Offer for development no obvious pre-use

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by Miriam Büttner

In a recent decision the German Bundesgerichtshof (Federal Court of Justice, FCJ) dealt with the requirements of an obvious pre-use (judgment of 9 December 2014, docket no. X ZR 6/13 – Presszange).

In 2011 plaintiff attacked the German part of the European Patent 1 223 008 (DE 502 06 178.2), which concerns the construction of a crimping plier. Such crimping pliers are mainly used for sanitary installations to connect two pipes via a connecting piece called "fitting". Plaintiff based its nullity suit inter alia on an obvious pre-use of the protected invention. In this regard plaintiff submitted correspondence with a manufacturer of crimping pliers to develop a crimping plier allegedly showing the features of patent claim no. 1. Furthermore plaintiff argued that it would be very likely that during the distribution of crimping pliers it was pointed out to customers that crimping pliers with the features of patent claim no. 1 shall be developed.

The German Bundespatentgericht (Federal Patent Court, FPC) dismissed the complaint as the alleged pre-use did not show all features of patent claim no. 1 and was not available to the public.

The FCJ annulled the decision of the FPC as the teaching protected by patent claim no. 1 was rendered obvious by the prior art, but it maintained the patent following one of the claimed auxiliary requests.

With regard to the alleged pre-use the FCJ mainly followed the reasoning of the FPC. The FCJ elaborated in this regard that an offer that is not addressed to the public, but to a (potential) contract partner only constitutes an obvious pre-use if the spread of the information disclosed to the offeree to third parties is suggested by life experience. If the offer concerns the production of an item, which still has to be developed, this cannot be assumed without further ado. In such a situation the developer as well as his contract partner are interested in keeping the development project confidential until the new product is launched.

The FCJ also refused plaintiffs second argument which based on a hypothetical course of events. The FCJ stated in so far that according to the settled case law it is sufficient for an obvious pre-use that third parties and thus also experts had a not only remote possibility to get reliable, sufficient knowledge of the invention and that the general life experience can justify the assumption that such a possibility existed. Such a conclusion is only possible if at least one act of communication is established such as an offer or a delivery on which a principle derived from experience can be applied. There-fore, it is not sufficient for an obvious pre-use that the owner of an invention was only willing to make his invention available to the public. Rather, it is necessary that such a statement actually has taken place.

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