



FEDERAL SUPREME COURT
IN THE NAME OF THE PEOPLE
JUDGMENT

X ZR 111/19

Published on:
December 7, 2021
Schönthal
Clerk of the Court as clerk
of the court registry

in the patent nullity case

The X. Civil Senate of the Federal Supreme Court ruled as follows at the oral proceedings on December 7, 2021, by the Presiding Judge Dr. Bacher, Judges Hoffmann and Dr. Deichfuß, Judge Dr. Kober-Dehm and Judge Dr. Crummenerl:

On appeal, the judgment of the 5th Senate (Nullity Senate) of the Federal Patent Court of October 15, 2019, is amended.

The action is dismissed.

The plaintiff is ordered to pay the costs of the proceedings.

By law

Facts:

The defendant is the owner of European patent 2 313 243 (patent in suit), which was granted with effect for the Federal Republic of Germany, was filed on May 14, 2009, claiming a Swedish priority of May 16, 2008, and relates to a dispenser housing.

Patent claim 1, to which six further claims are referred back, reads in the process language:

Dispenser housing comprising a dispenser part (20, 90, 100, 110), the dispenser part comprising at least two component parts (17, 18; 31, 32; 41a, 42a; 41b, 42b; 41c, 42c; 41 d, 42d; 51; 61; 71; 91, 92; 101, 102; 111, 112a, 112b; 121a, 121b, 122) each joined by a seam (21; 33; 43a, 43b, 43c, 43d; 93; 103; 113a, 113b; 123a, 123b), said dispenser part (20; 90; 100; 110) comprising a first injection molded plastic component part (17; 31; 41a, 41b, 41c, 41d; 51; 61; 71; 91; 101; 111; 121a, 121b) with an associated first mating surface; a second injection molded plastic component part (18; 32; 42a, 42b, 42c, 42d; 92; 102; 112a, 112b; 122) having an associated second mating surface; a seam (21; 33; 43a, 43b, 43c, 43d; 93; 103; 113a, 113b; 123a, 123b) is formed by said first mating surface and said second mating surface during injection molding for joining said first component part (17; 31; 41a, 41b, 41c, 41d; 51; 61; 71; 91; 101; 111; 121a, 121b) and said second component part (18; 32; 42a, 42b, 42c, 42d; 92; 102; 112a, 112b; 122) to define the dispenser part (20; 90; 100; 110), each component part (17, 18; 31, 32; 41a, 42a; 41b, 42b; 41c, 42c; 41d, 42d; 51; 61; 71; 91, 92; 101, 102; 111, 112a, 112b; 121a, 121b, 122) comprising a front surface, a first and a second side surface each having an edge facing away from the front surface, wherein the resulting seam (21; 33; 43a, 43b, 43c, 43d; 93; 103; 113a, 113b; 123a, 123b) extends from a side edge of a first side surface of the dispenser part to a side edge of a second side surface of the dispenser part, characterized in that the dispenser part (20; 90; 100; 110) is detachably joined to a rear dispenser section (96; 106; 116), in order to form the dispenser housing (97; 107; 117), wherein the rear dispenser section (96; 106; 116) is arranged to be mounted on a vertical wall, and wherein the dispenser housing (97; 107; 117) is for a dispenser for a stack of paper towels or a roll of paper.

The plaintiff claimed that the subject matter of the patent in suit was not patentable. The defendant defended the patent in suit as granted and, in the alternative, in sixteen amended versions.

The patent court declared the patent in suit null and void. The defendant appeals against this decision and continues to defend the patent in suit in the version granted and - in an amended order - with its first-instance claims and 34 additional auxiliary claims. The plaintiff opposes the appeal.

Reasons for Decision:

The admissible appeal is well-founded and leads to the dismissal of the action.

I. The patent in suit concerns a dispenser housing for paper towels.

1. According to the statements in the patent specification, it may be desirable for various reasons to provide a dispenser part in which at least the outer surface, the shell or a comparable part is made of two similar or different plastics. For example, it may be conceivable to make a portion of the dispenser part transparent to facilitate checking the level of the consumable contained in the dispenser. A second section could be opaque in design to conceal a dispensing mechanism and give the dispenser an aesthetically pleasing appearance.

For the production of such a dispenser part, the first component is usually produced by injection molding in a first mold. It is then transferred to a second mold, where it is joined to a further component which is then injected. This can result in warpage of at least the first component and the seam, particularly in or near the areas of the side edges. The components are generally joined end-to-end; even with local reinforcements, the joint seam may lack sufficient stability to withstand the expected forces.

2. Against this background, the patent in suit concerns the technical problem of providing a dispenser housing with a dispenser part made of different plastic components which has low distortion and high strength.

3. In order to solve this problem, the patent in suit proposes in claim 1 a dispenser housing, the features of which can be structured as follows (the deviating structure in the first instance judgment is reproduced in square brackets):

The dispenser housing (97)

1. is intended for a dispenser for paper towels from a stack or roll [1.9] and

2. has a dispenser part (20) with at least two component parts (17, 18) [1.1].

3. the two component parts (17, 18)

a) show in each case:

(1) a connecting surface [1.2, 1.3],

(2) a front surface [1.5],

(3) a first and a second side surface, each having an edge facing away from the front surface [1.6].

b) are connected by a seam (21) [1.1.1], which is

(1) formed by the first bonding surface and the second - bonding surface during injection molding for bonding the first component part (17) and the second component part (18) to define the dispenser part (20) [1.4],

(2) extended from a side edge of a first side surface of the dispenser part to a side edge of a second side surface of the dispenser part [1.7].

4. the dispenser part is removably connected to a rear dispenser section (96) to form the dispenser housing (97) [1.8].

5. the rear dispenser section (96) is set up for mounting on a vertical wall [1.8.1].

4. Some features require further discussion.

a) A dispenser part within the meaning of feature 2 must be a component that significantly shapes the structure of the dispenser housing.

aa) According to the description of the patent in suit, however, parts which are arranged inside the housing and are not visible from the outside can also be considered as dispenser parts (para. 10).

A counterpart to this is the rear dispenser section (96) characterized in features 4 and 5, which enables mounting on a wall and to which the dispenser part can be removably connected.

bb) Nevertheless, not every component of the dispenser that can be connected to the rear dispenser section is to be considered a dispenser part within the meaning of feature 2.

According to the description of the patent in suit, dispenser parts are to be understood as structural parts of the dispenser (para. 9). In the embodiments, this requirement is fulfilled by the fact that the dispenser part consisting of two or three components forms the front and side surfaces of the dispenser. As has been pointed out above, it is true that components inside the dispenser may also be considered. However, it follows from the requirement that these must be structural parts, against the background of the embodiment examples, that they must have a formative character for the spatial-physical design of the dispenser housing as a whole.

b) Corresponding requirements apply to the component parts as defined in feature 3.

According to the description of the patent in suit, a component part is any component that is joined to one or more other component parts to form a donor part (para. 9).

From this, against the background of the embodiment examples, it can be seen that the individual component parts must also be structural parts in the sense shown above.

c) It follows from features 3 a (2) and 3 a (3) that the two component parts belonging to the dispenser part are designed as a three-dimensional shape, the outline of which is essentially in the form of a U with, if necessary, more or less beveled legs.

aa) This understanding is supported by the embodiments of component parts and dispensers shown in the figures reproduced below.

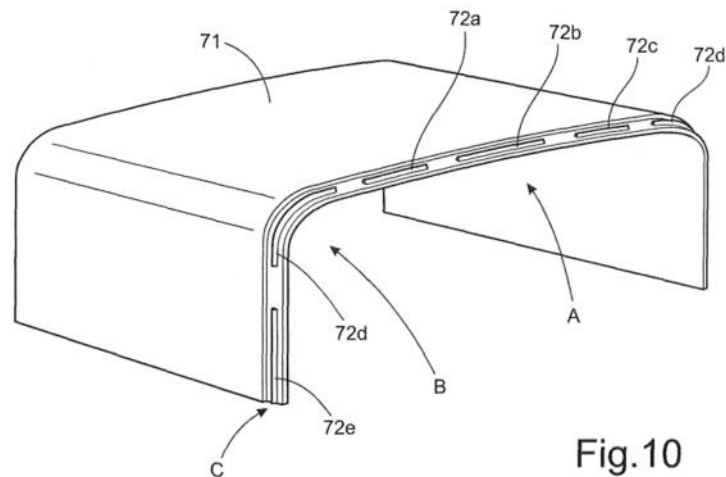


Fig.10

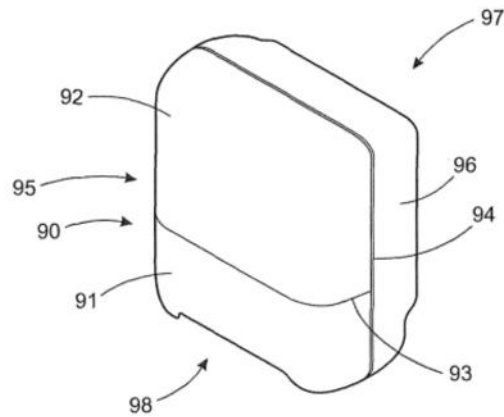


Fig.13

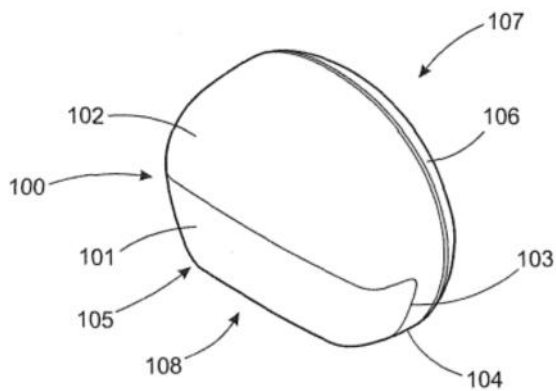


Fig.14

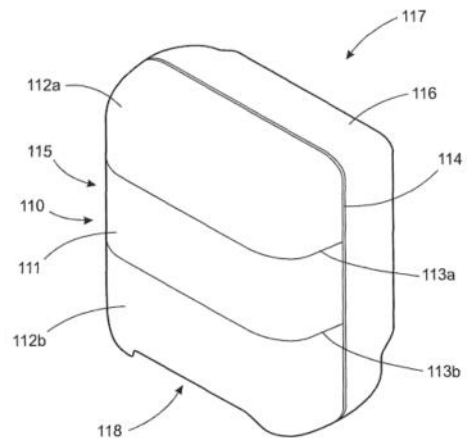


Fig.15

As can be seen from Figures 13 and 15 and in particular from Figure 14, the transitions between the three surfaces can be continuous. According to feature 3 a (3), the decisive factor in this respect is that the two side faces have (at least) one edge facing away from the front face. To meet this requirement, the side faces must run at least in substantial parts in a plane that deviates from the main plane of the front face.

The representation of a donor part shown in Figure 2 reproduced below does not lead to a different assessment, contrary to the opinion of the plaintiff.

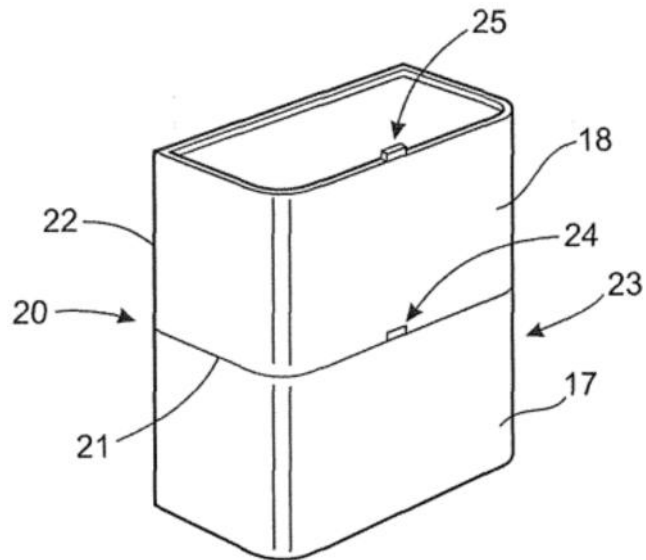


Fig.2

The illustration in Figure 2 may in itself support the conclusion postulated by the plaintiff that the component parts of the dispenser part can also be of closed design, for example in the form of an O. However, this understanding is not consistent with the explanations in the description referring to Figure 2.

In the explanations to Figure 2, it is stated that the seam (21) connecting the component parts (17, 18) runs from one side edge (22) to a second side edge (23) of the dispenser part (20) (par. 59). This is consistent with the description of the other embodiments and indicates that the seam ends at the two side edges (22, 23). If these two side edges were connected in the area of the seam by a back wall, it would make sense to make the seam circumferential.

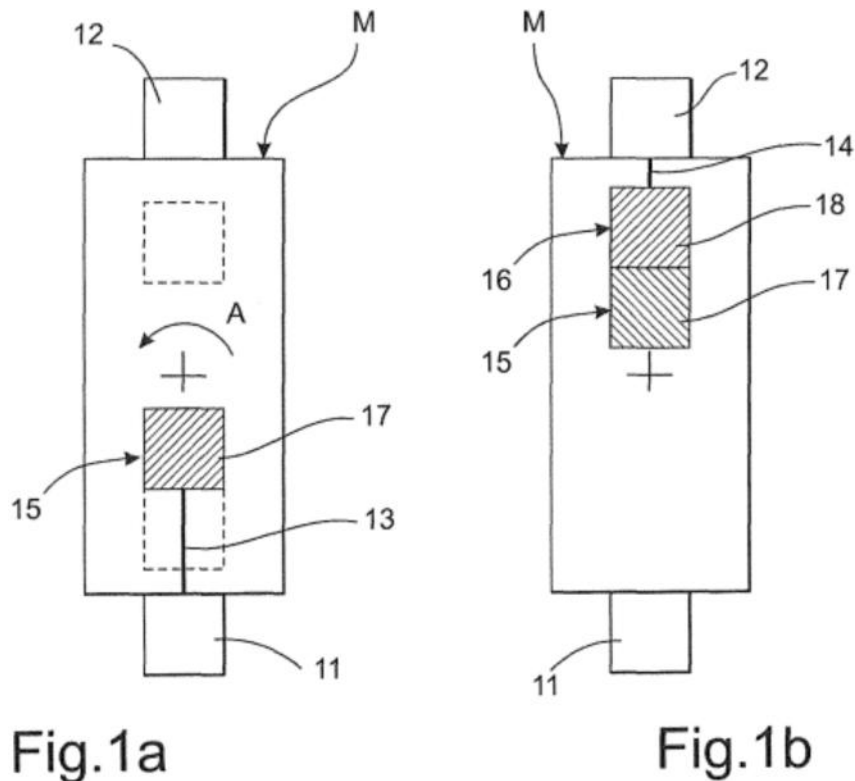
In view of the overall context of the description and in view of the explanations of the individual embodiments, which are consistent in this respect, this contradiction is to be resolved to the effect that the component parts must in principle have a U-shape. In contrast, no decisive significance can be attached to the graphic representation in Figure 2, especially since the description states that this is only a schematic illustration (paragraph 59).

bb) It can also be seen from Figures 13 to 15 that the component parts can also have other surfaces, such as an upper surface, as shown for the upper component part in all three embodiment examples.

d) The seam joining the two component parts is characterized in feature group 3 b by its method of manufacture and its course.

aa) According to feature 3 b (1), the seam must be formed during injection molding to join the two component parts. The more detailed design of this manufacturing step is left to the person skilled in the art.

(1) In the description, the turning technique is named as a particularly suitable manufacturing method for this purpose. This process is shown schematically in Figures 1a and 1b below.



In this process, the material for forming the first component (17) is injected from an injection unit (11) via a sprue manifold (13) into a cavity (15). The moving part of the mold then rotates 180° to the position shown in Figure 1b and releases a second cavity - which is closed during production of the first component. The material for manufacturing the second component (18) is injected into this cavity via a second sprue distributor (14) from the injection unit (12) (paras. 11, 57-58, 100).

As an alternative method, the description mentions the core back technique. In this technique, the cavity for the second component is blocked by a movable slide when the first component is injected (par. 101).

- (2) Patent claim 1 does not specify one of these methods.

According to the description of the patent in suit, the two methods presented as suitable have the advantage that the first component remains in the tool and thus deformations can be better avoided (para. 26 lines 52-54). However, this requirement has not been reflected in the patent claim.

According to the description of the patent in suit, the avoidance of deformations is indeed one of the objectives of the patent in suit. However, the means used in the embodiments to achieve this goal are not necessarily provided for in patent claim 1.

bb) According to feature 3 b (2), the seam must extend from a side edge of the first side surface to a side edge of the second side surface of the dispenser part.

(1) It follows from this that the seam connecting the two component parts has a starting point and an end point corresponding to the U-shaped ground plan of the component parts, i.e. it is not circumferential. Contrary to the plaintiff's view, this also applies to the embodiment example shown in Figure 14, for which it is stated in the description, in accordance with feature 3 b (2), that the seam (103) extends from a first side edge (104) to a second side edge (105) of the dispenser part (100) (para. 84).

(2) These side edges may be identical to the edges provided in feature 3 a (3), as is the case in Figures 10, 13 and 15 shown above. However, it can be seen from the embodiment example shown in Figure 14 that it can also be a different edge of the side surface.

The edge (104) shown in Figure 14, from which the seam (103) extends to the corresponding edge (105) on the opposite side, forms the lower side edge of the side surface of the dispenser part (100) and therefore realizes feature 3 b (2). It also forms a side edge of the side surface of the lower component part (101). However, this side edge extends to the front surface of this component part and is therefore not turned away from this surface, contrary to the specification in feature 3 a (3). Feature 3 a (3), on the other hand, is realized by the perpendicularly extending edge which adjoins the edge (104).

(3) As the appeal rightly claims, features 3 a (3) and 3 b (2) also differ in that, according to feature 3 b (2), it is not only a side edge of a component part that must be involved, but at the same time a side edge of the donor part.

This is also consistent with the embodiment shown in Figure 14.

The edges (104, 105) between which the seam (103) extends also form a side edge of the dispenser part (100). In contrast, the vertically extending edge adjoining the edge (104), which realizes feature 3 a (3), forms only a side edge of the lower component part (101).

e) With regard to the shape of the seam, the selection of the plastics used for the component parts and with regard to the stability of the seam and housing, patent claim 1 - despite the extensive and detailed explanations which the description contains on these points - does not contain any more detailed specifications.

II. The patent court gave the following main reasons for its decision:

The subject-matter of patent claim 1 as granted is not based on inventive step. This subject-matter is obtained by the skilled person, an engineer specializing in mechanical engineering or plastics technology with a degree from a university of applied sciences or a comparable degree and several years of professional experience in the product development of receptacles, who is skilled in the shaping of plastics and consults a skilled person in injection molding technology, starting from international patent application 2006/054965 (Ni3) by combining it with international patent application 99/18835 (Ni4).

Ni3 discloses a dispenser for dispensing paper towels provided as a roll with the features 1, 2, 3 a (1) and (2) as well as 3 b (1). Also disclosed are features 4 and 5. With the term hinge structure, Ni3 also discloses structures in which the cover can not only be pivoted but also removed. Features 3 a (3) and 3 b (2) were not disclosed.

Ni4 discloses a dispenser for towel rolls with internal pull-out having the features 2 and 3 b. An injection molding of the second component part onto a first, previously injection molded component part is not explicitly disclosed. However, the person skilled in the art envisages injection molding as the primary manufacturing process and will also consider integral gating of the cover and base as an alternative to plastic welding, provided this is feasible in terms of demolding. The latter is not to be assumed for the design examples shown in the figures of Ni4. However, at least for the arrangement of a window in an opaque cover, which is also disclosed as a possible embodiment in Ni4, the person skilled in the art would readily consider integral gating, especially since this is also provided for in Ni3. In the embodiments shown in Figures 1, 17, 25 and 26 in Ni4, both components had a front surface facing the user in the sense of feature 3 a (2) and side surfaces with edges in the sense of feature 3 a (3).

The skilled person who, starting from Ni3, wishes to further develop a dispenser housing both technically and in terms of design, sees advantages in the embodiment disclosed in Ni4 which he can use for the design of the cover of the housing shown in Ni3. He had reason to adopt the window geometry of the design variants shown in Figures 25 and 26 of Ni4, with the seam running from the first to the second side edge, for the upper part of the cover of the dispenser housing of Ni3 and to extend it to its entire side area, because this would also result in an improved view of the fill level in Ni3 due to the enlarged window and a more attractive design could be realized. The skilled person is also encouraged to - produce the enlarged transparent component part by gating the second component onto the first component and to apply this gating technique, which he is familiar with from the Ni3, also to an enlarged seam, since the Ni4 discloses an integral design and thus already implies the gating of two components. As long as the two material components did not exhibit any significant thermal expansion coefficients, the skilled person would not expect any major problems. The course of the seam between the two plastic components is determined by functional and design aspects. A change in the course of the seam does not require the overcoming of technically relevant difficulties and is therefore not based on inventive step.

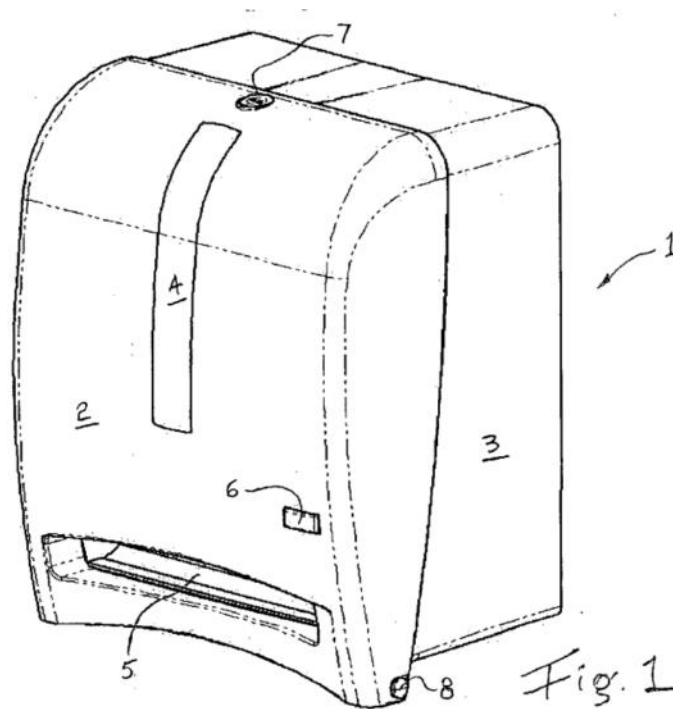
III This assessment does not withstand review on appeal in one crucial respect.

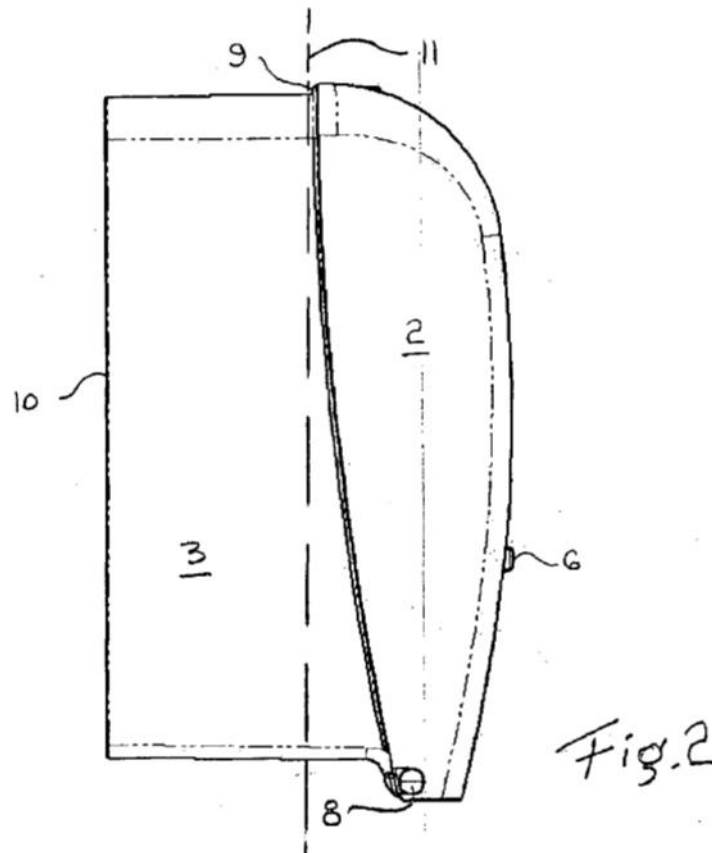
Contrary to the opinion of the patent court, the subject matter of patent claim 1 as granted is not suggested by Ni3 or by a combination of Ni3 with Ni4.

1. The Patent Court correctly held that Ni3 does not fully disclose the subject matter of claim 1 as granted.

a) Ni3 discloses a dispenser for paper rolls.

An example of an embodiment is shown in perspective in Figure 1 reproduced below and in side view in Figure 2.





The dispenser (1) includes a body (3) and a cover (2).

The body (3) consists of a rear section with upper and lower surfaces, side surfaces and a rear mounting surface (10). It can at least partially accommodate a roll of paper to be placed in the dispenser and is suitable for mounting in a niche or on a wall (p. 3 line 1015; p. 7 line 20 to p. 8 line 4).

The cover (2) may have a recessed transparent viewing window (4) in addition to a dispensing opening (5) and a sensor (6) abutting the dispensing of a towel (p. 5 lines 18-19). In this case, the cover is either opaque or translucent over most of its surface. In one preferred design, it is manufactured together with the window using a two-component injection molding process in order to better integrate the window into the cover (p. 7 lines 6-12).

The cover (2) is pivotally connected to the body (3) by means of first and second hinge structures (8), for example in the form of hinge pins, and can therefore be opened for maintenance or replacement of the paper roll (p. 3 lines 17-22). Alternatively, any other embodiment that allows pivoting can be considered, for example, forming projections on the body (3) that engage openings in the cover (2) (p. 5 line 813). In the closed state, the cover is held on the body (3) by means of a locking structure (7) (p. 3 lines 22-24).

b) Thus, as the patent court correctly assumed and the defendant also does not doubt, features 1, 2, 3 a (1) and (2) as well as 3 b (1) are disclosed.

c) The patent court also rightly decided that features 4 and 5 are disclosed.

It is not expressly disclosed in Ni3 that the cover (2) is not only pivotable but also removable. However, it is sufficiently clear from the explanations, according to which any embodiment which allows pivoting can be considered, that hinges in which one of the pivoted parts can be removed are also considered. This is consistent with the example given as an alternative, in which projections on the body (3) engage in recesses in the cover (2). In any case, this embodiment allows the cover to be removed if its side walls have a certain flexibility.

d) Feature 3 a (3), on the other hand, is not disclosed - as the patent court rightly decided and the plaintiff does not question.

In the embodiment example shown in Figure 1 of Ni3, the viewing window (4) extends from the center of the front to the top of the cover (2). As the patent court rightly assumed, the area of the window (4) running along the upper side can

indeed also be regarded as a side surface with an edge facing away from the front. However, the window (4) does not have a second side surface with these features.

e) Also not disclosed is feature 3 b (2).

There is a lack of disclosure of this feature simply because the seam extending between the window (4) and the remainder of the cover (2) does not extend to a side edge of the dispenser portion.

As already explained above, it is neither necessary nor sufficient that the seam extends to an edge within the meaning of feature 3 a (3). Rather, it is necessary that the seam extends between two side edges of the dispenser part.

In the device disclosed in Ni3, the seam would consequently have to run between two side edges of the cover (2). Ni3 does not show such a design.

2. The subject matter of claim 1 was not suggested by Ni3 or by a combination of Ni3 with Ni4.

a) As already explained above, Ni3 discloses embodiments with a cover (2) consisting of two different components joined by injection molding only in such a way that one viewing window is completely surrounded by the other part of the cover. This did not give rise to any reason to arrange the viewing window (4) in such a way that its side edges on both side surfaces simultaneously form the side edges of the cover (2).

b) A supplementary reference to Ni4 also did not give rise to any suggestions with respect to the subject-matter of the patent in suit.

aa) Ni4 discloses a dispenser for rolls of paper with an internal drawer mounted vertically in the dispenser. An example of an embodiment is shown in Figure 1 reproduced below.

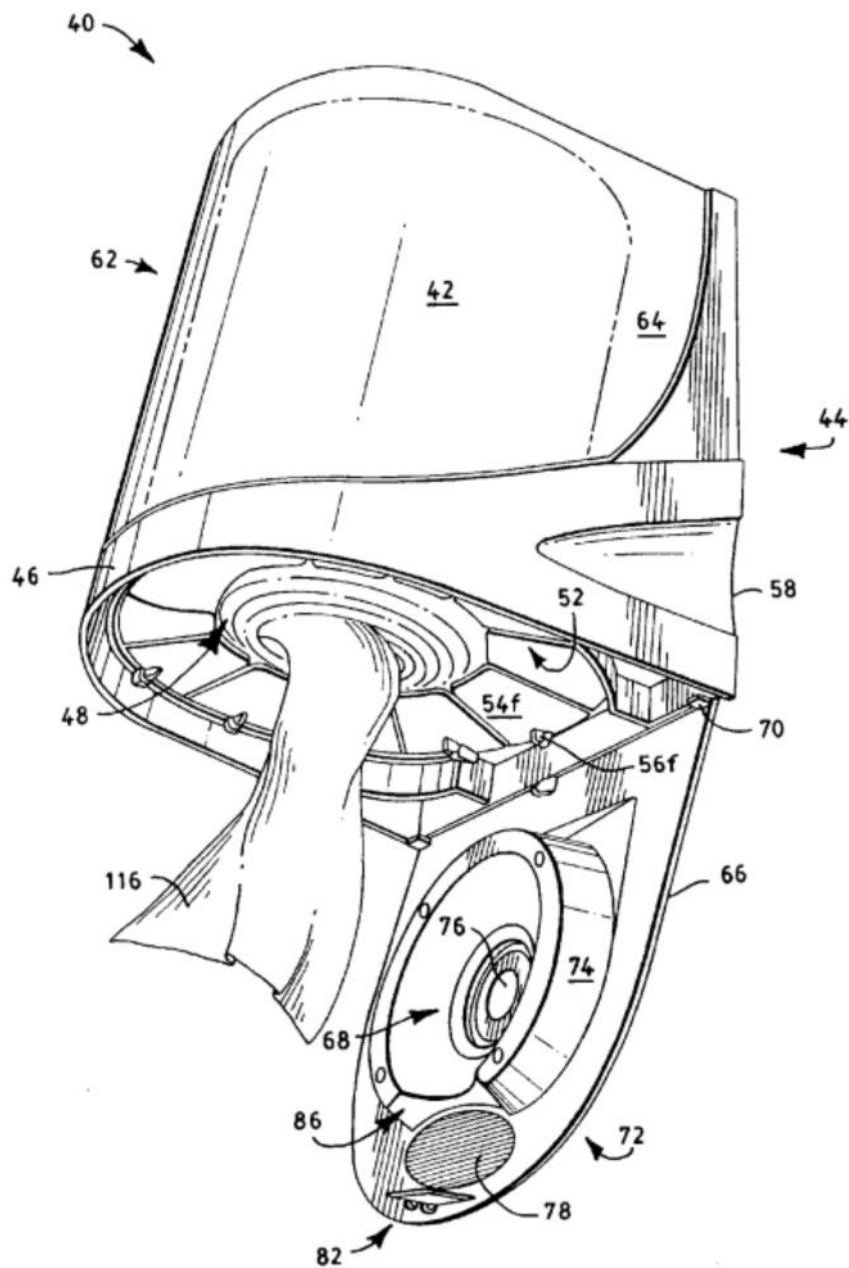


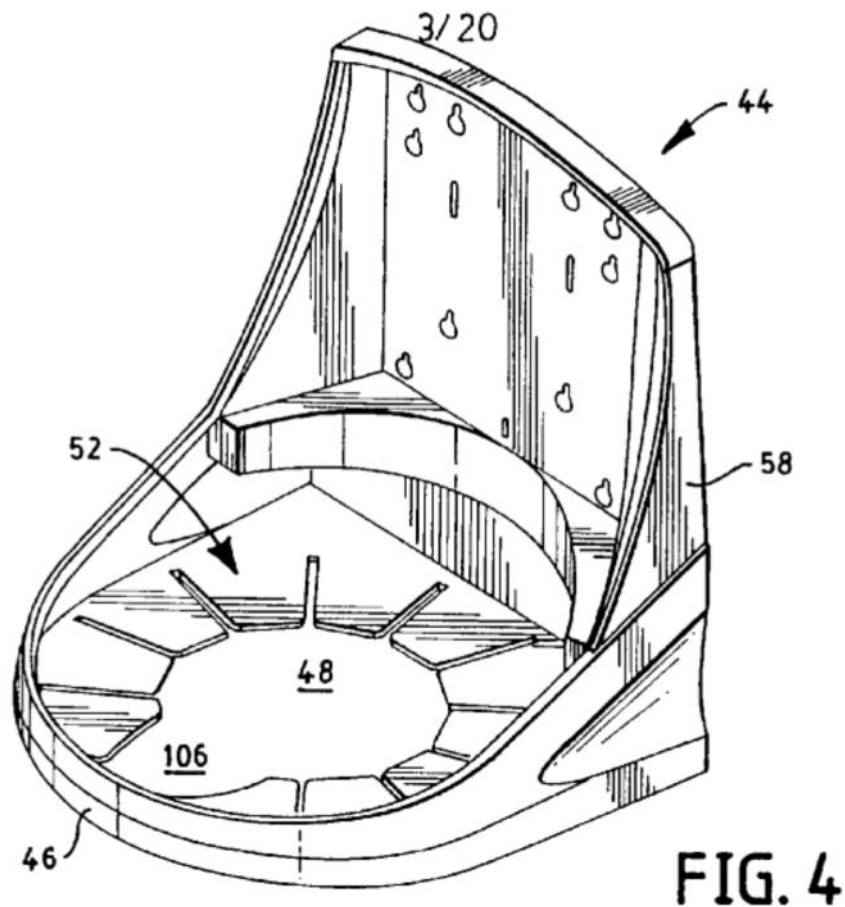
FIG. 1

The dispenser consists essentially of a base (44), a cover (62), a flap (66), a securing device (52), a fastening device (58), and a latch (82).

The base (44) and the cover (62) form a cavity for receiving a paper roll (42). The two parts may be joined by bonding, by mechanical fasteners, or by welding. The cover (62) may also be loosely attached over or integral with the base (44) (p. 7 lines 20-32).

Both parts can be made of different plastics (p. 7 lines 26-28). For example, the cover (62) can be made of a semi-transparent material in order to be able to see and control the paper roll and thus the filling level. Alternatively, a design is also possible in which the cover (62) is made of an opaque material which optionally encloses a transparent material serving as a window (p. 7 line 32 to p. 8 line 1-2; p. 14 line 4-8).

The base (44) of this embodiment is shown in Figure 4 reproduced below.



bb) As the patent court also did not misjudge in its approach, features 3 a (3) and 3 b (2) are thus not disclosed.

The cover (62) of the device disclosed in Ni4 corresponds to the dispenser part within the meaning of the patent in suit. For this component, Ni4 discloses an embodiment with two different materials only in the form that a window of transparent material is enclosed by a component of opaque material. This corresponds to the design disclosed in Ni3 and does not disclose features 3 a (3) and 3 b (2) for the reasons already pointed out above.

cc) For the person skilled in the art who, starting from Ni3, strives to improve the visibility and thus the control of the filling level and the appearance of a dispenser housing, the most that resulted from Ni4 was the suggestion to make

the cover of the dispenser disclosed in Ni3 completely translucent. This would not have led him to a design with features 3 a (3) and 3 b (2).

dd) Whether the suggestion arose from Ni4 to design the spatial arrangement of the window in the cover (62) along the lines of the arrangement of the cover (62) in relation to the base (44) does not require a final decision. Such a design also does not fulfill features 3 a (3) and 3 b (2).

With such an arrangement of the window, it would indeed extend over the front and the top of the cover (62). However, its side edge located on the upper side would not form a side edge of the cover at the same time.

As can be seen from Figure 4 above, the cover (62) is surrounded by the base (44) on all sides, i.e. also on the side facing the wall. Adopting this design for a window integrated into the cover would therefore not have changed the fact that the window is surrounded all around by the opaque part of the cover.

IV. The contested decision does not prove to be correct in result for other reasons (Sec. 119 (1) Patent Law).

1. European patent application 2 313 243 (Ni2), published after the filing date of the patent in suit, does not anticipate the subject-matter of claim 1.

a) Ni2 discloses an arrangement (S) that can be attached to the dispensing opening of a conventional paper roll dispenser (D) to prevent water or other liquids, such as cleaning agents, from entering the dispenser.

A paper dispenser (D) with an arrangement (S) attached thereto is shown in Figures 2A and 2B reproduced below, and an embodiment of an arrangement (S) is shown in Figures 4 and 5 reproduced below.

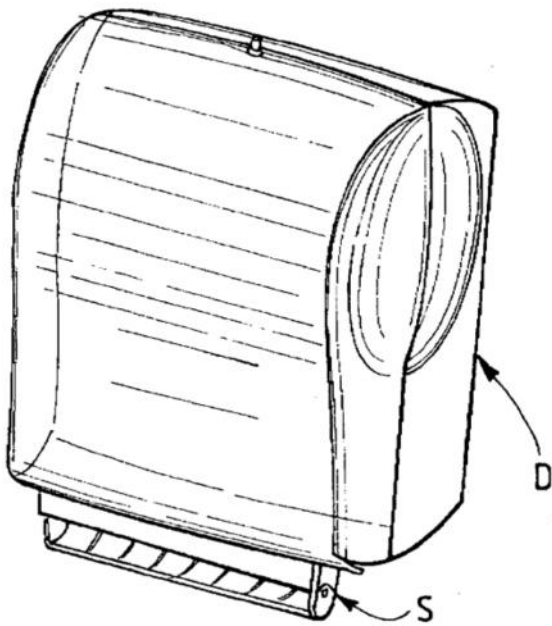


FIG. 2A

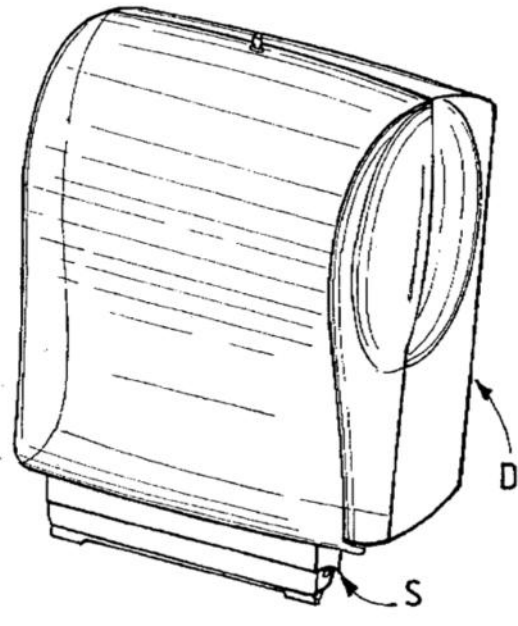


FIG. 2B

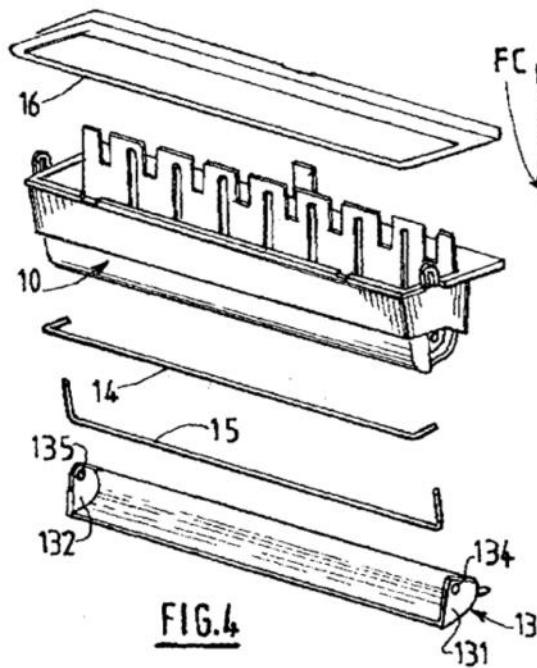


FIG. 4

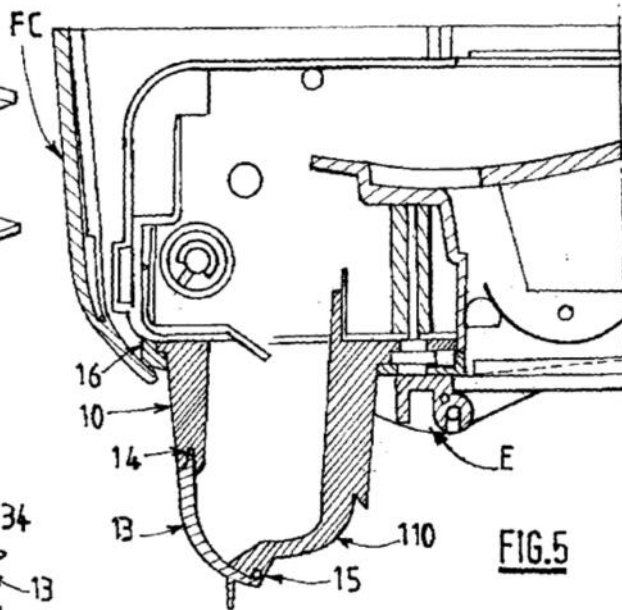


FIG. 5

The assembly (S) comprises a housing (10) mounted on the underside of the dispenser (D) for guiding the paper out of the dispensing opening, a chute flap (13) movable between an open and a closed position, a paper chute seal (16) mounted between the housing (10) and the dispensing opening, and two seals (14, 15) between the housing (10) and the chute flap (13) for preventing water from entering the dispenser (para. 22). The manhole flap (13) and the associated seal can be manufactured in a two-component injection molding process, and also by co-injection (bi-injection) in a common mold (par. 54 f.). The same applies to the housing and the associated seal (par. 56).

b) Thus, there is in any case no disclosure of the combination of feature 2 and feature group 3.

aa) It can be left open whether the unit consisting of the housing (10), the manhole cover (13) and the seals (14, 15, 16) can be regarded as a dispenser part within the meaning of feature 2. In any case, the housing and the manhole cover can at most be regarded as component parts within the meaning of this feature. For these two parts, a connection according to feature group 3 is not disclosed in Ni2.

In the list of parts which can be considered for such a connection (para. 55), the three components mentioned are listed without further differentiation. However, the connection of the housing (10) and the shaft flap (13) with a seam within the meaning of feature group 3 b cannot be considered, if only because the flap (13) must be pivotable relative to the housing (10).

bb) Such a connection may be disclosed for the seals (14, 15, 16). However, these parts do not form structural components within the meaning of the definition of feature 2 shown above.

2. The subject-matter of patent claim 1 as granted is also not anticipated by the prior use of a paper dispenser of the K . company with the model number ... (set of exhibits Ni17c-e and set of exhibits Ni18a-f).

It can be left open here whether this prior use was obvious and whether the documents submitted by the plaintiff in addition to its first-instance submission in the appellate instance (appendix volume Ni18a-f) are to be taken into account or rejected as belated. Neither from the documents submitted in the first instance nor from the supplementary submissions in the appeal instance does a disclosure of features 3 a (3) and 3 b (2) arise.

a) From the figures provided, it can be seen that the cover of the dispenser is made of opaque plastic material and has a transparent window inserted at the front, which is surrounded by the rest of the cover on three sides at the front, extends a little way into the bottom surface beyond the lower edge at the bottom and is surrounded by its edge.

b) This corresponds to the design disclosed in Ni3 and thus also does not disclose features 3 a (3) and 3 b (2).

Feature 3 a (3) is not disclosed because the window with the extension over the bottom edge into the bottom surface has, at most, a side surface with an edge facing away from the front surface.

Feature 3 b (2) is not disclosed because the seam with which the window is inserted into the cover of the dispenser does not extend to a side edge of the dispenser part. Rather, as in Ni3, the window is framed on all four sides by the component of opaque material surrounding it.

3. The subject-matter of claim 1 was also not suggested by the further prior art.

a) Ni2 has to be disregarded in the assessment of inventive step, since this citation was published only after the application for the patent in suit.

b) From the claimed prior use there was no suggestion to further develop this paper dispenser in the direction of the patent in suit.

The window provided on this dispenser allows the fill level to be checked without further ado. In view of this, there was no reason to extend the window to the side surfaces of the cover and to arrange it so that it is not framed on at least one side by the other component, which is made of opaque material.

c) Contrary to the opinion of the plaintiff, a further suggestion did not result from the Japanese patent application Sho 59-133029 (Ni9, German translation submitted as Ni9-de).

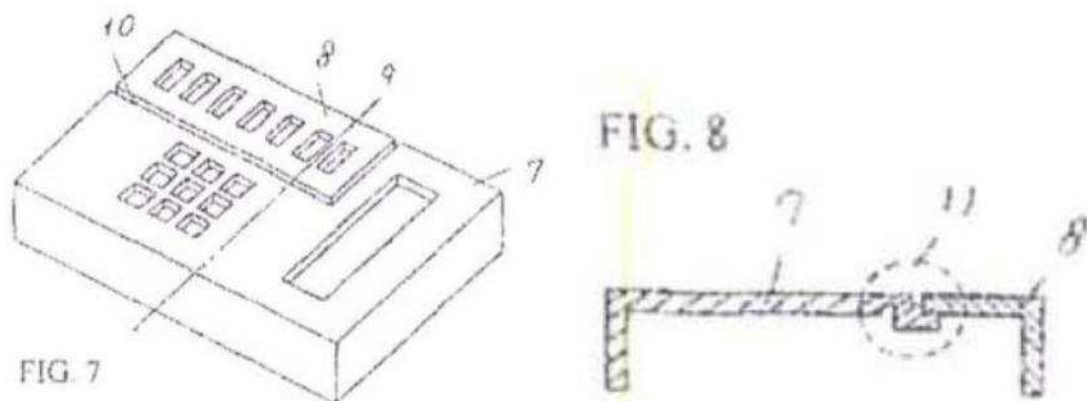
aa) Ni9 discloses a product with integrated component parts molded from resin in different colors and cites the housing of a key telephone as an example of use (Ni9-en p. 2 lines 8-10).

The citation addresses the problem of improving the joint between two component parts made of differently colored material in terms of aesthetic appearance and flexural strength. According to the description of Ni9, ultrasonic welding, which is used in the prior art for the production of such a joint, has the disadvantage, apart from the cost intensity, that on the one hand the external appearance is impaired, because burrs are formed at the joint line in this process, but that on the other hand the stability of the joint suffers if the burrs are removed

(Ni9-en p. 3 lines 3-17; p. 4 lines 13-15). With injection molding in the conventional form, there is a risk that the joint seam is not straight and the bending strength is low (Ni9-de p. 3 line 18 to p. 4 line 12).

To solve this, Ni9 proposes to provide the connecting surface of one component part (7) with steps and to connect the second component part (8) to this stepped surface by injection molding (Ni9-en p. 5 lines 1-5).

An example of an embodiment is shown in Figure 7 reproduced below, and a cross-sectional view along line 9 drawn in Figure 7 is shown in Figure 8.



bb) Thus, feature group 3 is fully disclosed.

The seam between the two component parts runs from the side edge of one side face to the side edge of an adjacent face.

cc) It follows from this, as the plaintiff correctly asserts in this respect, that the possibility of joining two plastic parts with such a seam was known in the prior art and that designs were also already available which ensured sufficient stability of the seam.

Even if it is assumed that corresponding options were also available for the housing of a paper dispenser, this does not result in the suggestion, contrary to the plaintiff's view, that the paper dispenser disclosed in Ni3 be designed accordingly.

A particular technical design is not obvious simply because it is technically possible. A more far-reaching suggestion to use the possibility disclosed in Ni9 for a paper dispenser along the lines of Ni3 does not result from either Ni9 or Ni3.

d) Further suggestions could at most have resulted from the effort cited by the patent court in connection with Ni3 and Ni4 to design the dispenser in a visually appealing manner if there had been concrete examples in which the window was designed according to feature group 3a. Such examples did not result from Ni3 and Ni4 or from other citations.

The division of the dispenser part into at least two component parts opens up design possibilities, for example the combination of transparent and opaque materials, which are not necessarily exhausted in design aspects, so that the subject-matter of the patent in suit cannot be denied to be based on inventive step.

V. The legal dispute is ripe for final decision (Sec. 119 (5), 2nd sentence, Patent Law).

It follows from the above considerations that the subject-matter of the patent in suit is patentable. The action must therefore be dismissed.

VI The decision on costs is based on Sec. 121 (2) Patent Act and Sec. 91 (1) ZPO.

Bacher

Hoffmann

Deichfuß

Kober-Dehm

Crummenerl

Lower court:

Federal Patent Court, decision of 15.10.2019 - 5 Ni 2/18 (EP) -