

The decision „Schleifprodukt“ of the German Federal Court of Justice - a step towards harmonisation with the EPO practice?

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One area where the practice of the EPO and the German Federal Court of Justice (FCJ) could not be further apart was the assessment of added matter. While the FCJ traditionally had been very lenient in allowing limiting amendments which involve a certain degree of generalisation over concretely described embodiments, if the resulting technical teaching is still covered by the more general description of the invention, the EPO normally finds these so-called "intermediate generalisations" inadmissible and rejects amendments of this type. Against this background, the FCJ decision *Schleifprodukt* (grinding product) X ZR 119/09 of 25 November 2014 could be seen as a step towards harmonisation with the EPO. The facts underlying this case were as follows:

Plaintiff asserted that the subject matter of EP 779 851 is not patentable, and the Federal Patent Court declared the patent in suit to be null and void. In his appeal, Defendant defended the patent in suit with several different claim sets, namely, a Main and five Auxiliary Requests, which were all directed to a cloth-based grinding product. Some of the claim sets defined two different grinding products which essentially differed from each other in that, in the first product, the grinding agent is applied to the side of the cloth having projecting thread parts such as loops, and in the second product, it is applied to that side which is essentially even. The narrowest claim set concerned only the second grinding product.

The patent in suit related to the technical problem of providing a grinding product that enables a considerably longer service life than known products. In order to solve this problem, the invention attributed central significance to the properties of the cloth. However, the text of the application on which the patent in suit was granted described the textile construction only in that the grinding product comprises a "cloth of woven or knitted threads". Further details regarding its textile construction could only be ascertained from the drawing figures. As confirmed by the court expert, the relevant figures showed a cloth consisting of a knitted fabric having a satin/tricot construction where the satin stitches, more specifically the underlaps connecting the same, are arranged above the underlaps of the tricot stitches.

Defendant pursued a broader claim set in which the cloth was defined as being a warp-knitted fabric having a combined construction with a specified stitch arrangement that did not only cover satin/tricot cloth but also other types of combined constructions such as velvet, atlas or rib. In a narrower claim set, the cloth was defined as a warp-knitted fabric having a combined construction made of satin stitches and tricot stitches. This wording did not only cover the satin/tricot cloth which the court expert had identified as being shown in the relevant figures, but also a tricot/satin cloth, i.e. one with reversed underlaps.

When judging the admissibility of these amendments in light of the disclosure of the application as filed, the FCJ did not express that it wishes to deviate from the currently applied criteria as set forth e.g. in "Spielkammer" (X ZB 9/89 of 23. January 1989) and "Kommunikationskanal" (X ZR 107/12 of 11 February 2014). The FCJ emphasized with reference to these decisions that it would generally not be inadmissible to incorporate only some of a plurality of features of an embodiment into the independent claims. In doing so, the Court repeated earlier guidance given for assessing the admissibility of amendments: if features of an embodiment either jointly or individually contribute to the success achieved with the invention, and serve to specify the protected invention, it is essentially permissible that the patent be limited by incorporating such features, individually or in their entirety, into the claim.

However, in the "Schleifprodukt" judgment the FCJ placed greater emphasis on one further aspect of that assessment according to which the entirety of the combination claimed by the amended claim has to represent a technical teaching which the person skilled in the art could have taken from the original documents as a potential embodiment of the invention (see e.g. "Drehmomentübertragungseinrichtung" X ZB 18/00 of 11 September 2001). In the present judgement, this prerequisite was held to be not met.

As to the broader claim set, the FCJ found it insufficient that the skilled person might have identified the embodiment of the relevant figures to fall within the scope of those claims. The FCJ rejected the broader claims with the reasoning that there were no indications in the text of the application from which the skilled person could have taken that it is decisive for the configuration of a cloth to be one according to the invention that several types of stitches be combined in the claimed manner, the specific stitch type being irrelevant. Examining the narrower claim set in the light of the court expert's statement, the FCJ arrived at the conclusion that the skilled person would have had reservations to use a tricot/satin construction as a possible configuration of the invention, since such a construction tends to be less suited for achieving the effects of the invention. The court expert had specifically highlighted that a satin/tricot construction leads to embodiments facilitating effects which contribute to the success achieved with the invention. However, in the view of the court expert, it was not apparent that the same also applies with regard to any other combination of tricot and satin stitches, in particular a tricot/satin construction.

The court thus carried out the test for the admissibility of claim amendments by assessing whether the feature combination of the amended claim in its entirety represents a technical teaching which is identifiable from the original application as being suitable for achieving the effects of the invention. This brings the German practice closer to the very strict approach of the EPO Boards of Appeal. If, in proceedings before the EPO, an amendment involves a singling-out of features from a combination of features disclosed in one working example, the yardstick for the admissibility of the amendment is whether the skilled person could recognize without any doubt that those (singled-out) features/characteristics were not so closely related to the other features/characteristics of the working example and that they apply directly and unambiguously to the more general context (see e.g. T962/98). This can be the case if the skilled person recognizes that the singled-out feature contributes to achieving the effects of the invention even in the absence of the other features of the working example.

In view of the above the broader and narrower claim sets were rejected by the FCJ on the ground that they extend the claimed subject matter beyond the content of the application as filed while, in contrast to the finding of the Federal Patent Court, the second grinding product being the only subject matter of the narrowest claim set was considered to be patentable.

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