



# **FEDERAL SUPREME COURT**

**IN THE NAME OF THE PEOPLE**

## **JUDGMENT**

X ZR 112/20

Delivered on:  
January 17, 2023  
Schönthal  
Judicial Employee  
as Clerk of the Court  
the Office

in the litigation

The X. Civil Senate of the Federal Supreme Court, at the hearing on January 17, 2023, by the Presiding Judge Dr. Bacher, the Judge Dr. Deichfuß, the Judges Dr. Kober-Dehm and Dr. Marx, and the Judge Dr. Rensen,

ruled:

On appeal by the defendant, the judgment of the 15th Civil Senate of the Düsseldorf Court of Appeal of November 12, 2020 is set aside.

The appeal against the judgment of the 4a. Civil Chamber of the Düsseldorf District Court of January 14, 2014 is dismissed.

The plaintiff shall also bear the costs of the appeals.

By law

Facts of the Case:

1           The plaintiff is the owner of the European Patent 1 659 501 (patent in suit), which concerns a display device with an interface in the swivel joint. The patent in suit, which expired by lapse of time on September 21, 2018, was declared partially invalid by the Patent Court in response to the nullity action brought by the defendant re 2). The Senate dismissed the appeal directed against this (judgment of November 7, 2017 - X ZR 63/15, GRUR 2018, 175 - Digitales Buch). Claim 1 reads as follows in the version it received in the nullity proceedings:

Digital book for reproducing text and/or image information, comprising a casing with a main part (1) and at least one secondary part (2), wherein said main part and said at least one secondary part are arranged such that said casing can be folded open and shut about a folding axis (A) of a swivel joint like a book, a display unit with at least one screen (3, 4), an interface for current supply to the digital book is arranged within said swivel joint, wherein said interface is configured in the form of an electrical connector, wherein said interface comprises a guiding and supplying opening, wherein counter-contacts for current supply are arranged in the guiding and supplying opening, wherein said guiding and supplying opening is configured cylindrically such that the longitudinal axis of the guiding and supplying opening lies co-axially to said folding axis.

2           The defendant re 2) manufactures notebooks which the defendant re 1) distributes in Germany. The embodiments under attack are notebooks of the model series V.     with the series designations FW, FR, TZ, BZ, AW, Z and TT. Samples are submitted as Exhibits BK13, BK14, BK15 and BK16. A model of the TT series is shown in the illustration reproduced below and taken from the statement of complaint:



3           The District Court dismissed the action for injunctive relief, rendering of accounts, recall, destruction, and a declaration of the obligation to pay damages and compensation.

4           In accordance with the plaintiff's most recent motions, the Court of Appeal ordered the defendants to render accounts and to recall, and additionally ordered the defendant re 1) for destruction. It has further found that the action on the merits has been disposed of with regard to the request for injunctive relief and that the defendants are obligated to pay damages.

5           In their appeal, which was allowed by the Senate, the defendants seek to have the judgment of the District Court that dismissed the action reinstated. The plaintiff objects to the appeal.

Reasons for Decision:

6           The admissible appeal is well-founded and leads to the reinstatement of the  
judgment of the court of first instance.

7           I.     The patent in suit concerns a digital book with an interface in the swivel  
joint.

8           1.     According to the statements in the specification of the patent in suit,  
the devices known in the prior art for reproducing book, newspaper and magazine  
information and the like do not enable a technical layman to hold and operate them  
in an uncomplicated and comfortable manner. Laptops and notebooks are not  
sufficiently ergonomic due to their purpose as a work tool and the resulting features  
and require a high operating effort. Electronic books known in the prior art also  
often required cumbersome and time-consuming handling operations. In an  
embodiment known from U.S. Patent Specification 5 534 888, a large number of  
electrical connectors are arranged on the back of the center section. Their  
identification requires technical knowledge. In addition, the device could no longer  
be held by the spine in the manner of a book or placed on a support when electrical  
lines were connected to the connectors.

9           2.     Against this background, the patent in suit concerns the technical  
problem of providing a device for displaying book information and the like which  
enables easier handling and operation.

10          3.     To solve this problem, the patent in suit proposes in claim 1, in the  
version it received in the nullity proceedings, a digital book, the features of which the  
Court of Appeal structured as follows:

1. Digital book for reproducing text and/or image information comprising:
  - a) a casing with a main part (1) and at least one secondary part (2),
  - b) a display unit with at least one screen (3, 4).
2. Said main part and said one secondary part are arranged such that said casing can be folded open and shut about exactly one folding axis (A) of a swivel joint like a book.
3. Within the swivel joint an interface for current supply of the digital book is arranged, which
  - a) is configured in the form of an electrical connector,
  - b) comprises a guiding and supplying opening (7'),
    - (1) in which counter-contacts (8') for the current supply are arranged and
    - (2) which is configured cylindrically such that its longitudinal axis is co-axially with said folding axis.

11           4. The term "digital book" used in the patent in suit means a mobile display device which, due to its special design, is suitable to be handled like a book.

12           a) As the Senate has already pointed out in the nullity proceedings, neither the patent claims nor the description contain an exact definition of which features must be realized in detail for this purpose. However, it follows from the objective stated in the description that the device according to the invention should offer the user the possibility of easy handling that only devices are to be regarded as digital books which, both due to their dimensions and weight and due to the function and arrangement of their operating elements, can be taken to hand in a comparable manner to a conventional, not too bulky and heavy book (BGH, judgment of November 7, 2017 - X ZR 63/15, GRUR 2018, 175, para. 12 - Digitales Buch).

13           Whether a device meets these requirements is to be determined by the trial judge if necessary. Particularly in the case of more modern devices, the above requirements may also be met if the device, due to its other features, can not only be handled like a book but can also optionally be used like a personal computer and can therefore be classified as a laptop or notebook at the same time. However, these requirements are not necessarily met by every mobile electronic device, in particular not by a portable computer which, due to its weight and the arrangement of its controls, is not suitable for being used like a book (loc. cit. para. 15).

14           II.    The Court of Appeal based its decision, insofar as it is relevant to the appeal proceedings, primarily on the following grounds:

15           The embodiments under attack were in accordance with the wording of feature 1.

16           According to the statements in the appeal judgment of the nullity proceedings, notebooks or laptops would not have to be different from a digital book per se, i.e. according to their type, but could be a digital book according to the invention under certain conditions.

17           However, contrary to the plaintiff's view, it cannot be concluded from this that in particular the arrangement of the interface in the swivel joint taught in feature group 3 would already be sufficient to meet the requirements for a digital book. Feature group 3 referred to a digital book in the sense of feature 1 and not generally to a display device or any other electronic device. In this respect, the digital book within the meaning of feature 1 had to fulfill additional criteria upstream of feature group 3.

18           Whether the interface of the embodiments under attack differed from those of previously known laptops and notebooks was not relevant to the decision. Furthermore, it follows from the objective mentioned in the description that laptops and notebooks are not already according to the invention if their dimensions and

weight correspond to a conventional book. Even if the defendants were to be agreed that turning the pages was undoubtedly part of the typical handling of a conventional book and therefore had to be possible by means of corresponding operating elements of the digital book in accordance with the invention, it was not necessary for this handling to take place precisely by means of operating keys on the edge or spine of the device. The specific location is merely the subject matter of subclaim 10, from which it follows in reverse that any arrangement of operating elements suffices across the entire scope of the invention which, according to the overall design of the device, permits handling like a conventional book.

19           The fulfillment of this criterion is not excluded per se if and because a device has a laptop keyboard. Such a restrictive limitation cannot be inferred from the grounds of the judgment under appeal in the nullity proceedings. A device with a full keyboard, which is held like a book and allows turning pages - for example, with various keys on the keyboard - in different situations of use, could therefore be classified as a digital book. Turning pages with control elements that are part of the full keyboard, such as arrow keys or a touchpad, could also be sufficient for this. This applies in any case if the device in question has a lower weight and a lower volume than laptops or notebooks at the time of priority.

20           According to these principles, it must be stated that all the embodiments under attack implement feature 1 literally. These can be taken in the hand while sitting or standing and can be held at the swivel joint with one hand and operated with the other hand. A PDF document displayed in portrait format can be easily scrolled through with one finger using the arrow keys. The same can also be done automatically with the trackpad, the integrated "mouse keys" and the space bar without the user having to install software or program the corresponding keys beforehand.



21           III. This assessment does not stand up to review under the law of  
revision in one decisive point.

22           The reasoning with which the Court of Appeal affirmed a literal infringement  
of the patent in suit is, as the appeal rightly asserts, not capable of supporting the  
contested decision.

23           1. The Court of Appeal correctly assumed that a device that can be used  
as a laptop or notebook can also meet the requirements for a digital book within  
the meaning of feature 1.

24           2. Contrary to the opinion of the court of appeal, it is not sufficient for a  
laptop or notebook that the device can be handled like a book due to its size and  
weight and that the operating elements that are available for the operation of  
mobile computers anyway also enable handling along the lines of a book. In  
addition to a suitable size and a sufficiently low weight, the device must rather  
have special hardware or software components that serve the use for this  
purpose.

25           This requirement results from the comparison between devices that are  
more difficult to operate, such as laptops or notebooks, and handier, easier-to-  
use digital books in the description of the patent in suit, which was already  
decisive for the decision in the nullity proceedings.

26           As the Court of Appeal correctly saw, this does not rule out the possibility  
that a device has all the operating elements that are common in a notebook known  
in the prior art. However, the conclusion to be drawn from the aforementioned  
comparison is that additional means are then required to facilitate use as a digital  
book. As the Court of Appeal also correctly pointed out, it is not sufficient for

features 2 to 3 b to be fulfilled. Rather, additional devices must be present, such as operating keys or software functions that are specially adapted to this purpose.

27           3. It cannot be inferred from the findings of the Court of Appeal that the  
embodiments under attack are configured in this way.

28           According to the findings of the Court of Appeal, the same controls are  
provided for use as a book as are provided for use as a mobile computer. This  
does not satisfy the criteria outlined above.

29           According to the findings of the Court of Appeal, the screen display can be  
rotated 90 degrees so that the screen content can be read in the position of the  
device that is typical for a book. Again, this is a feature that, as the Court of Appeal  
found, has been available on personal computers since the 1990s.

30           The Court of Appeal left open whether the input means are arranged  
particularly close to the edge in the gripping area in all challenged embodiments.  
Even if this requirement were met, this would also not be sufficient for qualification  
as an electronic book. In addition, it would at least be necessary that the individual  
input means are assigned functions that differ from the functions customary for  
use as a notebook or laptop and are of particular importance for ergonomic  
operation when reading books. On the other hand, it is not sufficient if a large part  
of the typically required functions can only be accessed with the aid of the  
keyboard or mouse control intended for use as a computer.

31           IV. The legal dispute is ready for a final decision (Section 563 (3) of the  
Code of Civil Procedure) because supplementary findings are out of the question.

32           The appeal against the first-instance judgment must be rejected because  
the embodiments under attack are not digital books within the meaning of feature  
1.

33           1.    The factual findings of the Court of Appeal do not indicate the  
existence of any special operating means adapted for use as an electronic book in  
the sense described above.

34           2.    The additional features submitted by the plaintiff in response to the  
advice made by the Senate in the decision on approval also do not enable the  
classification of the embodiments under attack as a digital book within the  
meaning of feature 1.

35           a)    However, the arrangement of the accumulator in the swivel joint and the  
arrangement of the interface for recharging at the upper end of the swivel joint can  
help to facilitate the handling of the device along the lines of a book. As explained  
above, however, this is not sufficient.

36           b)    The ability to rotate the screen display by 90 degrees is also not  
sufficient.

37           In this context, it is irrelevant whether this function is provided by a single  
application program or by the operating system and whether the rotation occurs  
automatically as soon as the device is brought into a corresponding position or  
must be triggered manually by the user. Regardless of these details, the mere  
orientation of the screen is not a control element adapted for use as a book in the  
sense shown above.

38           c)    The claim that control elements such as space bar, slidepad or trackball  
can be set up in the system, so that these enabled scrolling of book and

document pages or page-by-page browsing of a book's content is also not capable of leading to a different assessment.

39           The plaintiff does not show which steps are necessary to activate the mentioned functions. Regardless of this, scrolling pages and page-by-page browsing with the help of a keyboard or mouse-like controls are among the functions typically already offered by a notebook or laptop.

40           V.    The decision on costs is based on Section 97 (1) and Section 91 (1) ZPO.

Bacher

Deichfuß

Kober-Dehm

Marx

Rensen

Lower courts:

Düsseldorf District Court, decision of January 14, 2014 - 4a O 207/12 -

Düsseldorf Court of Appeal, decision of November 12, 2020 - I-15 U 77/14 -