of the legal appeal proceedings, the subject matter
defended by auxiliary requests 4 and 5 does not go beyond the original request
for protection.

58 The description of the design of the slots states that they could be axial or
deviate from the axial alignment. In any case, it is essential that they are just wide
enough for optimum heat radiation, whereby they must be so narrow that neither
embers nor flying sparks can pass through them to the outside (para. 8). The slots
could be designed as required, whereby a slot width in the range of 1 to 3 mm is
advantageous (para. 10).

59 It is sufficiently clear from this that the described advantages of the width in
the range of 1 to 3 mm provided for in feature 3.2.2 are independent of whether
the slots are axially or non-axially aligned.

60 c) However, the Patent Court's decision proves to be correct as a result
because the subject-matter defended by auxiliary requests 4 and 5 is also not
protectable for the reasons given by the Patent Court in respect of auxiliary request
2.

61 aa) According to auxiliary request 2, the version of claim 1 defended by the
main request is to be supplemented by feature 3.2.2, which is also provided for in
auxiliary requests 4 and 5.

62 According to the Patent Court's considerations, which were not challenged
in this respect, the requirement that the slots be designed just wide enough for
optimum heat radiation and at the same time narrow enough to prevent embers
or flying sparks from reaching the outside through the slots was suggested by
AS27. As already explained above, this assessment does not reveal any error of
law.

63 bb) On this basis, the range of 1 to 3 mm claimed in auxiliary requests 4
and 5 was also obvious.

64 Based on the requirements of feature 3.2.2, it is possible to determine a
suitable slot width. It is neither claimed nor otherwise apparent that the selection
of the claimed area under these specifications would be unusual or surprising.

65 d) For auxiliary requests 6 to 8, which seek to protect a charcoal chamber
for a table grill with the features from the main request or auxiliary requests 2 and
4 instead of a table grill, there is no different assessment.

66 5 The legal appeal proceedings also unsuccessfully challenges the
Patent Court's decision on costs.

67 a) According to the case law of the Senate, however, the legal concept
of Section 93 Code of Civil Procedure (ZPO) is to be applied accordingly in
utility model cancellation proceedings (Federal Supreme Court BGH,
decision of February 25, 1982 - X ZB 18/81, GRUR 1982, 364 - Figur 3;
judgment of December 8, 1983 - X ZR 15/82, GRUR 1984, 272, 276

- Isolierglasscheibenrandfugenfüllvorrichtung; decision of March 11, 1997 - X ZB 10/95, GRUR 1997, 625, 627 - Einkaufswagen I).

68 As in patent nullity proceedings (see most recently Federal Supreme Court (BGH), judgment of June 27, 2023 - X ZR 59/21, para. 149 - Anzeigemonitor), the application of Section 93 Code of Civil Procedure (ZPO) may be considered in particular if the respondent, who has not given cause to file a request for cancellation, defends the property right only in a limited version and waives the protection beyond that for the past and future.

69 b) Applying these principles, there is generally no reason to file a request for cancellation if the utility model proprietor provides the opponent with a legal position comparable to that after the cancellation of the utility model even before the proceedings are initiated.

70 If the property right is only partially challenged, however, the aforementioned circumstance must be taken into account that the Utility Model Act does not provide for a limitation procedure along the lines of § 64 PatG and a utility model owner is therefore not in a position to limit the subject matter of the property right outside of a cancellation procedure.

71 However, according to the case law of the Senate, a utility model proprietor has the option of filing limited claims for protection in the utility model file and to combine this with a declaration that the request for protection is limited to the new claims. Since the subsequently filed claims become part of the utility model file and anyone is free to inspect this file, the utility model proprietor is obliged, on the basis of such a declaration, to assert protection against anyone only to the extent of the new claims. Even if this does not directly change the subject matter of the utility model, such a declaration is generally to be regarded as an anticipated waiver of an objection to the cancellation of the utility model in its broader scope. Accordingly, the utility model in its registered form is to be canceled upon an admissible request for cancellation without further substantive examination insofar as the registered claims for protection go beyond the claims subsequently filed in the utility model file (Federal Supreme Court, judgment of October 28, 1997 - X ZB 11/94, BGHZ 137, 60 = GRUR 1998, 910 juris para. 37 - Scherbeneis).

72 In the context of Section 93 of the Code of Civil Procedure (ZPO), this leads to the conclusion that a utility model proprietor generally does not give rise to a request for cancellation insofar as he has filed amended requests and declared that the request for protection is limited to the new claims.

73 c) If, after making such a declaration, the claimant requests cancellation of the utility model to a greater extent and if this request is successful, application of Section 93 of the Code of Civil Procedure (ZPO) in favor of the respondent is, as a rule, still out of the question.

74 aa) The fact that such an application for cancellation is directed against the registered version must not be to the detriment of the claimant in this constellation.

75 As the Patent Court correctly assumed, the examination in cancellation proceedings must also be based on the registered version of the utility model, if

the utility model owner has already filed amended claims prior to the request for cancellation and has declared that the request for protection is limited to the new claims (Federal Supreme Court, judgment of October 28, 1997 - X ZB 11/94, BGHZ 137, 60 = GRUR 1998, 910, juris para. 35 - Scherbeneis). This is the consequence of the fact that the subject matter of a utility model - just like the subject matter of a patent - can only be changed by an act of public authority (para. 38 above).

76 bb) The application of Section 93 Code of Civil Procedure (ZPO) in favor of the respondent would also be inappropriate in this constellation because the attack against the part of the property right that is only formally to be regarded as an object of examination does not result in any additional costs.

77 The object value of utility model cancellation proceedings - as well as the value of patent nullity or opposition proceedings - is determined by the fair market value of the property right plus any claims for damages incurred (Federal Supreme Court BGH, decision of March 27, 2018 - X ZB 3/15, GRUR 2018, 654 para. 7 - Ratschenschlüssel II).

78 If the utility model proprietor has already filed amended claims before filing a request for cancellation and has declared that the request for protection is limited to the new claims, this generally has the effect of reducing the value of the property right.

79 The value of a utility model is largely determined by the possibility of excluding third parties from using the protected invention and taking legal action against infringements. This possibility is already limited by declarations of the type mentioned. The remaining value generally corresponds to the subject matter resulting from the amended claims. If these claims prove not to be legally valid, it is therefore consistent to impose the costs incurred, which are usually largely determined by the legal fees based on the value in dispute, in full on the respondent.

80 If, on the other hand, the claimant has failed to give the respondent the opportunity to avert a legal dispute by filing amended claims and declaring that the request for protection is limited to the new claims before filing a cancellation

request, and if a limited defense and an associated reduction in value only arises after the cancellation request has been filed, it is consistent to order the claimant to pay a corresponding portion of the costs, provided that the requirements of Section 93 of the Code of Civil Procedure (ZPO) are also met in other respects.

81 d) In the case in dispute, the Patent Court rightly ordered the respondent to pay the costs in full because the defendant had already filed amended claims before the cancellation request and declared that the request for protection was limited to the new claims and therefore the value of the property right had already been reduced accordingly at the time the request was filed.

82 IV The decision on costs for the legal appeal proceedings is based on Section 18 (4) sentence 2 of the German Utility Model Act (GebrMG) in conjunction with Section 109 (1) sentence 2 of the German Patent Act (PatG).

83 V. The determination of the value in dispute is based on Section 51 (1) GKG and the concurring values stated by the parties at the oral hearing before the Patent Court.

84 VI. The Senate does not consider an oral hearing to be necessary (Section 18 (4) sentence 2 of the German Utility Model Act in conjunction with Section 107 (1) German Patent Act (PatG).

Bacher

Deichfuß

Kober-Dehm

Marx

Crummenerl

Lower court:

Federal Patent Court, decision of October 12, 2020 - 35 W (pat) 434/18 -