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FEDERAL SUPREME COURT

IN THE NAME OF THE PEOPLE

JUDGMENT

X ZR 32/21

Delivered on:
October 18, 2022
Schönthal
Judicial Employee
as Clerk of the
Court

in the patent nullity case

ECLI:DE:BGH:2022:181022UXZR32.21.0

The X. Civil Senate of the Federal Supreme Court, at the oral hearing on October 18, 2022, by the Presiding Judge Dr. Bacher, the Judge Hoffmann, the Judges Dr. Kober-Dehm and Dr. Marx, as well as the Judge Dr. Crummenerl

ruled:

The appeal against the judgment of the 3rd Senate (Nullity Senate) of the Federal Patent Court of January 13, 2021, is dismissed at the defendant’s expense.

By law

Facts of the Case:

1 The defendant is the owner of European Patent 2 562 002 (patent in suit), which was granted with effect for the Federal Republic of Germany, arose from an application of May 27, 2008 (2 158 095), claims a priority of May 27, 2007 and concerns a planar element.

2 The patent in suit comprises twelve claims. Claims 1, 8 and 12 read in procedural language:

> 1. Planar element (100), comprising
>
> - at least one support substrate (10), in particular at least one support plate, being configured as aluminum composite sheet, and
>
> - at least one coating (30) arranged on at least one area or side of the support substrate (10),
>
> characterized by a repeated sealing (50) on the coating's (30) area or side averted from the support substrate (10).
>
> 8. A method for producing at least one planar element (100), wherein at least one coating (30) is applied on at least one area or side of at least one support substrate (10), in particular of at least one support plate, said support substrate (10) being configured as aluminum composite sheet, characterized in that the coating's (30) area or side averted from the support substrate (10) is repeatedly sealed (50).
>
> 12. Use of at least one planar element (100) according to at least one of claims 1 to 7 and/or a method according to at least one of claims 8 to 11 as a decorative element, shower wall, front of a piece of furniture, partition wall or the like, in particular in damp or wet areas, for example for shower cubicles or for swimming pools.

3 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 31 amended versions.

4 The Patent Court declared the patent in suit invalid. This is the subject of the defendant's appeal, which pursues its motion to dismiss the action and sixteen of its first-instance auxiliary claims (retaining the numbering). The plaintiff opposes the appeal.

Reasons for Decision:

5 The admissible appeal is unfounded.

6 I. The patent in suit relates to a planar element being configured from an aluminum composite sheet.

7 1. The description of the patent in suit cites as prior art the German disclosure document 102 49 223 and the European patent application 864 444.

8 Both documents deal with the application of inks to a substrate, especially glass.

9 Against this background, the patent in suit concerns the technical problem of providing, in a simple and inexpensive manner, a planar element that enables a visually appealing and durable color design.

10 2. To solve this, claim 1 proposes a planar element whose features can be structured as follows:

1. A planar element, comprising
   - 1.1 at least one support substrate, in particular at least one support plate, being configured as an aluminum composite sheet, and
   - 1.2 at least one coating arranged on at least one area or side of the support substrate, and
   - 1.3 a repeated sealing on the coating's area or side averted from the support substrate.

11 3. Central importance is given to repeated sealing as per feature 1.3.

12 A repeated sealing, for example three times, is referred to in the description of the patent in suit as an advantageous embodiment (para. 11). According to claim 1, the sealing must comprise at least two layers.

13 According to the description, a sealing is particularly useful when used in damp or wet areas because it protects the planar element against any impact. This makes it possible to provide the element with an imprint located between the coating and the sealing or created as part of the coating (para. 28 et seq.).

14 4. Claim 8 protects a method for producing an element whose features correspond to features 1.1 to 1.3.

15 This subject matter is not to be assessed differently from that of claim 1.

16 5. Claim 12 protects the use of an element having these features for various uses, which include, but are not limited to, use in damp or wet areas.

17 This subject is also not subject to a different assessment.

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

19 The subject matter of the patent in suit had been suggested to the skilled person, a team consisting of an engineer (M.Sc.) of material sciences with special knowledge in the coating of aluminum composite plates and a construction technician, starting from a brochure of A. S. GmbH (Dibond Verarbeitung, 02/2004, K6). K6 disclosed aluminum composite plates to which a decorative surface finish could be applied by printing or painting. For the concrete configuration, K6 refers to a leaflet published by the Gesamtverband der Aluminiumindustrie (GDA, since 2021: Aluminium Deutschland e.V.) (Aluminium Leaflet O 3, Beschichten von Aluminium, K7b). It states that coatings on aluminum basically consist of a primer, an intermediate coating and a final coating; the number of coatings depends on the stress. For use in damp and wet areas, it was therefore obvious to apply the final sealing - which corresponds to the sealing in the sense of feature 1.3 - with an increased layer thickness. In order to avoid coating defects, the expert would consider applying several coats of paint instead of a thick single coat.

20 Contrary to the view of the defendant, Dibond plates had also been used in wet and damp areas before the priority date. Such use is expressly mentioned in K6. The fact that these statements do not relate to the plates themselves, but to their fastening by means of rivets, does not lead to a different assessment.

21 Against this background, the objects defended by the auxiliary requests, which concerned the use as a shower wall, had also been obvious.

22 III. This assessment stands up to scrutiny on appeal.

23 1. The Patent Court rightly decided that the subject matter of claim 1 was obvious on the basis of K6.

24 a) K6 contains instructions for processing aluminum composite plates with the designation "Dibond".

25 According to the data sheet contained in K6 (p. 24), Dibond plates have a thickness of 2, 3, 4 or 6 millimeters. The core consists of low density polyethylene (LDPE), the two 0.30 millimeter thick cover sheets of an aluminum alloy. The surface is coated with a modified polyester coating system.

26 The instructions on transport, storage and handling (p. 5) state that delivered pallets must be inspected for transport and moisture damage, stored protected from rain and splash water and protected from moisture penetration.

27 The description of possible processing, joining and fastening techniques includes the use of rivets. It is stated that in outdoor areas and damp rooms, aluminum blind rivets with stainless steel mandrels are generally used to prevent rusting (p. 16).

28 Under the heading "Surface treatment/printing", it is stated that the stove-enameled surfaces of the Dibond plates can be overpainted. In this context, there is talk of non-weathered plates (p. 21, top left).

29 It is also stated that coatings on roll-matted (unpainted) Dibond surfaces are to be built up in the same way as on bare aluminum surfaces. It is advisable to

familiarize oneself with the coating systems and materials as well as working methods that have been tried and tested for aluminum. For general information, the GDA leaflets surfaces 02, 03, 012 and 015 are recommended (p. 21, top right).

30 b) Contrary to the view of the appeal, K6 offered itself as a starting point for considerations of aluminum composite plates in damp or wet environments.

31 It is not clear from the findings of the patent court that Dibond plates were actually used in such areas before the priority date. However, as the Patent Court rightly assumed in the result, there are already sufficient indications from K6 that Dibond plates can also be considered for such use.

32 However, the explanations referred to by the Patent Court regarding joining by means of rivets in outdoor areas and damp rooms are somewhat contradictory to the references to possible moisture damage during transport and storage. This alleged contradiction is, however, resolved by the remarks on surface treatment, where a distinction is made between stove-enamelled surfaces for non-weathered plates and roll-matted, i.e. unpainted Dibond plates.

33 Although even these comments do not clearly indicate whether uncoated Dibond plates can be coated in such a way that they are suitable for use in a humid environment. However, the references to best practices and the leaflets published by the industry association gave sufficient reason to look for possible solutions in this area.

34 c) The Patent Court rightly decided that a coating and multiple sealing of roll-matted Dibond plates was suggested by K7b.

35 aa) Leaflet K7b, published in 1992, deals with the coating of aluminum.

36 In the introductory remarks, it is stated that aluminum with a mill-finished or press-finished surface is also very weather-resistant in industrial and marine climates. However, when exposed to weathering, the surface is covered with an oxidic coating over time, which does not impair its function but its appearance (p. 2 et seq.).

37 For coloration, coating is common in many cases, especially when a uniform color appearance is required. Coating is necessary for copper-containing alloys exposed to moisture and for copper-free alloys when high demands are made on appearance, operational safety and service life in aggressive atmospheres (industrial atmosphere, marine climate) (p. 3, cp. 2).

38 In the case of coatings, the focus is usually on decorative corrosion protection. The architectural sector in particular requires high weather resistance with little color change and a high residual gloss (p. 4).

39 Industrial organic coating is carried out with automatic equipment (p. 5 et seq., cp. 4).

40 Coating by hand preferably involves individual components, smaller component series and on-site coating. The usual work steps consist of cleaning and degreasing, mechanical surface preparation by grinding, priming and the application of a finishing coat (p. 9, cp. 5). The latter may consist of an intermediate and a final coat (p. 13, para. 2).

41 For an opaque interior coating for normal use, such as for ceiling cassettes and room dividers, priming with special primer or polymer resin primer and a final coat of alkyd resin paint or polymer resin paint is recommended, for damp areas priming with epoxy resin primer and a final coat of polyurethane paint. If additional resistance, for example to acids, is required, priming with epoxy resin primer paint can be followed by further coating with polyurethane paint (PUR) or polyvinyl chloride (PVC) paint. The number of coatings depends on the stress (p. 13, cp. 5.3).

42 bb) As the Patent Court rightly assumed, this gave rise to the suggestion that aluminum composite plates of the type disclosed in K6 should be provided with a suitable coating for use in damp rooms and, if necessary, that a finishing coat consisting of several layers should be considered.

43 The introductory remarks in K7b indicate that aluminum surfaces provided with a color coating are also suitable for use in a damp environment, provided that the coating is adapted to the relevant requirements. The additional note that the number of coatings depends on the stress gave reason to consider a multi-layer finishing coat if a single-layer structure proves insufficient.

44 The reference to a plurality of coatings depending on the respective stress is disclosed in K7b only in the context of additional requirements for resistance, for example against acid. However, resistance to acid is only mentioned as an example. It is therefore sufficiently clear from the overall context that a multi-layer finishing coat is also to be considered in other constellations in which special requirements are placed on the resistance.

45 cc) Concrete evidence that, despite the indications in K7b, it was common practice in the prior art to provide composite plates along the lines of K6 only with a sealing layer and to make this as thick as possible, if required, does not result from the submissions of the appeal.

46 (1) The product description "Dibond" (K32) submitted by the plaintiff does not contain any information in this regard.

47 (a) The passage cited by the appeal, according to which overcoating the prints could be advantageous in order to achieve certain surface properties or to improve mechanical or chemical resistance (p. 233, bottom), is unproductive in this respect.

48 Neither from these statements themselves nor from the context does it appear that the word "one" is used as a numeral or that the reference is to be understood for other reasons as meaning that overcoating with several layers is to be avoided.

49 Furthermore, these statements refer to the printing of Dibond plates with stove-enameled surfaces by means of screen printing. In connection with the overprinting of stove-enameled surfaces, however, D32 also refers to non-weathered panels (p. 234, top). For the coating of mill-finished Dibond surfaces, on the other hand, K32, like K6, recommends proven painting systems and materials as well as working methods (p. 234, mid).

50 (b) The same applies to the statements in German disclosure document 38 38 930 cited by the appeal.

51 This document deals with the production of decorative glass plates as paneling or facing material. A base layer, a layer printed by transfer and a layer of cured resin are successively applied to the glass plate. The thickness of the resin

layer was not subject to any limitations and should preferably be at least 15 micrometers (p. 3, lines 66-68).

52 Whether these statements relating to the coating of glass surfaces can be transferred to the coating of aluminum surfaces can be left open. In any case, these statements do not indicate that a resin layer consisting of several separately applied layers is to be avoided.

53 2. The objects defended by the second-instance auxiliary claims are also suggested by the prior art.

54 a) The use of the planar element as a shower wall, in particular in damp or wet areas, for example for shower cubicles or for swimming pools, claimed according to all these applications, was obvious on the basis of K6.

55 As already explained above, based on K6, it emerged from the leaflet K7b referred to there that colored surfaces made of aluminum can also be used outdoor and in damp areas if suitably coated, and that the coating can even be applied in such a way that it is acid-resistant.

56 Against this background, the conclusion of the Patent Court that on the priority date there was reason to consider the use of Dibond plates with a coating meeting the respective requirements also as a shower wall proves to be correct. The effects to be expected from water and acidic or alkaline cleaning agents do not exceed the stresses for which coated aluminum surfaces are described as suitable in K7b.

57 b) The additional feature provided in auxiliary claims 7, 9, 11, 19, 21, 23, 29 and 31 that the aluminum composite plate has at least one plastic core and two aluminum cover layers is disclosed in K6.

58 c) The feature provided in auxiliary claims 8, 9, 10, 11, 20, 21, 22 and 23, according to which the side of the support substrate facing the coating has at least one primer, is disclosed in K7b and thus obvious on the basis of K6.

59 d) The replacement of the word "comprising" by the wording "consisting of" (mutatis mutandis) in auxiliary requests 10, 11, 22, 23, 28, 29, 30 and 31 does not lead to a different assessment.

60 Such designs embodiments are also suggested by K6 and K7b for the reasons shown above.

61 e) The feature provided for in auxiliary claims 18, 19, 20, 21, 22, 23, 30 and 31, according to which at least one imprint or inscription, for example in the form of advertising, is applied as part of the coating, was also obvious on the basis of K6 and K7b.

62 In both citations, the possibility of applying a colored coating is disclosed without any restrictions on the graphic design being apparent. In view of this, it can remain open whether and to what extent different contents of the color printing can at all lead to the affirmation of inventive step.

63 IV. The decision on costs is based on Sec. 121, para. 2, Patent Law (PatG), Sec. 97, para. 1, Code of Civil Procedure (ZPO).

Bacher Hoffmann Kober-Dehm

Marx Crummenerl

Lower court:
Federal Patent Court, decision of January 13, 2021 - 3 Ni 5/18 (EP) -