

## Fahrzeugscheibe II (Windscreen II) - Now we can see more clearly...

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The German Federal Court of Justice (FCJ) recently issued a second decision in a nullity lawsuit revolving around a windscreen for vehicles (Fahrzeugscheibe II, X ZR 41/14). While the first decision dealt with interesting questions regarding the transferability of the right to priority, the second one treads more conventional paths, yet it still contains a couple of interesting statements on various issues. The patent at stake was about a "device for connecting a fixed-mounting vehicle window, in particular a windscreen, to a component contiguous with one edge of the vehicle window". While this might sound a bit dull at the first moment, the patent did, however, have an exciting litigation history that would have been more appropriate for a device for securing and connecting a person to a roller coaster car.

Nullity plaintiff requested revocation of the patent with the exception of claim 11 and was successful in the first instance. To the requested extent, the patent was declared null and void by the FPC for lack of novelty vis-à-vis its German priority application on the grounds, according to the FPC, that the right to priority had not been properly transferred to the applicant of the EP application, which was a member of the same group of companies. The FCJ reversed the decision and remanded the case back to the FPC for an evaluation of the other invalidation grounds invoked by the nullity plaintiff (Fahrzeugscheibe I, X ZR 49/12, discussed [here](#)). Thus, the roller coaster started moving up again, from patentee's perspective, and reached a peak when the FPC issued its preliminary opinion indicating that claim 1 according to patentee's auxiliary request might be patentable.

From there, however, it went sharply downhill again when the Presiding Judge of the competent nullity panel of the FPC remarked in his opening comments during the hearing that the Court would no longer adhere to its preliminary opinion in view of plaintiff's new arguments and evidence. The oral proceedings then ended with a renewed revocation of the patent to the extent as requested by nullity plaintiff. But patentee appealed again, this time adding new Auxiliary Requests I to III to its main request.

Filing new auxiliary requests only in the appeal stage is in principle risky since the Federal Court of Justice has discretion under Sec. 116 (2) German Patent Act to reject requests filed for the first time during appeal proceedings. However, and this was fortunate for the patentee, the FCJ tends to exercise this discretion carefully, taking all circumstances of the case into account. Thus, late-filed auxiliary requests have previously been admitted when there is a dispute as to claim construction, with the Federal Patent Court in one case considering a narrow construction appropriate with the patent thus being construed to be valid, but the Federal Court of Justice considering (a) the patent has to be construed broadly and (b) a limited version of claim 1, corresponding to what the Federal Patent Court had understood the granted claim 1 to mean anyway, was patentable (X ZR 21/12 *Walzstrasse*). Late-filed auxiliary requests have also been allowed when the preliminary opinion by the Federal Patent Court had not been complete and did not discuss all of the attacks advanced by the nullity plaintiff, i.e. when one of these attacks in the end proved to be successful (X ZR 2/13 *Analog-Digital-Wandler*). Conversely, late-filed auxiliary requests have been rejected when the patentee had every reason to file them in the first instance, yet failed to do so, i.e. due to negligence on the patentee's part (X ZR 111/13 *Telekommunikationsverbindung*).

The Fahrzeugscheibe II decision has now added another set of facts to those circumstances where late-filed auxiliary requests are permissible. If the FPC's preliminary opinion does not induce the patentee to file other or more (auxiliary) requests, and the court then changes its opinion in the oral proceedings, the patentee is not to blame for this and may still file such auxiliary requests during appeal. The patentee is not expected to react to such a change of opinion as early as in the oral proceedings.

Thus in the end, the patentee's new auxiliary requests I-III were admitted to the proceedings and patentee finally succeeded with his second auxiliary request. The roller coaster came to stop somewhere in the middle between peak and trough.

This decision also contains several interesting statements on substantive law. With regard to the problem underlying the invention, the FCJ reiterated its earlier position (see X ZR 41/13 *Quetiapin*) that the problem should be formulated in a general way and not too narrowly. It is not admissible to assume that the skilled person would only have set out to solve one particular problem. Unless it is doubtlessly apparent which problems would have been addressed by the person skilled in the art, it would be wrong to evaluate the question of which incentives the skilled person would have received from the state of the art when defining the problem. This question should only be dealt with in its relevant context, i.e. when considering the question of obviousness. It goes without saying that this approach is quite at odds with the EPO's problem-solution approach.

Finally, the Fahrzeugscheibe II decision also confirms the FCJ's long-standing case law stipulating that intermediate generalizations are in principle admissible (X ZR 107/12 *Kommunikationskanal*) unless it is clear from the application as filed that certain features of a working example are inseparable, with the claim having been amended so as to only contain some of them (X ZB 18/00 *Drehmomentenübertragungseinrichtung*). The FCJ held that such an inseparable connection did not exist in the case of patentee's second auxiliary request that contained some features from Fig. 1 and 2, but not all of them.

Where does this leave us? In the first place, it tells us again that there can always be surprises in litigation, and that a preliminary opinion issued by the Federal Patent Court is not always predictive of the final outcome of first instance proceedings, let alone appeal proceedings. Secondly, it shows us that the Federal Court of Justice takes great care not to use the weapons of procedural law to the detriment of a party that has acted diligently in the first instance. If a patentee had no sound reason or adequate opportunity to file a certain auxiliary request during the first-instance proceedings, it can still do so upon appeal and sometimes even be successful with this. Thirdly, the FCJ continues to reject or at least not to apply certain approaches of the EPO that it perceives as overly rigid or schematic.