



# FEDERAL SUPREME COURT

IN THE NAME OF THE PEOPLE

## JUDGMENT

X ZR 16/20

Pronounced on:  
March 29, 2022  
XXX  
Judicial Employee  
as clerk of the  
Court Registry

in the patent invalidity case

Reference book:    yes  
BGHZ:                no  
BGHR:                yes

Transfer power control method

ZPO Sec. 66 (1), Sec. 265 (2); Patent Act Sec. 30 (3), second sentence

A legal interest in defending a patent challenged by a nullity action already results from the entry in the patent register as the new owner of the patent in suit during the legal dispute.

EPC Art. 83; IntPatÜbkG Art. II Sec. 6 (1) sentence 1 No. 2; Patent Law Sec. 21 (1) No. 2

In order for a person skilled in the art to be able to carry out the invention, the patent specification must indicate at least to some extent by what means and in what way the claimed technical teaching can be realized. This requirement is not met if the patent specification merely states an abstract goal in keywords without even hinting at how this goal can be achieved.

BGH, Judgment of March 29, 2022 - X ZR 16/20 - Federal Patent Court

ECLI:DE:BGH:2022:290322UXZR16.20.0

In response to the oral proceedings of February 15, 2022 the X. Civil Senate of the Federal Supreme Court by Presiding Judge Dr. Bacher, Judges Hoffmann and Dr. Deichfuß, Judge Dr. Kober-Dehm and Judge Dr. Crummenerl

has ruled:

The appeal against the judgment of the 6th Senate (Nullity Senate) of the Federal Patent Court of February 3, 2020 is dismissed.

The costs of both instances are allocated as follows:

The defendant shall bear the extrajudicial costs of the first and second plaintiffs and two-thirds of the court costs.

The third plaintiff shall bear one third of the court costs.

By law

Facts of the Case:

1           The defendant was the registered proprietor of European patent 847 147 (the patent in suit), which was granted with effect in the Federal Republic of Germany and was transferred to the intervener in the course of the legal dispute. The patent in suit was filed in English on December 4, 1997, claiming the priority of a Japanese patent application of December 6, 1996, and has since expired. It relates to a transmission power control method for a spectrum spreading communication system.

2           In previous nullity proceedings, the Patent Court declared the patent in suit partially invalid with effect for the Federal Republic of Germany. Patent claim 1 was given the following wording in this judgment (of May 9, 2012 - 5 Ni 152/09):

A transmission power control method for a spectrum spreading communication system which performs communication between a base station (203) and a plurality of mobile terminals (204) by using a plurality of channels, wherein:

said plurality of channels includes first channels (3) allocated to said mobile terminals for transmitting a data packet to the base station and a second channel (140) used by said base station to transmit a control signal to said mobile terminals, wherein said mobile terminals sharing the second channel, wherein said second channel (140) is a downlink traffic channel;

said base station measures the reception level of a signal received at each of said first channels, generates a transmission power control signal in accordance with the reception level from each of said first channels, and inserts a common transmission power control signal containing said transmission power control signals for said respective first channels collected into a format predetermined for said system into said second channel, and transmits said common transmission power control signal containing said transmission power control signals for each of said first channels over said second channel; and

each mobile terminal receives the transmission power control signal allocated to it on the second channel and controls the transmission power for a signal to be transmitted over a corresponding one of the first channels in accordance with the received transmission power control signal.

3           The plaintiffs, who have been sued by the defendant for infringement of the patent in suit, have argued that the subject matter of claim 1 goes beyond the content of the originally filed documents and is not patentable. In addition, the patent in suit does not disclose the invention clearly and completely enough for a person skilled in the art to carry it out. The defendant defended patent claim 1 as amended and with sixteen auxiliary claims.

4           The patent court declared the patent in suit invalid to the extent requested. The defendant appeals against this decision and continues to pursue its first-instance claims and submits a further auxiliary claim. The first and second plaintiffs oppose the appeal. The third plaintiff withdrew the action during the appeal proceedings. The intervener joined the legal dispute on the side of the defendant.

Reasons for Decision:

5 The admissible appeal is unsuccessful.

6 I. The intervener's intervention is admissible.

7 It already has a legal interest in defending the patent in suit because, with the registration as new proprietor, it has moved into the formal position of obligor and beneficiary pursuant to Sec. 30 (3) sentence 2 Patent Act. The fact that this, in corresponding application of the procedural provision of Sec. 265 (1) sentence 1 ZPO, has no influence on a nullity action initiated prior to the re-registration does not eliminate the legal interest.

8 II. The patent in suit relates to the control of transmission power in a mobile communication system with code division multiple access.

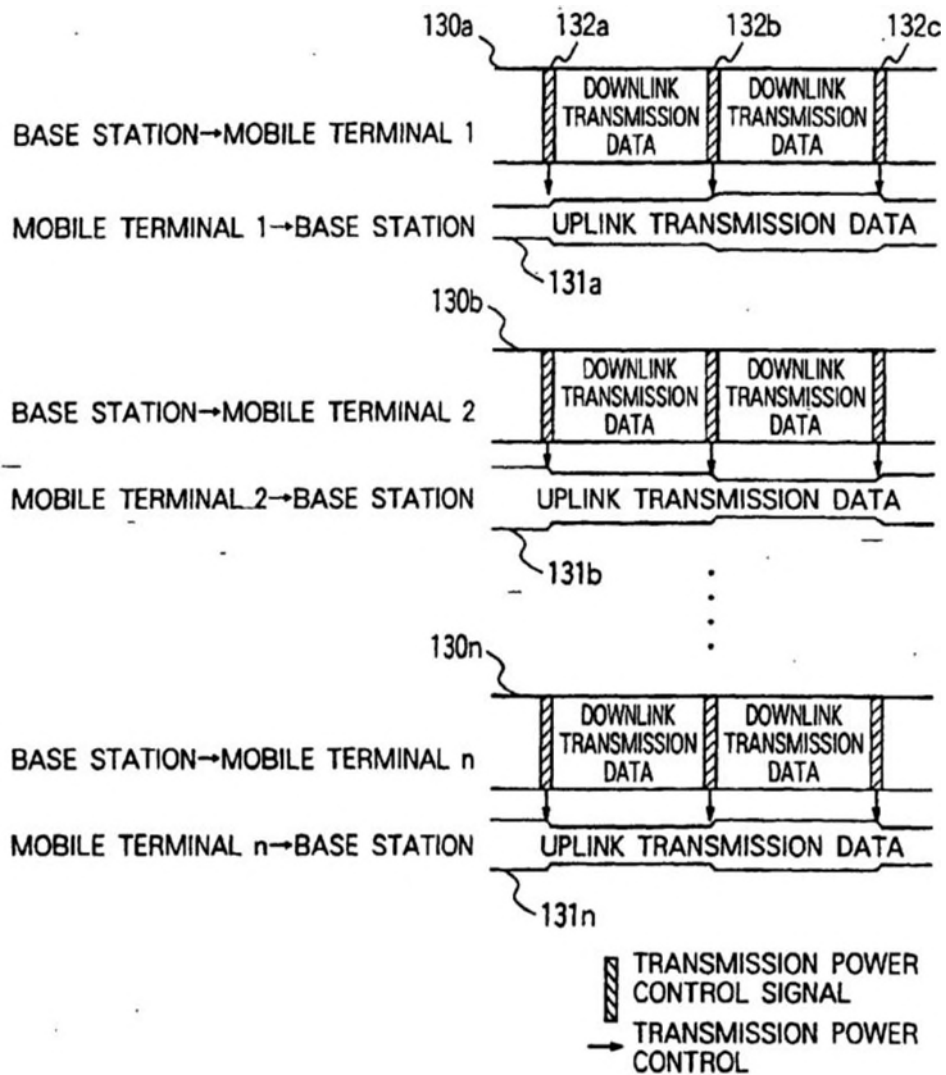
9 1. According to the description of the patent in suit, in a CDMA (Code Division Multiple Access) method, a plurality of mobile terminals share the same frequency band for communication with a base station. This could result in the modulated signal waves of one mobile terminal interfering with the reception of the modulated signal waves of another mobile terminal at the base station, depending on the reception level (para. 2).

10 If the transmission power of each mobile terminal is controlled so that the signal level received at the base station is limited to a minimum necessary reception power, it is possible to maximize the number of uplink channels (para. 3).

11 In the control method known from the IS-95 standard, data is transmitted via paired uplink and downlink channels from a mobile terminal to the base station and vice versa (par. 5, 12). The base station measures the received power of data transmitted from each mobile terminal and generates a control signal based on it. The transmission power control signal is inserted into data to be transmitted from the base

station to a mobile terminal, whereupon the mobile terminal reduces or increases the transmission power according to the received signal (para. 6).

12 Figure 12 of the patent in suit, reproduced below, illustrates this process.



13 The upper row of each pair represents the transmission data (downlink transmission data) of the downlink traffic channel (130a-n) with the control signals (132a, 132b, 132c) inserted by the base station, and the lower row represents the

transmission data of the uplink traffic channel (131a-n). Each mobile terminal changes its transmission power according to the received control signal. The received power at the base station is represented graphically by the width of the bottom row (para. 7 et seq.).

14           The increasing progress of mobile communications technology is leading to a growing need for data communications functions (Par. 10). Unlike voice communication, communication here typically takes place in only one direction. Therefore, adopting the conventional control method with paired uplink and downlink traffic channels is problematic (para. 12). If a paired downlink channel is provided only for controlling the transmission power of the uplink traffic channel, this will result in low utilization efficiency of the traffic channels (para. 13).

15           2.   Against this background, the patent in suit is based on the technical problem of enabling a power control suitable for data communication while using the available resources as efficiently as possible.

16           3.   For solution, the patent in suit in the current version of claim 1 proposes a method, the features of which can be organized as follows (deviations from the granted version are highlighted):

1.   Transmission power control method for a spectrum spreading communication system for communication between a base station (203) and a plurality of mobile terminals (204) by using a plurality of channels.
2.   The plurality of channels includes:
  - 2.1 first channels (3) allocated to said mobile terminals for transmitting a data packet to the base station,
  - 2.2 a second channel (140) used by said base station to transmit a control signal to said mobile terminals,

2.3 being shared by said mobile terminals,

2.4 which is a downlink traffic channel.

3. The base station

3.1 measures the reception level of a signal received at each of said first channels,

3.2 generates a transmission power control signal in accordance with the reception level from each first channel,

3.3 inserts a common transmission power control signal, which contains said transmission power control signals for the respective first channels collected into a format predetermined for the system, into the second channel; and

3.4 transmits said common transmission power control signal containing said transmission power control signals for each of said first channels via said second channel.

4. Any mobile terminal

receives said transmission power control signal allocated to it on said second channel and

5. controls the transmission power for a signal to be transmitted via a corresponding one of said first channels in accordance with the received transmission power control signal.

17 4. Some features require further consideration:

18 a) Patent claim 1 does not provide for a limitation to CDMA methods or other mobile radio standards.



19           The description of the patent in suit is indeed oriented to the special features of the control method known from the IS-95 standard (para. 4). However, this is only expressed in claim 1 to the extent that the transmission of data packets and control signals between a base station and several mobile terminals in uplink and downlink directions is possible using several channels. It does not follow from this that the design of these elements is limited to the particular specifications from IS-95 or another CDMA method.

20           b) With regard to the channels used, feature group 2 contains specifications relating to the direction of transmission and the transmission content. Further specifications as to how such channels must be designed in detail or how they are set up or allocated do not result from this.

21           c) The requirement in feature 2.3 that mobile terminals share the second channel enables efficient use of resources because there is no need to establish a separate downlink channel for each mobile terminal (paras. 14, 62).

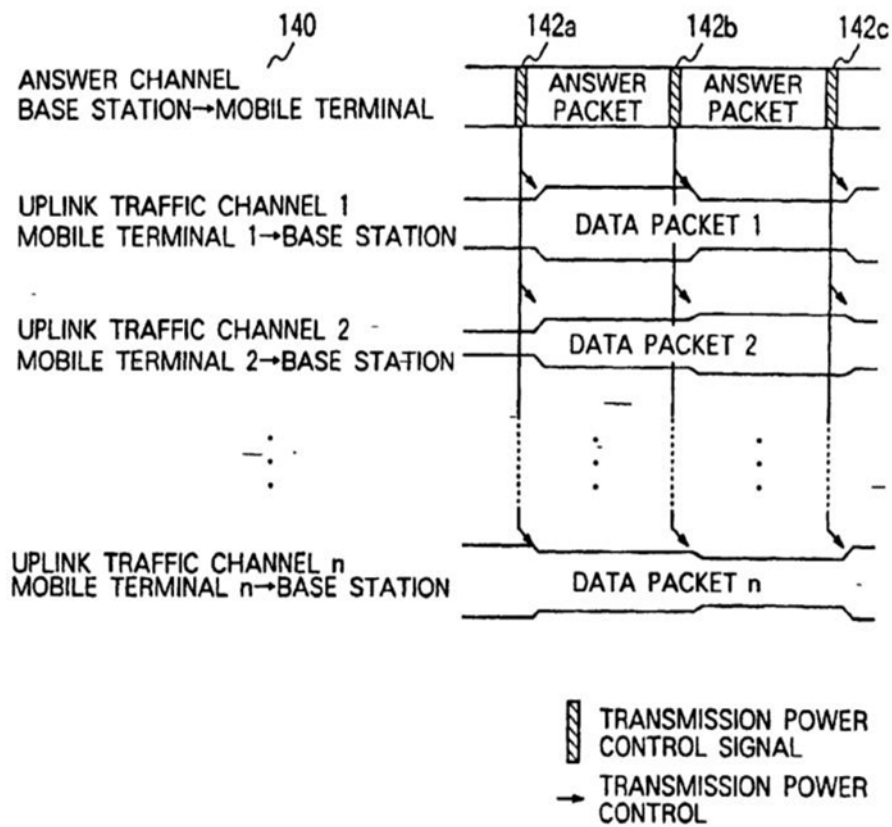
22           aa) The manner in which the control signals are transmitted on this channel is specified in more detail in features 3 to 5.

23           Then the control signals for the individual uplink channels are collected into a common control signal. This common signal is transmitted on the common downlink channel. Each mobile station can receive the transmission power control signal allocated to it from this and use it to control its transmission power.

24           bb) A channel that is already designated for other purposes may be used as a second channel.

25 In the first embodiment of the patent in suit, a downlink response channel is used on which the base station sends response packets in response to traffic channel reservation requests from the mobile terminals, and from which each mobile terminal takes and evaluates the response packet allocated to it (para. 22, Fig. 2). Figure 9, reproduced below, illustrates the use of this response channel to control transmission power.

**FIG. 9**



26 The base station inserts control signals (142a, 142b, 142c ...) between the response packets transmitted on the response channel. The mobile terminals, each

of which transmits data packets (1-n) on the uplink traffic channels (1-n) allocated to it, derive from the common signals (142a, 142b, 142c, ...) the control signal intended for it in each case and, in accordance with it, change the power for the transmission of the data packet (par. 47). If no data packet is transmitted, the transmission power control signal is disregarded (par. 49).

27           cc) With regard to the question of whether the common downlink channel may or must also be used for other purposes, feature 2.3 does not contain any further specifications.

28           d) Feature 2.4 provides that the second channel is not only a shared downlink channel from the base station to the mobile terminals, but that it is a traffic channel.

29           aa) As the patent court explained in detail, in the prior art typically such channels were called traffic channels which are allocated to a single mobile station and enable the transmission of user data.

30           In this meaning, the patent specification in dispute uses the term both in the description of the prior art and in the description of the second embodiment.

31           (1) As already explained above, the patent in suit is based on the IS-95 mobile radio standard and the paired uplink and downlink traffic channels provided therein for voice transmission. The criticism voiced in this context that it is inefficient for the transmission of data to set up a downlink traffic channel for each mobile station, although only power control signals are transmitted on this channel (para. 13), implicitly assumes that each of these channels is allocated to a specific mobile station.

32           (2) In the second embodiment described in the patent in suit, which is explained in the description with reference to Figures 10, 11 and 12 reproduced below, the power control signals are not transmitted on the common response channel but on downlink traffic channels (1-n).

FIG. 10

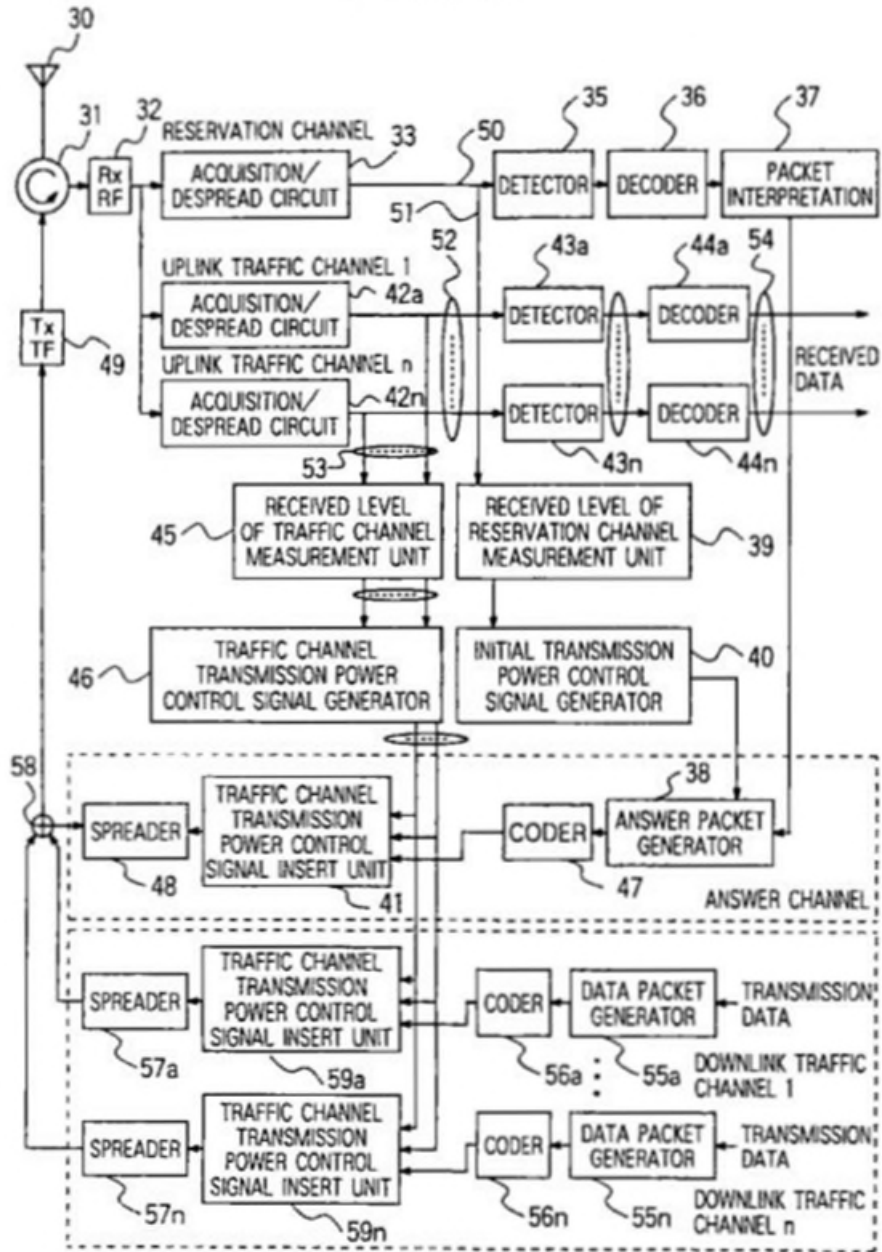


FIG. 11

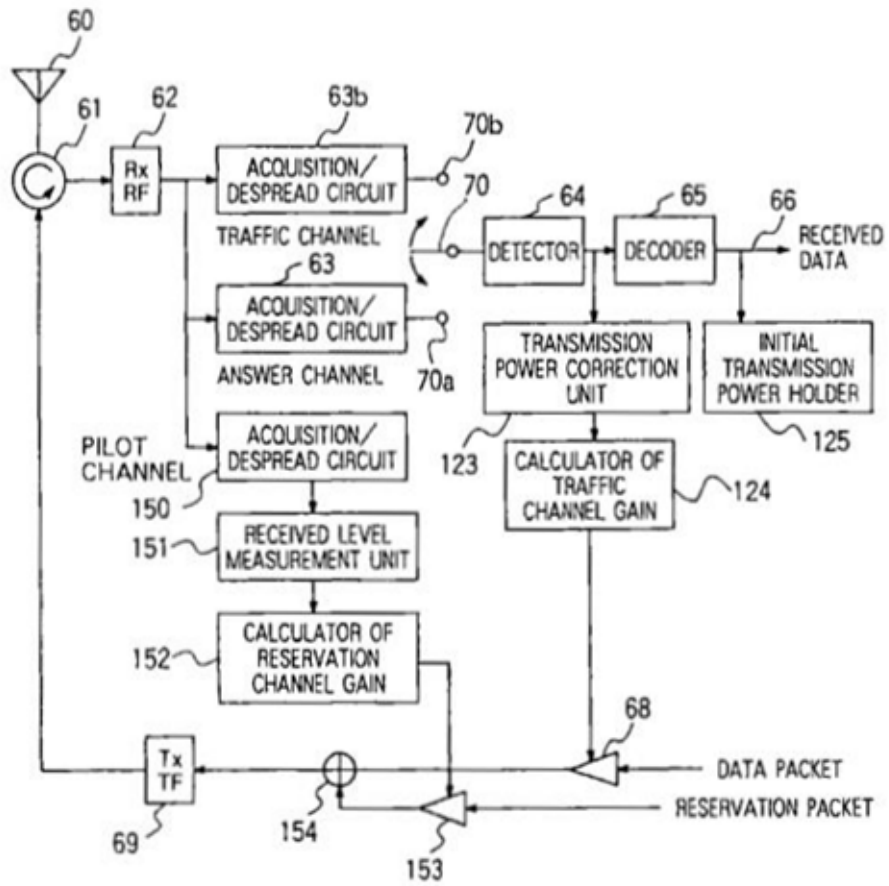
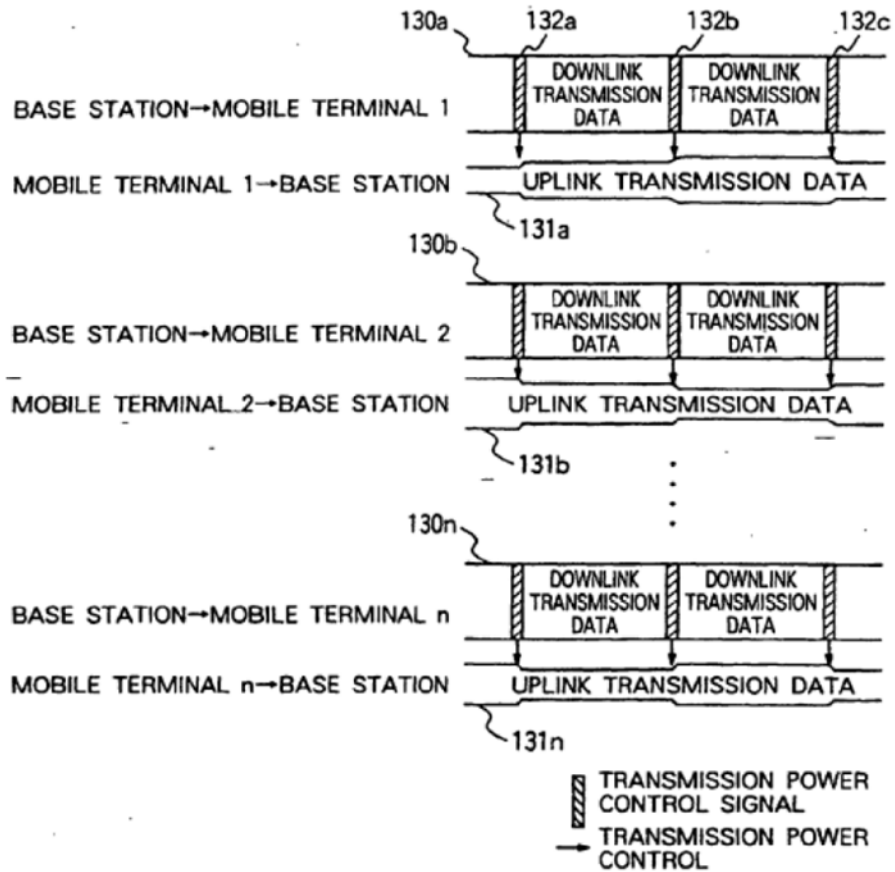


FIG. 12



33 From Figure 10, which shows the circuit diagram for a base station, and the explanatory notes thereto (para. 55), it is clear that there is a separate traffic channel for each mobile station and that the base station can transmit the control signals for the individual mobile stations on the common response channel or on the traffic channels of the individual mobile stations, depending on the operating state. The

transmission on the traffic channels, which is the focus of the second embodiment, is proposed for situations in which two-way communication takes place (par. 51), i.e., a downlink channel must be available anyway for the transmission of user data to the individual mobile stations.

34 In Figure 11, which shows the circuit diagram of a suitable mobile station, it is indicated that the mobile station can optionally take the power control signal from the response channel or the traffic channel.

35 Figure 12 shows that in this embodiment, the power control signals are not inserted into the common response channel, but into the traffic channels (130a-n) allocated to the individual mobile stations.

36 The comparison between a response channel, which is accessed by all mobile stations and via which data is transmitted for control purposes, and the traffic channels allocated to each mobile station, which are intended for the transmission of user data, corresponds to the understanding of the term "traffic channel" described above.

37 bb) The formulation used to characterize the invention that the base station uses a single downlink traffic channel for the control of the transmission power for all mobile stations in common (para. 14) is, in contrast, based on a modified understanding of the term. It contradicts the usual understanding insofar as according to this understanding a traffic channel is typically allocated to a single mobile station, i.e. it is precisely not shared by all mobile stations.

38 cc) Against the background shown, this contradiction is to be resolved to the effect that patent claim 1 deviates from the conventional understanding of the term to the extent that an existing downlink traffic channel is used at least in certain situations to transmit transmission power control signals to all mobile stations.



39           As the patent court rightly assumed, the conventional understanding of the term remains, however, in the absence of deviating indications in the patent specification.

40           Accordingly, a downlink traffic channel within the meaning of Feature 2.4 is a channel that is allocated to a single mobile station and is set up for the transmission of user data, but can be used to transmit transmission power control signals to all mobile stations if required.

41           (1) From the last paragraph of the patent description it can be inferred as a general idea of the invention to select a channel for the transmission of the transmission power control signal which is shared by all mobile stations. In the first embodiment, the selection falls on the (shared) response channel already established for other purposes anyway, as claimed in this function in independent patent claim 7. With the downlink traffic channel, patent claim 1 selects another channel already set up. The only special feature is that this channel - conventionally allocated only to a single mobile station - must first be set up as a shared channel for transmission of the transmission power control signal.

42           (2) Contrary to the opinion of the appeal, no deviating conclusions result from the concluding reference in the description that a channel can also be set up which is intended exclusively for the transmission of power control signals (para. 62 last sentence).

43           The establishment of a common channel exclusively for power control signals may also still correspond to the objective of the patent in suit of an approach that is as resource-saving as possible. However, it follows from the stipulation in feature 2.4 that the common channel must be a traffic channel that such embodiments do not belong to the subject-matter of patent claim 1.

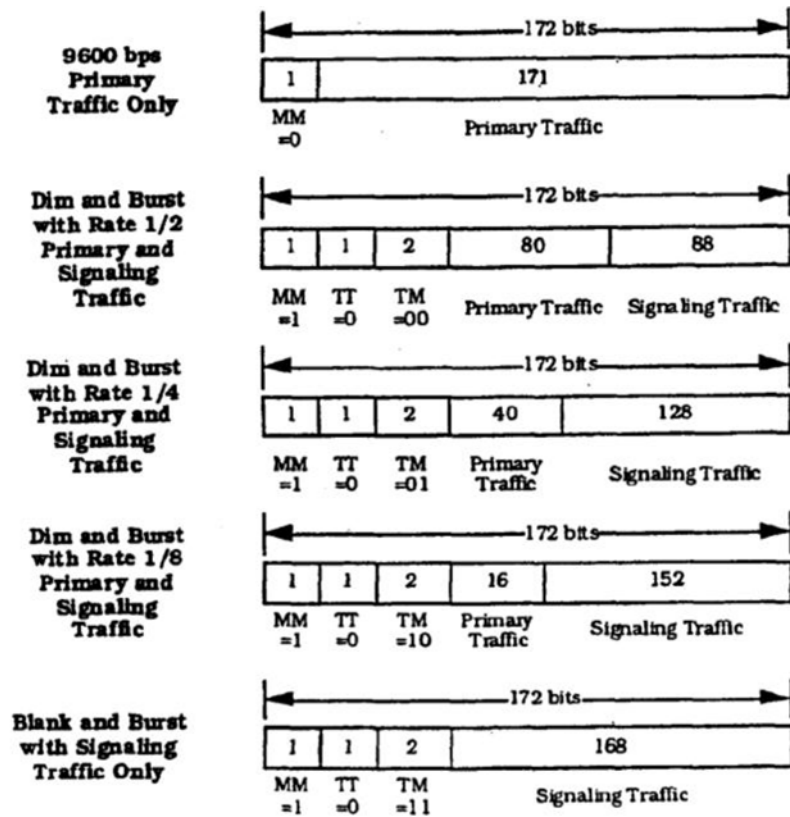
44           The resulting contradiction between the description and the claim is explained by the fact that feature 2.4 was added to the claim only after it was granted.

45           (3) Finally, the allocation of the downlink traffic channel to a single mobile station for the transmission of user data is not called into question by the fact that the transmission power control signal can also be transmitted independently of the transmission of user data.

46           The possibility of inserting and transmitting only the transmission power control signal in the downlink traffic channel during time periods in which (temporarily) no user data is to be transmitted is expressly described in the patent specification in dispute for the paired downlink traffic channel known from the prior art (para. 13). This procedure does not remove the fundamental characteristic of a traffic channel. The channel continues to be set up for this purpose and can be used again to transmit user data to a single mobile station in subsequent operating situations, if required.

47           Contrary to the view of the appeal, the IS-95 standard (ZP18) referred to by the patent specification in dispute (para. 4) does not contradict this understanding.

48           The standard refers to the downlink traffic channel as the forward traffic channel and defines it as a code channel used to transport user and signaling traffic from the base station to the mobile station (p. 1-5, lines 38-39). Below, for a Multiplex Option 1 of the standard, its Figure 7.1.3.5.11.1-1 (Information Bits for Primary Traffic and Signaling Traffic) is reproduced.



**Notation**

- |   |  |
|---|--|
| <b>MM - Mixed Mode Bit</b>  | <b>TM - Traffic Mode Bits</b>  |
| 0 - Primary Traffic Only  | 00 - 80 Primary Traffic Bits and either 88 Signaling Traffic or 88 Secondary Traffic Bits        |
| 1 - Primary Traffic and/or Signaling Traffic or Secondary Traffic | 01 - 40 Primary Traffic Bits and either 128 Signaling Traffic Bits or 128 Secondary Traffic Bits |
| <b>TT - Traffic Type Bit</b>                                      | 10 - 16 Primary Traffic Bits and either 152 Signaling Traffic Bits or 152 Secondary Traffic Bits |
| 0 - Signaling Traffic   | 11 - 168 Signaling Traffic Bits or 168 Secondary Traffic Bits                                    |
| 1 - Secondary Traffic   |  |

**Figure 7.1.3.5.11.1-1. Information Bits for Primary Traffic and Signaling Traffic (Part 1 of 2)**

49 Thereafter, under the designation "Blank and Burst", there is a frame indicated with the header bits 1011 in which only signaling traffic, i.e. control data, is transmitted. This does not change the fact that, in accordance with the general definition, the channel remains (also) set up to transmit user data when required.

50           It is also consistent with the teaching of the patent in suit when the standard (p. 7-38(1)) provides that signaling traffic shall only occur using the blank-and-burst frames when the primary and secondary data transmission services are not active. As stated earlier, a channel does not lose its status as a traffic channel if, in the event that data is (temporarily) not to be transmitted, it contains a special frame that can continue to be used to transmit incidental control data.

51           III. In justifying its decision, the patent court essentially stated, insofar as this is relevant to the appeal proceedings:

52           The person skilled in the art, an engineer specializing in electrical or communications engineering with a university diploma or master's degree and several years of professional experience as well as knowledge in the field of designing mobile radio systems, in particular in the field of power control in CDMA systems, differentiates the channels mentioned in features 1 and 2 according to whether they establish a point-to-point connection between the base station and a single mobile terminal as a dedicated channel or whether they serve as a common or shared channel for simultaneous communication of the base station with several mobile terminals.

53           The fixed allocation of the first channels could take place in a "reservation based access system" in that the base station - in response to a request from a mobile station via the reservation channel - allocates the mobile station a code or number for an uplink channel and a time period on it via the response channel. However, the teaching of the patent in suit was not limited to this. For example, in a "CSMA with busy tone" system (CSMA = Carrier Sense Multiple Access), a mobile station could attempt access via one (of several possible) random uplink channels, and if successful, this channel would be marked as busy by the base station by transmitting a busy signal,

thus preventing access attempts by other mobile stations and achieving a fixed allocation.

54 According to the patent description (para. 62), a shared channel other than the response channel used in the first embodiment could also be used as a second channel for the additional transmission of the power control commands, e.g. the pilot channel or the synchronization channel in IS-95 or the broadcast channel according to the UMTS study Codit. A traffic channel does not fall under this because it does not belong to the shared channels.

55 As far as the patent specification in dispute (para. 62) emphasizes the possibility of providing a new dedicated channel (dedicated to transmission power control) in a mobile communication system for the transmission of transmission power control commands from the base station to the mobile stations, the skilled person would not read a traffic channel into this either, since such a channel is intended for the transmission of user data and is not shared.

56 In the absence of explanations to the contrary in the patent in suit, the skilled person would assume that the downlink traffic channel referred to in feature 2.4, like the response channel according to the first embodiment, retains its original function of transmitting user data to a single mobile station and is merely modified in that it additionally contains the transmission power control signals for several mobile stations.

57 The subject-matter of patent claim 1 defended by the main request went beyond the content of the originally filed documents. The one-time mention in the original application of the downlink traffic channel as a channel common to all mobile stations had been perceived by the skilled person as a foreign body in the sense of an obvious incorrectness, which he would have corrected to a downlink control channel in the light of what he had taken from the entirety of the application documents (description, claims, drawings) in terms of technical teaching. In contrast, the design of the

common downlink channel as a traffic channel in patent claim 1 represents an aliud.

58 Patent claim 1 also does not disclose the claimed invention clearly and completely enough for a person skilled in the art to carry it out. The patent specification in dispute does not contain any explanations as to how the claimed split downlink traffic channel must be designed in order to transmit the common transmission power control signal from the base station to the several mobile terminals and, at the same time, to realize a point-to-point connection between the base station and a mobile station for the transmission of user data as intended. Nothing else can be derived from the IS-95 mobile radio standard cited in the patent description. In particular, it was unclear how it could be made possible that a self-power-controlled dedicated downlink traffic channel, i.e. allocated to a mobile station, is simultaneously broadcast as a common downlink (control) channel with fixed power. In addition, it remained open how the shared downlink traffic channel was to be implemented in the higher transmission layers (layer 2 upwards) in comparison with the channels known from IS-95.

59 The US patent specification 5 621 723 (ZP15/D2/D6; hereinafter also: Walton) anticipates the teaching of patent claim 1 in a manner detrimental to novelty. The document is prior art, since the patent in suit wrongly claims the priority of the Japanese application Hei 8-32649396 (ZP3), which, if translated correctly, does not disclose a downlink traffic channel, but only a downlink channel, which is common to all mobile stations for transmission power control.

60 Based on the IS-95 standard, Walton wants to improve packet data transmission in the uplink direction. The reverse packet data channels created for this purpose are allocated to respective receivers in the base station depending on their data rate, whereby several mobile stations could use the same uplink data rate and then have to compete for a specific uplink packet data channel. For this purpose,

a CSMA procedure with a busy signal is used to indicate to the other mobile terminals that (further) access attempts will not be successful. This is sufficient for an allocation in the sense of feature 2.1. The other features of patent claim 1 are also disclosed.

61 Patent claim 1 could also not be maintained in the version of the partially already inadmissible auxiliary requests.

62 IV. This assessment stands up to scrutiny in the appeal proceedings.

63 1. The patent court has in the result rightly decided that the subject matter of the invention indicated in patent claim 1 is not disclosed so clearly and completely that a person skilled in the art can carry it out.

64 According to the case law of the Senate, sufficient disclosure for practicability is given if the person skilled in the art is able, without inventive step and without unreasonable difficulties, to practically realize the teaching of the patent claim on the basis of the overall disclosure of the patent specification in combination with the general knowledge of the art on the filing or priority date in such a way that the desired success is achieved (BGH, judgment of May 11, 2010 - X ZR 51/06, GRUR 2010, 901 para. 31 - Polymerisierbare Zementmischung).

65 a) As has already been pointed out, the downlink traffic channel is disclosed in the patent in suit with respect to the prior art explained as a channel associated with a mobile terminal in the sense of feature 2.1 (par. 5), paired with an upward channel (par. 12, 13). In the second embodiment example of the patent in suit (paras. 52 et seq.), in which switching in two modes is shown, the downlink traffic channel (130a) is not differently configured. It is used in the case of two-way data

communication to transmit the common transmission power control signal not (further) via the common response channel, but - as shown in Figure 12 - inserted into the data to be transmitted from the base station to the respective mobile stations (1-n).

66           The patent in suit does not disclose how it should be possible for the downlink traffic channel, on the other hand, to be allocated to a single mobile station for the transmission of user data and at the same time to be a shared channel with which the common transmission power control signal is transmitted from the base station to several mobile stations.

67           In the IS-95 standard referenced by the patent in suit, such use of a downlink traffic channel is also not shown.

68           b)    Based on this, a disclosure sufficient for executability is not given.

69           aa) In principle, it is sufficient that the person skilled in the art is able to carry out the subject matter of the invention based on the information in the patent specification with recourse to his technical knowledge (BGH, judgment of February 3, 2015 - X ZR 76/13, GRUR 2015, 472 para. 36 - Stabilization of water quality). In this context, that which was already available to the skilled person in terms of technical knowledge and skills at the time of filing the application on the basis of his technical knowledge does not need to be expressly included in the patent description (BGH, judgment of December 8, 1983 - X ZR 15/82, GRUR 1984, 272, 273 - Isolierglasscheibenrandfugenfüllvorrichtung).

70           However, the information contained in the patent description must provide the person skilled in the art with at least enough technical information to enable him to use his technical knowledge and expertise in addition for the implementation of the invention (BGH, judgment of July 13, 2010 - Xa ZR 126/07, GRUR 2010, 916 para.



17 - Klammernahtgerät). For this purpose, the patent specification must indicate at least to some extent by what means and in what way the claimed technical teaching can be realized. This requirement is not met if the patent specification merely states an abstract goal in keywords without even hinting at how this goal can be achieved.

71           bb) In the case in dispute, the explanations in the description of the patent in suit are limited to the requirement to establish a downlink traffic channel common to all mobile stations. How such a channel can be created is - as already explained - neither explained by an example of an embodiment nor by other concrete indications. Recourse to general technical knowledge does not provide any more concrete indications, because here, too, a downlink traffic channel is typically allocated to only one mobile station, i.e. it is precisely not common to all mobile stations. Consequently, the skilled person is confronted with the task of working out a concept for implementing the abstract objective from scratch, without being able to refer to any relevant technical information in the patent specification and to supplement it with his expert knowledge. This does not satisfy the requirements for an executable disclosure.

72           The question of whether and to what extent the expert would have to deal with problems in controlling the transmission power of a split downlink traffic channel when implementing the abstract target is therefore no longer relevant to the decision. The same applies to the question of whether the expert could find a practically feasible way to implement a downlink traffic channel (in particular) in the higher transmission layers (layer 2 and up) that represents a shared channel with respect to the transmission power control signal and a channel allocated to an individual mobile station with respect to the data transmission. This is because these are problems which, without reference to concrete specifications in the patent specification,

concern the basic work for implementing the abstract concept of a shared downlink traffic channel.

73           2) Whether the patent in suit is also to be declared invalid for the other reasons cited by the patent court does not require a final decision in view of this.

74           V. Patent claim 1 is not amenable to patent protection even in the version of the auxiliary requests, since all auxiliary requests contain the non-executably disclosed feature 2.4.

75           1. The fact that part of the auxiliary requests is filed with the proviso that no rights are derived from the feature "wherein the second channel (140) is a downlink traffic channel" cannot lead to a different assessment already because the selection of a downlink traffic channel as a divided downlink channel adds a technical aspect to the subject-matter of patent claim 1 which is not a mere limitation.

76           It can be left open whether the principles according to which the insertion of a feature not originally disclosed does not exceptionally lead to a declaration of invalidity if it merely represents a concretization of a feature originally disclosed in a more abstract form (most recently BGH, judgment of 20. October 2020 - X ZR 158/18, GRUR 2021, 571 marginal no. 41 - Zigarettenpackung; judgment of February 17, 2015 - X ZR 161/12, BGHZ 204, 199 = GRUR 2015, 573 marginal no. 53 - Wundbehandlungsvorrichtung), are transferable to the case that the insertion of a feature results in the invention not being disclosed in an executable form. Even if this were to be affirmed, this could not lead to dismissal of the action in the case in dispute because the insertion of feature 2.4 does not lead to a mere limitation, but to protection for an aliud.

77           Inherent in the selection made in feature 2.4 is the particular technical aspect that a downlink traffic channel typically allocated to only one mobile station can be

modified to transmit both the user data intended for a single mobile station and a common transmission power control signal intended for all mobile stations. No such feature can be inferred from the subject matter of the granted version of patent claim 1, either specifically or in abstract form. The addition of the feature thus leads to protection for an aliud.

78           2.    Insofar as part of the auxiliary requests provides as additional feature 2.5 that the second channel is dedicated to transmission power control, and one sees in this with the Patent Court a limitation of transmission exclusively to power control, there is an inadmissible extension of the scope of protection, since in this version the understanding of the term "downlink traffic channel" underlying feature 2.4 is changed.

79           The same applies to the auxiliary requests in which the word "dedicated" is replaced by the word "reserved" and the auxiliary requests that provide for the additional feature 2.5 in the English language version ("said second channel being dedicated to transmission power control").

80           3.    Whether the auxiliary request made for the first time in the appeal instance is late and the further auxiliary requests are partly inadmissible does not need to be decided against this background.

81           VI    The decision on costs is based on Sec. 121 (2), second sentence, Patent Law and Sec. 97 (1), Sec. 269 (3) and Sec. 101 (1) ZPO.

82           Pursuant to Section 269 (3) of the Code of Civil Procedure, the third plaintiff must bear its share of the court costs. This legal consequence is to be pronounced independently of an application, because the court costs are to be decided ex officio pursuant to Section 308 (2) ZPO. The extrajudicial costs of the defendant, on the other hand, are not to be imposed on the third plaintiff for lack of an application for costs (Sec. 121 (2) Patent Act, Sec. 269 (4) Code of Civil Procedure).

83 The intervener shall also bear its own extrajudicial costs pursuant to Section 101 (1) of the Code of Civil Procedure.

Bacher

Hoffmann

Deichfuß

Kober-Dehm

Crummenerl

Lower court:

Federal Patent Court, decision of February 3, 2020 - 6 Ni 45/16 (EP) -