



**FEDERAL SUPREME COURT**  
**ON BEHALF OF THE PEOPLE**  
**JUDGMENT**

X ZR 61/21

Announced on:  
June 20, 2023  
Anderer  
Judicial employee  
as clerk of the court  
office

in the litigation

Reference book:     yes  
BGHZ:                 no  
BGHR:                 yes

Fiber web

GebrMG Sec. 13 (3); PatG Sec. 12

- a) The modification of a pre-used object, which realizes all features of an independent claim of protection of the suit utility model, may be covered by a right of prior use even if the pre-used object did not exhibit further features, which are mandatory according to the suit utility model.
- b) This applies irrespective of whether the infringement action is merely based on a version of an independent protective claim which is restricted in the aforementioned manner or whether the utility model has been restricted accordingly in cancellation proceedings.

Federal Supreme Court (BGH), judgment of June 20, 2023 - X ZR 61/21 –

Düsseldorf Higher Regional Court  
Düsseldorf District Court

The X. Civil Senate of the Federal Supreme Court, at the oral hearing on June 20, 2023, by the Presiding Judge Dr. Bacher, Judges Hoffmann and Dr. Deichfuß, Judge Dr. Marx, and Judge Dr. Crummenerl,

found in favor of the following:

On appeal by the defendant, the judgment of the 2nd Civil Senate of the Düsseldorf Higher Regional Court of June 24, 2021 is set aside.

The matter is referred back to the Court of Appeal for a new hearing and decision, including on the costs of the appeal proceedings.

By law

Facts:

1 The plaintiff brings a claim against the defendant for literal infringement of German utility model 298 18 178 (suit utility model), which expired during the litigation after the maximum term of protection and relates to an absorbent fibrous web.

2 Claims 1, 10 and 11, on which the complaint was last based, have been given the following wording in cancellation proceedings initiated by the defendant (with amendment markings compared to the originally registered wording):

1. Absorbent fibrous web (100) consisting of a high proportion of pulp fibers (1) pressed together, characterized in that the pulp fibers are pressed together in an embossing pattern consisting of dot-shaped or linear embossing regions (3) and are fused in the embossing regions (3) of the embossing pattern as a result of high pressurization in such a way that they are free of adhesive and/or binder, that adjacent pulp fibers in the embossing area are very firmly and intimately bonded to one another, so that the bond does not loosen at service temperature due to the action of water.
10. A fibrous web (100) according to any one of the preceding claims, characterized in that the fibrous web (100) has an addition of auxiliary and filler materials, for example titanium oxide, chalk or kaolin.
11. The fibrous web (100) according to claim 10, characterized in that the additive comprises a superabsorbent polymer (SAP), the amount being from 0.5 to 70% by weight, preferably between 5 to 30% by weight of the total weight.

3 The defendant markets panty liners with the designations "Siempre Ultraplus 18 normal" and "Siempre Ultraplus 14 long" (challenged embodiments I) and "TIP" (challenged embodiment II).

4           At first instance, the plaintiff claimed that the challenged embodiments I infringed the utility model as originally registered. The District Court essentially ordered the defendant to cease and desist, to destroy, to provide information and to render accounts, and found the defendant liable for damages.

5           In the appeal instance, the plaintiff based its claim lastly on the combination of claim 1 as amended after the cancellation proceedings with the additional features of claims 10 and 11, extended it to the challenged embodiment II and adjusted it in time to the lapse of the utility model in suit. The court of appeal reworded the operative part of the first-instance decision accordingly and dismissed the defendant's appeal.

6           In the appeal allowed by the Senate, the defendant continues to pursue its request to dismiss the complaint. The plaintiff opposes the appeal.

Reasons for Decision:

7           The admissible appeal of the defendant is successful. It leads to the reversal  
of the contested judgment and to the remittal of the case to the Court of Appeal.

8           I.       The utility model in suit concerns an absorbent fibrous web

9           1.       According to the description of the suit utility model, cellulose-  
containing material, such as wood or plant fibers, is bonded under pressure to  
produce such a fibrous web.

10          Compression takes place between smooth calender rolls, which results in an  
increase in density. However, the material has a low tensile strength. To improve  
this, synthetic additives had to be added, which made it more difficult to recycle the  
pulp fibers (p. 1 lines 11-23).

11          2.       Against this background, the utility model in suit concerns the  
technical problem of providing a fibrous web whose tear strength and recyclability  
are improved.

12          3.       As a solution, the IPR proposes in claims 1, 10 and 11 a fibrous  
web whose features can be divided as follows:

1. fibrous web (110), which
  - 1.1 is absorbent and
  - 1.2 from a high proportion of pressed together  
pulp fibers (1).
2. The pulp fibers are pressed together in an embossed  
pattern of dot or line embossed areas (3).

3. The pulp fibers are fused in the embossing areas (3) of the embossing pattern without adhesives or binders as a result of high pressurization,
  - 3.1 in such a way that adjacent pulp fibers in the embossing area are very firmly and intimately bonded to each other so that the bond does not loosen at service temperature due to the action of water.
4. The fibrous web (100) has an addition of auxiliaries and fillers.
  - 4.1 The additive comprises a superabsorbent polymer (SAP),
    - 4.1.1 wherein the proportion is 0.5 to 70 wt.%

13           II.       The Court of Appeals gave the following main reasons for its decision:

14           Protection claim 1 substantiates the requirements for the fusion of adjacent  
pulp fibers in the preparation areas according to features 3 and 3.1 in terms of  
the result. Their firm and intimate bond is given if this does not dissolve at the  
usual water quantities and temperatures depending on the intended use.

15           A definition of "non-solubility" cannot be inferred from the design in suit. Contrary  
to the defendant's view, however, it does not follow from this that feature 3.1 is only  
fulfilled if none of the numerous fiber connections in the embossed areas dissolves  
under the influence of water.

16           The wording of the claim did not give rise to such a restrictive understanding.  
The term "non-dissolving" of the fiber connections is aimed at a specific material  
state under the influence of water. Therefore, "non-loosening" does not  
necessarily mean that the connection of the fibers must remain fully intact in all  
directions. From a functional point of view, in view of the desired improved tensile

strength, it is rather sufficient if even in the wet state there are still so many connections between adjacent pulp fibers that the respective embossing point remains intact. This is evident from the fact that under the relevant conditions according to feature 3.1, there is no dispersion of the embossing areas or their disintegration into individual fibers. A mere change in the geometry of the fiber composite - for example through swelling - is therefore not a loosening of the bond.

17 It is not sufficient if only individual embossed areas do not dissolve when exposed to water. Conversely, however, it is also not necessary that all embossing points of the fibrous web with an intact absorbent core always remain intact under conditions of use. If individual embossing points do not withstand the influence of water, this does not lead out of the scope of protection of the utility model in suit, provided that sufficient embossing points remain which ensure a mechanically stable product overall.

18 According to feature Group 4, the fibrous web must have an additive of auxiliaries and fillers, whereby this must contain a certain proportion of superabsorbent polymers (SAP). For this purpose, it is sufficient if only superabsorbent polymers are added to the fibrous web as an additive. It follows from the wording "comprises" that the additive must at least consist of superabsorbent polymers. Other additives are optional. Accordingly, the description also explicitly mentions titanium dioxide and superabsorbent polymers as alternatives.

19 Based on this understanding, the challenged embodiments made direct use of the teaching of the patent in suit in the last version at issue.

20 Insofar as the defendant asserts for the first time in the appeal that the challenged embodiment I is not free of bin demitants according to feature 3 due to the presence of silicone, this new argument is not admissible. An exceptional case under Section 531 (2) of the Code of Civil Procedure (ZPO) did not exist. The plaintiff had claimed at first instance that the challenged embodiment I was free

of adhesives and bin demitants. The defendant had not countered this. Admission of the new argument was not justified because claim 1, only in the version relevant to the appeal, stipulated that the fibrous web had to be free of binders and adhesives: Claim 1 in the originally registered version also provided for this property - in addition to an alternative ratio.

21           The challenged embodiments also realized feature 3.1.

22           This is evident from the expert opinions obtained. The embossing points of the challenged embodiments were initially examined in isolation to determine how they functioned. The fact that some of the isolated embossing points had become detached in the water was comprehensibly justified by the expert on the grounds that the cohesion of neighboring pulp fibers had been disturbed by the cutting of the absorbent core. The disintegration of just under half or just under two thirds of the isolated embossing areas under the influence of water, which was repeatedly mentioned by the defendant, could not be equated with a fiber suspension according to the comprehensible expert explanations. Even an embossing dot that has disintegrated into two halves consists of fibers that are stably bonded together. Accordingly, these are not dissolved.

23           Since an isolated examination of the embossing points impaired their stability, an examination of the intact absorbent core was necessary anyway. When exposed to water, the absorbent cores swell, so that the embossed areas are no longer recognizable. Nevertheless, they were still present. A fiber suspension was not detectable. Rather, the absorbent cores formed a compact material even in the highly swollen state. The lack of disintegration allows the conclusion to be drawn about the stressed stability provided by the embossing areas.



24 The realization of characteristic group 4 is not in dispute on the basis of its correct interpretation.

25 Nor can the defendant invoke a private right of prior use under Sec. 13 (3) GebrMG in conjunction with Sec. § Section 12 PatG. It is undisputed that the allegedly prior-used product "H. H. C " does not contain any superabsorbent polymers. Thus, there was no possession of the invention at the time of priority as a basic prerequisite for the creation of a private right of prior use.

26 The prior user is limited to the use of the invention for which all requirements of the exception were fulfilled before the filing date or priority date. Further developments are precluded if they interfere with the subject matter of the protected invention for the first time. This was the case in the dispute. In the absence of superabsorbent polymers, the allegedly pre-used product would encroach on the scope of protection of the utility model in suit for the first time.

27 The decision "Schutzverkleidung" of the Federal Supreme Court does not lead to a different assessment. There, it was not a question of the prerequisites, but of the limits of the right of prior use in the event of a modification of the vested rights. The question of the admissibility of modifications to the pre-used object could only arise if a protected vested right had been established by this. This was not the case, because the pre-used product "H. H. C. " did not constitute such a vested right due to the lack of superabsorbent polymers.

28 The fact that the mandatory use of superabsorbent polymers was originally only provided for in claim 11 does not help the defendant. For the assessment of whether the invention was owned, the relevant claim version at the end of the oral proceedings was decisive. The requirements of feature group 4 were now the subject matter of the main claim and their fulfillment was therefore essential for the creation of protected ownership.

29           III.       This decision does not withstand legal review in one decisive  
point.

30           1.        However, the interpretation of the claim utility model by the Court  
of Appeal is correct.

31           a)        The strong and intimate bond between adjacent pulp fibers in the  
embossing areas does not loosen under the action of water within the meaning  
of feature 3.1 if it persists to such an extent that it still contributes to a tear-  
resistant pulp web in the state of use.

32           aa)       Contrary to the view of the revision, the requirement of "non-  
solubility" does not necessarily mean, even from a functional point of view, that  
the firm and intimate connection of adjacent pulp fibers in the preparation areas,  
which exists in the dry state, must remain in exactly this state under the influence  
of water.

33           Rather, it is sufficient if the pulp fibers in the embossing areas are still bonded  
under the effect of water in such a way that sufficient embossing points remain  
which contribute to the desired increased tensile strength and mechanical load-  
bearing capacity of the pulp web. Under this condition, it is irrelevant if individual  
embossing areas disperse under the effect of water.

34           bb)       Whether the geometric shape of the embossed areas changes  
compared to the dry state or individual fibers lose their connection is also  
irrelevant, as the court of appeal correctly assumed.

35           The description of the patent application emphasizes that the fibrous web  
according to the invention, using the embossed areas, is characterized by a high  
mechanical load-bearing capacity even in the wet state (p. 3 lines 1-3). This does

not necessarily mean that the mechanical load-bearing capacity must correspond to that in the dry state and that the bond in adjacent pulp fibers in the embossed areas must not change under the influence of water. Rather, it is sufficient if a sufficiently high strength is still given even in the wet state.

36           The further implementation of this specification, in particular the arrangement and determination of the number of embossing areas required for this purpose, is left to the expert.

37           cc)     Accordingly, the Court of Appeal was correct in assuming that the bond between adjacent pulp fibers in the embossing area does not disintegrate under the effect of water at service temperature within the meaning of feature 3.1 even if the pulp web as a whole does not disintegrate under the effect of water to form a fiber pulp or a fiber suspension and the embossing areas provided for in feature group 3 and defined in more detail therein contribute to this.

38           dd)     Contrary to the opinion of the appeal, the Court of Appeal did not leave the interpretation of feature 3.1 to the expert.

39           Rather, the Court of Appeal determined the technical and functional meaning of the claim on the basis of the wording of the claim. On this basis, it arrived at the correct result of its interpretation with additional reference to the description.

40           In this context, it is not legally objectionable that the Court of Appeal additionally referred to the expert explanations of the technical context of the protected teaching and took these into account in its interpretation (see Federal Supreme Court (BGH), judgment of December 22, 2009 - X ZR 56/08, BGHZ 184, 49 para. 25 f. - Kettenanordnung II).

41           b)       The Court of Appeal was also correct in assuming that the sole  
use of superabsorbent polymers satisfies the requirements of feature group 4.

42           aa)       Contrary to the opinion of the revision, the mentioned characteristics  
do not require that the addition of auxiliaries and fillers must consist of  
superabsorbent polymers and at least one other component.

43           In claim 10, possible examples of the composition of the claimed additive in an  
alternative ratio are given. Accordingly, each of the components mentioned therein  
may in itself constitute the additive of auxiliary and filler materials. According to claim  
11, the additive comprises superabsorbent polymers. As the Court of Appeal  
correctly pointed out, this only means that the additive must contain superabsorbent  
polymers. Other components, on the other hand, are optional.

44           In line with this, the description also mentions by way of example an additive  
of auxiliaries and fillers consisting of titanium dioxide or superabsorbent polymers  
(p. 4 lines 15-21). A cumulative use of different substances is also not mandatory  
in this respect.

45           bb)       Against this background, nothing to the contrary results from the use  
of the plural with regard to the auxiliaries and fillers.

46           Rather, according to the authoritative understanding of the claim utility model,  
an additive of auxiliary and filler substances already exists if it is formed from a  
certain amount of a substance.

47           cc)       Nor does anything else follow from the "tire sealant" decision  
referred to by the appeal.

48           The assessment there, according to which a patent claim teaching the  
composition of a means from certain compulsory components and only a certain  
further optional component goes beyond the content of the originally filed

documents, in which this means may consist of any further components in addition to compulsory components (Federal Supreme Court (BGH), judgment of July 12, 2011 - X ZR 75/08, GRUR 2011, 1109 para. 37 et seq. - Reifenabdichtmittel), has nothing in common with the interpretation of feature group 4 that is of interest here.

49 First, the fact that the subject matter of the IP right is not disclosed as belonging to the invention in the originally filed documents under a particular interpretation of the claims would not automatically have the consequence that the claim is to be interpreted more narrowly.

50 Irrespective of this, in the case in dispute, a deviation of the features in question from the originally submitted documents is neither asserted nor otherwise evident.

51 2 On the basis of its correct interpretation, the Court of Appeal did not err in law in its assessment that the challenged embodiments implement the features of the claim version last asserted with the main request.

52 a) According to the findings of the Court of Appeal, the challenged embodiments have embossing areas within the meaning of feature group 3, the firm and intimate connection of which is maintained even in the state of use under the action of water to such an extent that these ensure a mechanically stable product.

53 The Court of Appeal reached this conclusion by evaluating the expert opinions obtained and the supplementary oral explanations in a legally unobjectionable manner.

54 aa) Under the law of review, it is only possible to review whether the judge of fact has dealt with the facts of the case and the results of the evidence comprehensively and without contradiction, i.e. whether the assessment is

complete and legally possible and does not violate the laws of reasoning or principles of experience. The standard of proof is also subject to review (see only Federal Supreme Court (BGH), judgment of May 6, 2015 - VIII ZR 161/14, NJW 2015, 2011, para. 11; judgment of March 13, 2003 - X ZR 100/00, GRUR 2003, 507, 508 - Enalapril).

55           bb)       The assessment of evidence in the challenged judgment satisfies these requirements.

56           In particular, contrary to the opinion of the appeal, the Court of Appeal did not disregard the increased disintegration of the fibers in the embossing areas examined in isolation under the influence of water or regard this circumstance as sufficient in the context of its formation of convictions.

57           Rather, the Court of Appeal comprehensibly explained that the isolated examination of the embossing areas is not suitable as a standard of assessment due to the infringement of the intact absorbent cores, and therefore relied decisively on the properties of the intact absorbent core. In doing so, it came to the conclusion that the pulp fibers fused in the embossing areas provide the mechanical stability of the attacked embodiments in the state of use due to their continued bonding even under the influence of water. Only as a supplement did it refer to the bond between neighboring pulp fibers under the influence of water, which still existed when the isolated embossing areas were examined.

58           This assessment does not reveal any legal errors. In particular, contrary to the view of the appeal, the Court of Appeal did not make itself the "mouthpiece" of the experts in its assessment of the evidence.

59           b)       The realization of feature group 4 by the challenged embodiments is not disputed by the appeal on the basis of the correct interpretation already set out, according to which only the presence of superabsorbent polymers constitutes an addition of auxiliaries and fillers.

60           c)     The Court of Appeal was correct in not taking into account the  
defendant's submission that the challenged embodiments I are not free of  
adhesives and binders within the meaning of feature 3 due to the presence of  
silicone, as a new submission pursuant to Section 531 (2) of the Code of Civil  
Procedure (ZPO).

61           aa)    According to the findings of the Court of Appeal, which are not  
challenged in this respect, the defendant claimed for the first time on appeal that  
the silicone contained in the challenged embodiments I constitutes a binder.

62           At first instance, the defendant did not dispute the plaintiff's assertion, based  
on the party expert opinion obtained, that the challenged embodiment I is free of  
binder and that the small amount of silicone detected in the pulp fibers is the  
amount usually found there.

63           bb)    The appeal does not show any aspects which would have  
necessitated consideration of the new submissions under Section 531 (2) of the  
Code of Civil Procedure (ZPO) in the appellate instance.

64           The fact that claim 1 in the most recent version only covers the combination of  
freedom from adhesives and freedom from binders does not constitute a sufficient  
reason in this respect.

65           Already at first instance, the plaintiff asserted infringement by the challenged  
embodiments I of the combination of freedom from adhesives and binders, which  
was already protected by the originally registered claim 1. This combination was  
thus the subject of the legal dispute from the outset and the plaintiff's arguments  
in this regard were relevant to the decision. The defendant should therefore have  
contested the plaintiff's arguments, if necessary, already at first instance.

66           Contrary to the opinion of the appeal, it does not follow otherwise from the fact  
that, according to the originally registered version of the claim, the sole use of an

adhesive or a binder would also have led to an infringement of property rights. Since the original claim was in any case also directed against a combination of both properties, the complaint would have had to be dismissed in part at any rate if this combination had not existed.

67           3.       On the other hand, a right of prior use of the defendant cannot be denied on the basis of the reasons given by the Court of Appeal.

68           a)       According to the case law of the Senate, the prior user is in principle limited to the use of that part of the invention for which all requirements of the exception were fulfilled prior to the filing or priority date. Further developments beyond the scope of the previous use are prohibited if they interfere with the subject matter of the protected invention.

69           aa)      The Senate has assumed such an interference in the case that all features of a patent claim are realized for the first time in the embodiment attacked as patent infringing, whereas this was not yet the case in the previously used embodiment due to the absence of one of these features (Federal Supreme Court (BGH), judgment of November 13, 2001 - X ZR 32/99, GRUR 2002, 231, 234 - Biegevorrichtung).

70           bb)      Furthermore, an interference with the subject matter of the property right may also be present if the prior user uses the invention to a greater extent than corresponds to his ownership or if he uses the invention in a different way than was the case prior to the filing or priority date.

71           It is true that the right of prior use must not be so narrowly defined that the prior user cannot make economically meaningful use of it. On the other hand, however, account must be taken of the fact that the technical teaching of a patent or utility



model may comprise alternatives which realize the technical and economic advantages of the invention in quantitatively or qualitatively different ways.

72 Whether a different form of use exists in this sense is to be decided on the basis of the claims interpreted in the light of the description and drawings. Changes which have no influence on whether and in which way the technical teaching of an IP claim and its individual features are realized are irrelevant for the right of prior use. If, on the other hand, at least one feature of the claim is realized in a technically different way than was the case before the filing date or priority date, this may exceed the limits of the right of prior use.

73 Whether the latter is the case is to be decided on the basis of an overall assessment which appropriately balances the interest of the prior user in being able to use the acquired property in a commercially reasonable manner and the interest of the property right owner in having to tolerate the use of his property right only to the extent that the technical teaching protected has also been recognized and implemented by the prior user.

74 Accordingly, the limits of the right of prior use may be exceeded if the modification realizes an additional advantage which was not realized by the non-modified embodiment. This can be considered if an embodiment is used for the first time which is emphasized in a subclaim or in the description because of this additional advantage.

75 If, on the other hand, two completely equivalent alternatives are mentioned in a claim for a feature, the fact that the prior user used only one of these alternatives will not regularly justify a corresponding restriction of his right to use. Likewise, it will have to be appreciated if the patent specification or the utility model specification discloses a deviation from the prior use which is a self-evident

variation which, from the point of view of the person skilled in the art, can be readily considered with the prior user's possession of the invention at the time of filing or priority (see Federal Supreme Court (BGH), judgment of May 14, 2019 - X ZR 95/18, BGHZ 222, 54 para. 26 et seq. - Schutzverkleidung).

76           b)           On the basis of these principles, the defendant's ownership of the invention in the case in dispute cannot be denied on the basis of the reasons given by the Court of Appeal.

77           aa)           With regard to the prior use of the product "H. H. C." in question, the Court of Appeal merely found that it was undisputed that the product did not contain any superabsorbent polymers. From this, it concluded that no protected vested rights of the defendant had been established with regard to the last claim version asserted by the plaintiff, which is why the question of a permissible modification of the prior-used object did not arise.

78           bb)           This does not stand up to legal review.

79           The modification of a pre-used object which realizes all the features of an independent claim of protection of the utility model in suit may be covered by a right of prior use even if the pre-used object did not exhibit further features which are mandatory under the claim.

80           (1)           In the absence of contrary findings by the Court of Appeal, it is to be assumed in favor of the defendant under the law of review that the product "H. H. C. " used by it in Germany prior to the priority date fulfilled features 1 to 3.1 of the most recently asserted version of the claim.

81            On this basis, as the appeal rightly asserts, there is a vested right protected  
by Sec. 13 (3) GebrMG in conjunction with Sec. 12 PatG. § Sec. 12 Patent Act  
with regard to the subject matter of claim 1.

82            (2)        Against this background, it is relevant for the decision whether a  
modification of the pre-used item is covered by the right of prior use according to  
the specifications of feature group 4.

83            For the assessment of this question, according to the case law of the Senate  
mentioned above, it is decisive whether an additional advantage is realized with  
the modification or whether it is a completely equivalent alternative or a self-  
evident modification.

84            Contrary to the opinion of the Court of Appeal, this question is also relevant if  
the additional features of a subclaim are realized for the first time with the  
modification. It is true that the highlighting of a feature in a subclaim may indicate  
in an individual case that it is a relevant additional advantage. However, the  
inclusion in a subclaim cannot replace the substantive examination of whether such  
an advantage exists or whether it is merely a completely equivalent alternative or  
a self-evident variation (see in this respect Federal Supreme Court (BGH),  
judgment of May 14, 2019 - X ZR 95/18, BGHZ 222, 54 para. 31 et seq. -  
Schutzverkleidung; in the result also Scharen, GRUR 2021, 343, 344; Haft, GRUR  
2021, 219, 220).

85            (3)        These principles apply irrespective of whether only the  
infringement action is based on a version of an independent protective claim  
limited by additional features or whether the utility model has been limited  
accordingly in cancellation proceedings.

86            Pursuant to Sec. 12 (1) Patent Law, the effects of the granted patent do not  
apply to the person who was in possession of the invention at the time of filing or  
priority. The basis for the protection of the prior user thus established cannot be  
withdrawn by a subsequent limitation of the property right. According to the  
principles outlined above, the fact that a prior-used subject-matter fulfills all features

of a granted independent claim does not justify any subsequent modification. Whether or not a modification is covered by the right of prior use according to the above standards must, however, already result from the granted version of the patent or from the originally registered version of the utility model. A subsequent amendment of the claims is not capable of eliminating a subsequent right to modify the pre-used subject matter (see Scharen, GRUR 2021, 343, 344; in the result also Haft, GRUR 2021, 219, 221).

87           Against this background, the question raised by the appeal as to whether the inclusion of additional features in the claim of a utility model infringement action is equivalent to a subsequent limitation of a granted claim in patent revocation proceedings or of a granted claim in utility model cancellation proceedings can be left open.

88           (4)       Likewise, the question of whether and, if so, under what conditions the prior user is also permitted to further develop the prior use in a manner which, although not a self-evident modification, was obvious to the skilled person with the prior user's possession of the invention (also left open in Federal Supreme Court (BGH), judgment of May 14, 2019 - X ZR 95/18, BGHZ 222, 54 para. 33 - Schutzverkleidung) does not need to be decided in the dispute.

89           c)       In the case in dispute, the court of appeal should therefore have clarified whether the pre-used object may be modified in such a way that it realizes the additional features of feature group 4.

90           As the appeal correctly asserts, this comes into consideration if the modification is not associated with any additional advantage highlighted by the protective writing or if, from the perspective of the person skilled in the art with the prior user's possession of the invention at the time of filing or priority, the additional features

are a self-evident modification of the originally used subject matter that can be considered without further ado (see Federal Supreme Court (BGH), judgment of May 14, 2019 - X ZR 95/18, BGHZ 222, 54 para. 31 et seq. - Schutzverkleidung).

91           IV.     The Senate cannot make a final decision on the merits.

92           The Court of Appeal will have to reassess the prerequisites of a right of prior use in the reopened appeal proceedings on the basis of the legal situation outlined above. If it comes to the conclusion that the object pre-used by the defendant fulfills features 1 to 3.1, it will have to deal in particular with the defendant's argument that the use of superabsorbent polymers within the meaning of feature group 4 constitutes a self-evident modification of the pre-used fibrous web.

93           Contrary to the opinion of the appellant, the finding of the Court of Appeal that superabsorbent polymers have an "explosive force" with respect to structures lying in their vicinity due to their high absorbency does not enable a final decision to be reached. The aforementioned circumstance may indeed constitute an indication that the use of superabsorbent polymers is not a natural modification of the previously used fibrous web, because there may have been a concern that

this could lead to problems with regard to strength. However, whether this risk existed and what conclusions, if any, resulted from this on the basis of the pre-used article cannot be conclusively assessed on the basis of the finding in question.

Bacher

Hoffmann

Deichfuß

Marx

Judge at the Federal Supreme Court  
Dr. Crummenerl is on vacation and  
can therefore not sign.

Bacher

Lower courts:

Düsseldorf District Court, decision dated October 6, 2005 - 4a O 264/04 -

Düsseldorf Higher Regional Court, decision dated June 24, 2021 - I-2 U 116/05 -